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7 Attorneys for Defendant
VARIAN MEDICAL SYSTEMS, INC.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

3 UNIVERSITY OF PITTSBURGH OF THE
4 COMMONWEALTH SYSTEM OF HIGHER
EDUCATION d/b/a UNIVERSITY OF
PITTSBURGH, a Pennsylvania non-profit
corporation (educational),

Plaintiff,

V.

8 VARIAN MEDICAL SYSTEMS, INC., a
Delaware corporation.

Defendant

Case No. CV 08-02973 MMC

**DEFENDANT'S SUBMISSION OF
EXHIBITS A-Q AND T-V TO THE
PREVIOUSLY-FILED "SEALED
DECLARATION OF MATTHEW H.
POPPE" IN SUPPORT OF MOTION
TO TRANSFER, PER THE COURT'S
ORDER OF AUGUST 19, 2008 (DOC.
NO. 62)**

Date: September 5, 2008
Time: 9:00 a.m.
Courtroom: 7, 19th Floor

1 Pursuant to the Court's Order Granting in Part and Denying in Part Defendant's
2 Administrative Motion to File Exhibits Under Seal, dated August 19, 2008 (Document No. 62),
3 Defendant Varian Medical Systems, Inc. ("Varian") hereby submits for the public record Exhibits
4 A through Q and T through V that were previously attached as exhibits to the Sealed Declaration
5 of Matthew H. Poppe in Support of Varian's Motion to Transfer Action to U.S. District Court for
6 Western District of Pennsylvania, filed on July 2, 2008 (Document No. 23).

7 I, Matthew H. Poppe, declare:

8 1. I am a partner in the law firm of Orrick, Herrington & Sutcliffe LLP ("Orrick"),
9 counsel of record for Varian in this action and in *University of Pittsburgh v. Varian Medical*
10 *Systems, Inc.*, Case No. 2:07-cv-00491-AJS, in the Western District of Pennsylvania (the "Penn.
11 Case"). I am licensed to practice law in the State of California. I have personal knowledge of the
12 facts stated herein, except where otherwise stated, and I could and would testify to those facts if
13 called as a witness.

14 2. Attached hereto as Exhibit A is a true and correct copy of excerpts from the
15 deposition of Karun Shimoga, taken on August 31, 2007 in the Penn. Case.

16 3. Attached hereto as Exhibit B is a true and correct copy of excerpts from the
17 deposition of Joel Greenberger, taken on September 21, 2007 in the Penn. Case.

18 4. Attached hereto as Exhibit C is a true and correct copy of excerpts from the
19 deposition of Andre Kalend, taken on October 5, 2007 in the Penn. Case.

20 5. Attached hereto as Exhibit D is a true and correct copy of excerpts from the
21 deposition of Takeo Kanade, taken on September 19, 2007 in the Penn. Case.

22 6. Attached hereto as Exhibit E is a true and correct copy of excerpts from the
23 deposition of Robert Wooldridge, taken on September 26, 2007 in the Penn. Case.

24 7. Attached hereto as Exhibit F is a true and correct copy of excerpts from the
25 deposition of Richard Westerhoff, taken on October 3, 2007 in the Penn. Case.

26 8. Attached hereto as Exhibit G is a true and correct copy of excerpts from the
27 deposition of Marc Malandro, taken on October 2, 2007 in the Penn. Case.

1 9. Attached hereto as Exhibit H is a true and correct copy of a document produced in
2 the Penn. Case by Carnegie Mellon University (“CMU”) pursuant to subpoena with Bates Nos.
3 CMU 0279 to CMU 0283 and marked as Exhibit 7 at Mr. Wooldridge’s deposition on September
4 26, 2007. The same document (though with different Bates numbers) was marked as Exhibit 1 at
5 Mr. Malandro’s deposition on October 2, 2007.

6 10. Attached hereto as Exhibit I is a true and correct copy of a document produced in
7 the Penn. Case by CMU pursuant to subpoena with Bates Nos. CMU 0274 to CMU 0278 and
8 marked as Exhibit 9 at Mr. Wooldridge’s deposition on September 26, 2007. The same document
9 was marked as Exhibit 10 at Mr. Malandro’s deposition on October 2, 2007.

10 11. Attached hereto as Exhibit J is a true and correct copy of a document produced in
11 the Penn. Case by CMU pursuant to subpoena with Bates Nos. CMU 0227 to CMU 0236 and
12 marked as Exhibit 24 at Mr. Wooldridge’s deposition on September 26, 2007.

13 12. Attached hereto as Exhibit K is a true and correct copy of a document produced in
14 the Penn. Case by CMU pursuant to subpoena with Bates No. CMU 0237 and marked as Exhibit
15 25 at Mr. Wooldridge’s deposition on September 26, 2007.

16 13. Attached hereto as Exhibit L is a true and correct copy of a document produced in
17 the Penn. Case by CMU pursuant to subpoena with Bates Nos. CMU 0238 to CMU 0248 and
18 marked as Exhibit 26 at Mr. Wooldridge’s deposition on September 26, 2007.

19 14. Attached hereto as Exhibit M is a true and correct copy of a document produced in
20 the Penn. Case by CMU pursuant to subpoena with Bates Nos. CMU 0256 to CMU 0257 and
21 marked as Exhibit 29 at Mr. Wooldridge’s deposition on September 26, 2007.

22 15. Attached hereto as Exhibit N is a true and correct copy of a document produced in
23 the Penn. Case by CMU pursuant to subpoena with Bates No. CMU 0258 and marked as Exhibit
24 30 at Mr. Wooldridge’s deposition on September 26, 2007.

25 16. Attached hereto as Exhibit O is a true and correct copy of a document produced in
26 the Penn. Case by CMU pursuant to subpoena with Bates No. CMU 0259 and marked as Exhibit
27 31 at Mr. Wooldridge’s deposition on September 26, 2007.

28

17. Attached hereto as Exhibit P is a true and correct copy of a document produced in the Penn. Case by CMU pursuant to subpoena with Bates No. CMU 0260 and marked as Exhibit 32 at Mr. Wooldridge's deposition on September 26, 2007.

18. Attached hereto as Exhibit Q is a true and correct copy of a document produced in the Penn. Case by CMU pursuant to subpoena with Bates No. CMU 0262 and marked as Exhibit 34 at Mr. Wooldridge's deposition on September 26, 2007.

19. Attached hereto as Exhibit T is a true and correct copy of excerpts from the deposition of Joel Greenberger, taken on October 24, 2007 in the Penn. Case.

20. Attached hereto as Exhibit U is a true and correct copy of excerpts from the deposition of Alexander Ciocca, taken on October 3, 2007 in the Penn. Case.

21. Attached hereto as Exhibit V is a true and correct copy of excerpts from the deposition of Jeffrey Shogan, taken on October 3, 2007 in the Penn. Case.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct. Executed in Menlo Park, California on August 20, 2008.

/s/ Matthew H. Poppe
Matthew H. Poppe

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the DEFENDANT'S SUBMISSION OF EXHIBITS A-Q AND T-V TO THE PREVIOUSLY-FILED "SEALED DECLARATION OF MATTHEW H. POPPE" IN SUPPORT OF MOTION TO TRANSFER, PER THE COURT'S ORDER OF AUGUST 19, 2008 (DOC. NO. 62) was served upon the University of Pittsburgh, through its counsel, via:

Hand-Delivery

Facsimile

First Class, US Mail, Postage Prepaid

Certified Mail-Return Receipt Requested

ECF Electronic Service

Overnight Delivery

at the following addresses:

Rita E. Tautkus
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Dated: August 20, 2008

/s/ Matthew H. Poppe

Matthew H. Poppe

OHS West:260496078.2

EXHIBIT A

IN THE UNITED STATES DISTRICT
NORTHERN DISTRICT OF CALIFORNIA

UNIVERSITY OF PITTSBURGH,)
)
Plaintiff)
vs.)
) Case No.
VARIAN MEDICAL SYSTEMS,) 07-CV-0791 (AJS)
)
Defendant.) Western District of
) Pennsylvania
)
)

**CERTIFIED
COPY**

HIGHLY CONFIDENTIAL ATTORNEYS' EYES ONLY

VIDEOTAPED DEPOSITION OF KARUN B. SHIMOGA, PhD

August 31, 2007

Reported by:

Rick Posner

CSR No. 5040

U.S. LEGAL
Supporet

Certified Stenographic Reporters

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1 IN THE UNITED STATES DISTRICT
2 NORTHERN DISTRICT OF CALIFORNIA
3

4 UNIVERSITY OF PITTSBURGH,)
5 Plaintiff)
6 vs.) Case No.
7 VARIAN MEDICAL SYSTEMS,) 07-CV-0791 (AJS)
8 Defendant.)
9 _____)
10
11
12

Deposition of KARUN B. SHIMOGA, PhD
taken on behalf of the Defendant at
1000 Marsh Road, Menlo Park, CA
beginning at 8:57 a.m. and ending at
6:02 p.m. on Friday, August 31, 2007
before Rick Posner, CSR No. 5040.

18

19

20

21

22

23

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25

1 APPEARANCES
2

3 Representing: Plaintiff

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10
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12 Orrick, Herrington & Sutcliffe

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15 Menlo Park, CA 94025

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17 mpoppe@orrick.com

18
19 ALSO PRESENT: Ramon Peraza, Videographer

1 KARUN B. SHIMOGA, PhD,

2 Having been first duly sworn, was examined and
3 testified as follows:

4

5 THE VIDEOGRAPHER: Good morning. Here
6 begins the deposition of Dr. Karun Shimoga in the
7 matter of University of Pittsburgh versus Varian
8 Medical Systems, Inc. This case is filed in the
9 United States District Court for the Western
10 District of Pennsylvania. And the case number is 8:57:38AM
11 2:07-CV-00491-AJS. Today's date is August 31st,
12 2007, and the time is 8:57 a.m.

13 This deposition is taking place at the law
14 offices of Orrick, Herrington & Sutcliffe, LLP,
15 located at 1000 Marsh Road, Menlo Park, California, 8:58:02AM
16 94025, and is being taken on behalf of the
17 defendants. The videographer is Ramon Peraza
18 appearing on behalf of US Legal Support. The court
19 reporter is Rick Posner, also appearing on behalf of
20 US Legal Support. 8:58:20AM

21 Will counsel present please identify
22 yourselves for the record and state whom you
23 represent.

24 MR. POPPE: Matthew Poppe with Orrick on
25 behalf of Varian Medical Systems. 8:58:27AM

1 MS. TAUTKUS: Rita Tautkus with Morgan 8:58:29AM
2 Lewis and Brockius on behalf of Dr. Karun Shimoga
3 and plaintiff University of Pittsburgh.

4 THE VIDEOGRAPHER: The court reporter may
5 now swear in the witness. 8:58:37AM

6 (Witness sworn.)

7
8 EXAMINATION

9 BY MR. POPPE:

10 Q Good morning, Dr. Shimoga. How are you? 8:58:50AM

11 A Fine. Pretty good. Thank you.

12 Q As I just mentioned my name is Matt Poppe
13 and I'm an attorney for Varian Medical Systems. And
14 you understand that Varian Medical Systems has been
15 sued for patent infringement by the University of 8:59:02AM
16 Pittsburgh? Can you please say yes or no?

17 A Yes.

18 Q Thank you.

19 I understand you got caught in a little
20 traffic today and just arrived a couple minutes ago, 8:59:11AM
21 is that correct?

22 A Yes.

23 Q It's not a problem at all. We appreciate
24 you being here.

25 A Thank you. 8:59:18AM

1 that seems to be correct.

9:42:28AM

2 Q And the development work on the inventions
3 that were described in those patents had started a
4 couple years before that, is that correct?

5 MS. TAUTKUS: Objection, vague.

9:42:40AM

6 THE WITNESS: Yeah. If I recall it was
7 somewhere, much earlier, yeah.

8 BY MR. POPPE:

9 Q Much earlier than 1996?

10 A Correct.

9:42:53AM

11 Q And during that period of the invention
12 development prior to the filing of the patent
13 applications, were you an employee of Carnegie
14 Mellon University during that whole time?

15 MS. TAUTKUS: Objection, vague.

9:43:06AM

16 THE WITNESS: Yes.

17 BY MR. POPPE:

18 Q You were a professor?

19 A I was a scientist.

20 Q And what's the distinction between
21 scientist and professor?

9:43:19AM

22 A The professor teaches and a scientist does
23 research.

24 Q So you were purely doing research?

25 A Correct, research and development.

9:43:31AM

1 Q And that was during the entire period of 9:43:33AM
2 the development of the inventions?

3 MS. TAUTKUS: Objection, vague.

4 THE WITNESS: Yes.

5 BY MR. POPPE: 9:43:42AM

6 Q And was that true during your entire
7 period of employment with Carnegie Mellon that you
8 were a scientist, not a professor?

9 A Correct.

10 Q Did you have the same -- did you have a 9:43:57AM
11 title other than scientist?

12 A Yes.

13 Q What was your title?

14 A Project scientist.

15 Q And was your title the same during your 9:44:06AM
16 entire time with Carnegie Mellon?

17 A It changed. The initial employment
18 started as what is called a research associate, and
19 then changed to project scientist.

20 Q And it was project scientist when you left 9:44:22AM
21 the University?

22 A Correct.

23 Q When did you start at Carnegie Mellon?

24 A Early '93.

25 Q And who did you report to at that time? 9:44:32AM

1 local research community and the presence of 9:53:32AM
2 hospitals spurred interest in radiation oncology.

3 Q Were any of those -- strike that.

4 And so it was after joining Carnegie

5 Mellon that you first began to study the procedures 9:54:12AM
6 related to radiation therapy to better understand
7 how robotics applications might be used in that
8 context?

9 MS. TAUTKUS: Objection, vague.

10 THE WITNESS: Yes, in a more serious 9:54:36AM
11 sense.

12 BY MR. POPPE:

13 Q In a more serious sense you said?

14 A Yes.

15 Q When was it that you left Carnegie Mellon, 9:54:43AM
16 left your employment with Carnegie Mellon?

17 A It is little interesting. At the end of
18 1999 I got leave of absence to work at a Carnegie
19 Mellon spin off company for a short while.

20 Q What was the name of that company? 9:55:16AM

21 A It is called Quant Point.

22 Q Spell that.

23 A Q-u-a-n-t, P-o-i-n-t. Quant Point. It
24 was also a robotics related company, but nothing to
25 do with the medical application. But they needed 9:55:27AM

1 somebody with my expertise. And I partially worked 9:55:32AM
2 on -- worked at that company for a couple of months.
3 And while the projects at Carnegie Mellon were still
4 going on, since I was a faculty on sabbatical, I
5 still, as a matter of professional interest, I was 9:55:53AM
6 supporting projects at Carnegie Mellon and also the
7 projects at UPMC.

8 As you understand, the projects at UPMC
9 were supported by Carnegie Mellon, and when the
10 project was about to be completed at Quant Point, 9:56:15AM
11 there were some shuffling of positions at UPMC which
12 called for somebody with my expertise to be there
13 full-time, again as my partial support through
14 Carnegie Mellon.

15 And at that time instead of returning back 9:56:36AM
16 to return to Carnegie Mellon, I continued the leave
17 of absence and joined University of Pittsburgh. I
18 do not recall when I terminated the leave of absence
19 status.

20 MS. TAUTKUS: Matt, we've been going for 9:57:11AM
21 about an hour. Maybe it's an appropriate time for a
22 break.

23 MR. POPPE: We can break now if you like.

24 MS. TAUTKUS: Very well.

25 THE VIDEOGRAPHER: We are off the record 9:57:18AM

1 calls for speculation.

10:37:07AM

2 THE WITNESS: I do not recall any other
3 work with the radiation oncology.

4 BY MR. POPPE:

5 Q How did you like working with Dr. Kanade? 10:37:22AM

6 A He's a nice person.

7 Q And I take it you respect him as a
8 professional in his field?

9 A Absolutely. A lot of people would love to
10 associate themselves with him.

10:37:34AM

11 Q How did you first meet Mr. Athanassiu?

12 A Mr. Athanassiu was a graduate student in
13 the Robotics Institute.

14 Q Was he already there when you started at
15 Carnegie Mellon? 10:37:54AM

16 A I do not know the exact answer to that,
17 whether he joined first or I joined first, but
18 somewhere along the line we came to know each other.

19 Q And I believe you referred to him as
20 Harry? 10:38:15AM

21 A Correct.

22 Q That was the name that he used generally?

23 A Correct.

24 Q And still does, I assume?

25 A Yes. 10:38:24AM

1 Q Had you known him prior to or outside -- 10:38:25AM

2 had you known him prior to starting work at Carnegie
3 Mellon?

4 A No.

5 Q Did you work with him on projects other 10:38:39AM
6 than the collaboration with University of Pittsburgh
7 that led to these patents?

8 A No.

9 Q Did he work on other projects that you're
10 aware of other than that this one -- 10:38:51AM

11 MS. TAUTKUS: Objection, vague.

12 BY MR. POPPE:

13 Q -- through the Robotics Institute?

14 MS. TAUTKUS: Objection, vague, calls for
15 speculation. 10:38:57AM

16 THE WITNESS: Yes.

17 BY MR. POPPE:

18 Q Do you know whether he had any particular
19 background in radiation oncology?

20 MS. TAUTKUS: Objection, vague. 10:39:09AM

21 THE WITNESS: I do not know. From my
22 understanding the previous projects were not related
23 to radiation oncology.

24 BY MR. POPPE:

25 Q And on the joint project with the 10:39:22AM

1 University of Pittsburgh, what was his role in 10:39:26AM
2 connection with that project?

3 A He was the project engineer. He's an
4 expert software developer, and also he has a very
5 good knowledge of the software architecture. 10:39:42AM

6 Q And what do you mean when you say software
7 architecture?

8 A It means as to -- for a system to work
9 what should be where in terms of the software
10 components, and where are the pitfalls, what you 10:40:01AM
11 should watch out for, where the software can fail,
12 and how it should be tested and so on.

13 Q Do you have any of that type of expertise?

14 A I do to some extent. But he's trained in
15 that area, so he was a significant contributor in 10:40:21AM
16 that aspect.

17 Q So back in that time period when that
18 project was going on can you describe what your
19 training or background was in the general area of
20 software development? 10:40:39AM

21 MS. TAUTKUS: Objection, vague.

22 THE WITNESS: I was and am able to write
23 software and do all of those things that I
24 mentioned, but not to the extent of somebody who is
25 specially trained to do that. My strong points are 10:40:53AM

1 more towards conceptualization and finding drawbacks 10:41:00AM
2 and contrasting, comparing different concepts in
3 terms of their applicability, and knowing new
4 technologies and how it should be implemented.

5 My role on the project was primarily 10:41:20AM
6 project management. From the title I was
7 responsible for organizing what is required for the
8 project in order to be implemented once the concept
9 was formulated.

10 BY MR. POPPE: 10:41:40AM

11 Q As of the mid-1990s, what software
12 languages did you know how to program in?

13 A C, C++.

14 Q Just those two?

15 A Yes. I have programmed in other languages 10:41:52AM
16 before, but those were the primary languages that we
17 were using for the project in question.

18 Q And those are very common software
19 languages that were used at that period, correct?

20 A Correct. 10:42:06AM

21 Q In connection with this joint project were
22 you responsible for managing the work of
23 Mr. Athanassiou?

24 A In a technical sense.

25 Q Can you explain? 10:42:25AM

1 A In terms of what the mathematics is and 10:42:26AM
2 how it should go and how it should be implemented,
3 how the mathematical problem has to be solved, and
4 once the solution is arrived he was good at
5 implementing it. 10:42:42AM

6 He also has similar kind of background as
7 I do, however, we kind of complemented each other.
8 My larger weight is on the mathematics and the
9 theory side, while his strong points were towards
10 the implementation of the software. 10:43:06AM

11 Q And in the area that you've described as
12 his strengths, what was your general opinion of his
13 competence and ability in those areas?

14 MS. TAUTKUS: Objection, vague.

15 THE WITNESS: He's pretty good. He falls 10:43:34AM
16 about 75 percentile. I would rate him somewhere
17 close to 80 -- 80, 85.

18 BY MR. POPPE:

19 Q And I take it given the fact that you've
20 stayed in contact with him, you've enjoyed working 10:43:49AM
21 with him as a person?

22 A Yes.

23 Q How did you first get in contact or become
24 acquainted with Dr. Greenberger?

25 A When Dr. Kanade suggested me of this 10:44:11AM

1 In one of the initial meetings we were given a tour 11:25:37AM
2 of the hospital where the treatment was being done
3 and so on. That is when I came to know that the
4 University of Pittsburgh Medical Center has linear
5 accelerators that are being used for treating , 11:25:53AM
6 radiation -- treating cancer patients. But I do not
7 recall when we discussed topics such as where it
8 will be implemented at UPMC.

9 BY MR. POPPE:

10 Q At some time in 1994 over the course of 11:26:14AM
11 your actual research work did you begin to work with
12 a Varian linear accelerator in connection with the
13 research that you were doing jointly?

14 MS. TAUTKUS: Objection, vague.

15 THE WITNESS: You say in 1994? 11:26:31AM

16 MR. POPPE: Yes.

17 THE WITNESS: I do not recall what is
18 exact date, but 1994 to my recollection would be a
19 little bit early to have had -- to having at the
20 point of doing anything at UPMC. I don't know when 11:26:51AM
21 we transferred that, but to my best recollection,
22 1994 we were working on still, working on the proof
23 of concept which was all at Carnegie Mellon.

24 BY MR. POPPE:

25 Q Let me broaden the question to the 1994 to 11:27:08AM

1 1996 period preceding the filing of the patent 11:27:12AM
2 applications. At some point during that period did
3 you begin doing -- you meaning you personally in
4 conjunction with other members of this joint
5 research group -- working on a Varian linear 11:27:27AM
6 accelerator in connection with the research?

7 MS. TAUTKUS: Objection, vague, lacks
8 foundation.

9 THE WITNESS: Yes. We set up a system in
10 a room that had the Varian. I believe it was Varian 11:27:43AM
11 linear accelerator. It was one of the linear
12 accelerators. But to the exact date, I do not
13 recall. It was sometime around the time of filing
14 our -- I don't know what was the relationship
15 between the filing of the patent date to the 11:28:09AM
16 approximate time frame of when the system was set up
17 at University of Pittsburgh Medical Center.

18 BY MR. POPPE:

19 Q During that pre-patent application filing
20 period, was there only a single linear accelerator 11:28:26AM
21 that your group worked on in connection with the
22 joint research project?

23 MS. TAUTKUS: Objection, vague.

24 THE WITNESS: Once again, whether it was
25 prior to patent filing or -- as I said, I do not 11:28:39AM

1 have a relative sense of whether our effort of 11:28:45AM
2 moving the system to there was before or after the
3 filing of the patent was. Yes, it was all in one
4 room.

5 BY MR. POPPE: 11:29:04AM

6 Q Can you describe for me what the proof of
7 concept was that you developed --

8 MS. TAUTKUS: Objection, vague.

9 BY MR. POPPE:

10 Q -- that you've referred to in your prior 11:29:14AM
11 testimony?

12 A The proof of concept, finally we chose to
13 focus on three aspects of the radiation oncology
14 solution which culminated in three patents. And as
15 far as the patient positioning is concerned we -- in 11:29:35AM
16 terms of the patient positioning is concerned, we --
17 a table, a writing desk was used as a treatment
18 couch. We bought an inexpensive -- these mannequins
19 from some clothing stores that display clothes as a
20 patient. 11:30:09AM

21 And we attached several markers to make
22 the skin marks that we eventually refined. And we
23 attached some kind of sensors to the walls in our
24 laboratory and a camera on the false roof, the false
25 ceiling, and some kind of black curtain to color or 11:30:35AM

1 to prevent the extra light coming in, and a computer 11:30:38AM
2 connected to the desk.

3 And it was a pretty crude proof of
4 concept, but the idea was to show that we can do it.

5 Q And that happened at Carnegie Mellon? 11:30:55AM

6 A Correct.

7 Q And it was just you and Dr. Kanade
8 preparing that proof of concept?

9 A Later Harry also joined.

10 Q And this was using the existing light 11:31:12AM
11 surface mapping technology that Dr. Kanade had
12 previously developed?

13 MS. TAUTKUS: Objection, vague, assumes
14 facts.

15 THE WITNESS: It was used for -- as I 11:31:30AM
16 said, it was used for an exploratory experiment.

17 However, later we started to more refined technique,
18 which I don't believe involved light stripe surface
19 matching and the initial concept was using cameras,
20 just the regular light projected, and laser 11:32:03AM
21 alignment markers and computer.

22 BY MR. POPPE:

23 Q What do you mean by the regular light
24 projected?

25 A It means an ordinary table lamp attached 11:32:14AM

1 your practice to retain them such as in a file 12:49:38PM

2 somewhere, or would you discard them?

3 MS. TAUTKUS: Objection, vague.

4 THE WITNESS: Both yes or no. If the

5 article was interesting enough, or if the article 12:49:50PM

6 had the content that I would like to refer back

7 again, my primary focus was the concept, the

8 mathematics or anything related to images, image

9 processing and automation of some of these things.

10 And if the article was more focused on 12:50:09PM

11 that part of it, then probably I would have either

12 copied part of it or all of it for my own reference

13 later. But if it was something else I would just

14 read it and pass it on and absorb whatever was

15 necessary. So in that sense, yes, I did both. 12:50:26PM

16 BY MR. POPPE:

17 Q Going back for a moment to the proof of

18 concept, in connection with the aspect that involved

19 determining patient movement from the movement of

20 fiducials on the patient's skin, what was the system 12:50:44PM

21 output that you were -- that you wanted the system

22 to generate that you would then review to see if it

23 was working properly or not?

24 MS. TAUTKUS: Objection, vague.

25 THE WITNESS: I don't recollect exactly 12:51:06PM

1 what the numerical outputs were and how it was 12:51:07PM
2 implemented properly unless I spend a couple of days
3 going through the software and things like that.
4 But conceptually, the image of the markers was
5 processed in order to extract the markers and then 12:51:24PM
6 compare with where they were in the previous time
7 instance.

8 And if it is larger than -- if it is
9 smaller than certain limit, then we declare that the
10 patient has not moved. And if it's larger than this 12:51:39PM
11 limit and another higher limit, then we warn the
12 medical staff that the patient has moved but not
13 significantly, then the medical staff has to decide
14 whether they want to continue or not at a conceptual
15 level. And then if it goes beyond the second limit, 12:52:00PM
16 then we immediately warn the medical staff to stop
17 the radiation and the patient has moved beyond
18 limit. That's our thing.

19 How it was presented, it was presented
20 through graphical user interface. A kind of a side 12:52:18PM
21 bar, I think there is a kind of a schematic in one
22 of the patients. A schematic, a vertical bar on the
23 side with three partitions, and the bottom one three
24 partitions, and as soon as the patient -- when the
25 patient treatment goes on, one of those partitions 12:52:40PM

1 will always be green, it means go ahead. And when 12:52:44PM
2 the patient moves to a second level of disturbance
3 from its correct position, it turns on the next
4 block which turns yellow, then we have both green
5 and yellow, and the next one becomes red when he 12:52:59PM
6 goes beyond that.

7 And for the first one we also provided
8 some auditory feedback, some kind of little ringing
9 from the computer itself, and then when it goes to
10 red the volume increases to alert the medical staff. 12:53:14PM

11 BY MR. POPPE:

12 Q Was the graphical user interface something
13 that your team developed itself?

14 MS. TAUTKUS: Objection, vague.

15 THE WITNESS: Correct. 12:53:28PM

16 BY MR. POPPE:

17 Q Was it built on any type of commercial
18 graphical user interface, or was it built from
19 scratch?

20 A It was C. C language has a couple of 12:53:38PM
21 tools that you can use to generate such visual
22 interfaces.

23 Q Were there any records that your team
24 generated to record the progress of the development
25 to either document what experiments had been 12:54:05PM

1 conducted, or what the results of the experiments 12:54:08PM
2 were, or what further development was necessary,
3 things of that nature?

4 MS. TAUTKUS: Objection, vague, compound.

5 THE WITNESS: Whatever the charts, graphs, 12:54:19PM
6 tables that we produced, and also the summaries that
7 we wrote, we all used to -- UPMC was -- we used to
8 send them to UPMC. And whatever the material that
9 we made and preserved, they should all be in the
10 collection that I left at UPMC. Whatever, the CDs 12:54:41PM
11 and the videos that we did for fundraising and so
12 on.

13 BY MR. POPPE:

14 Q How about the software itself that your
15 team developed, was that at UPMC? 12:55:02PM

16 A Correct.

17 Q And to your knowledge nothing was left
18 behind at Carnegie Mellon in terms of the
19 documentation or the software or videos that you
20 just mentioned? 12:55:15PM

21 A I don't believe we left anything. And
22 eventually whatever the version we had at Carnegie
23 Mellon was the base version that we built on when we
24 moved onto UPMC. So either we copied it and
25 transferred it to the new computer, the new UPMC, or 12:55:34PM

1 we moved the hard drive, or we maintained the same 12:55:40PM
2 box with a new monitor. I mean, probably a
3 combination of the three.

4 Q Was there a particular file room or 12:55:58PM
5 library at UPMC that you knew about where this type
6 of material was kept as of the time that you left?

7 A Actually when I became an employee of the
8 University of Pittsburgh most of material used to be
9 in my office, and my office and the room where we
10 were -- we had the setup made, some of the hardware 12:56:20PM
11 things were all there. Then the computer on a
12 stretcher so that we can move things around easily
13 and so on. But when I left I placed all of them in
14 a box and returned it.

15 Q To Dr. Greenberger? 12:56:39PM

16 A Yes.

17 Q And it all fit in a single box?

18 A The documents I'm talking about, the
19 documents and the videos, the CDs and so on. And
20 the computer that we used were also left in the 12:56:54PM
21 laboratory where we were doing the final
22 experiments. And I think the computer was also
23 placed in a known place, and Dr. Greenberger was
24 informed about the presence of the computer there,
25 but I do not know where that would be right now. 12:57:15PM

1 Q Did the laboratory you just referred to 12:57:19PM
2 where you had been working have a particular name?

3 A I don't think there is any name for it.
4 We just used to call it the lab.

5 Q What facility was it in, a particular 12:57:37PM
6 hospital?

7 A It was in Monti Fiore University Hospital.

8 Q Can you spell that?

9 A M-o-n-t-i, F-i-o-r-e, Monti Fiore
10 Hospital. Monti Fiore University Hospital. It's a 12:57:53PM
11 building where the radiation oncology department is,
12 Dr. Greenberger's office is, Dr. Kalend's office
13 was, and my office was, and laboratory. It's a
14 place where the patients are treated, and also there
15 are laboratories where they do some of these other 12:58:10PM
16 experiments, biological-related --

17 Q Just going back for a moment to something
18 that we were talking about before, for each of the
19 aspects of this project that you were working on,
20 the ultimate output was a computer display to the 12:58:46PM
21 user, is that correct?

22 MS. TAUTKUS: Objection, vague.

23 THE WITNESS: Yes, in some sense. That is
24 the mode of feedback to the humans. The monitor is
25 the feedback to the human. And then what we humans 12:59:09PM

1 let's use them, and then since you have the in-house 2:43:53PM
2 expertise here, we will set up the initial proof of
3 concept test here and so on.

4 Q So for the phase of development up through 2:44:24PM
5 the filing of the patent applications, what was the
6 source of funding?

7 MS. TAUTKUS: Objection, vague.

8 THE WITNESS: I do not recall the exact 2:44:41PM
9 demarcation, however, we were initially Carnegie
10 Mellon was supporting my time and Dr. Kanade's time
11 and also Harry Athanassiou's time, and of course
12 both Harry and my salaries were coming from Carnegie
13 Mellon. And how our time was divided depends on the
14 superior that we reported to, and in that sense
15 Carnegie Mellon paid for our time, and André Kalend 2:45:05PM
16 and Joel Greenberger's time was paid by University
17 of Pittsburgh.

18 BY MR. POPPE:

19 Q And where did funding for equipment that 2:45:16PM
20 you used on the project come from?

21 MS. TAUTKUS: Objection, vague.

22 THE WITNESS: The equipment we initially
23 used as I shared in one of my previous discussions
24 were computers, since some of these were unwanted
25 from other projects. And primarily whatever we 2:45:34PM

1 STATE OF CALIFORNIA)
2 : ss
3 COUNTY OF SAN FRANCISCO)
4

5 I, the undersigned, a Certified Shorthand
6 Reporter of the State of California, do hereby certify:

7 That the foregoing proceedings were taken before
8 me at the time and place herein set forth; that any
9 witnesses in the foregoing proceedings, prior to
10 testifying, were placed under oath; that a verbatim record
11 of the proceedings was made by me using machine shorthand
12 which was thereafter transcribed under my direction;
13 further, that the foregoing is an accurate transcription
14 thereof.

15 I further certify that I am neither financially
16 interested in the action nor a relative or employee of any
17 attorney of any of the parties. IN WITNESS WHEREOF, I
18 have this date subscribed my name.

19 Dated: August 31, 2007

20 R Posner
21

22 RICK POSNER CSR No. 5040
23
24
25

EXHIBIT B

FOR ATTORNEYS' EYES ONLY

1 IN THE UNITED STATES DISTRICT COURT FOR THE
2 WESTERN DISTRICT OF PENNSYLVANIA

3 UNIVERSITY OF PITTSBURGH,)
4)
5 Plaintiff,)
6) Case No.
7 -vs-) 07-CV-0791 (AJS)
8 VARIAN MEDICAL SYSTEMS, INC.,)
9)
10 Defendant.)

ORIGINAL

11 - - - -
12 CONFIDENTIAL - ATTORNEYS' EYES ONLY
13 - - - -

14 VIDEOTAPE DEPOSITION OF: JOEL GREENBERGER, M.D.
15 - - - -
16

17 DATE: September 21, 2007
18 Friday, 9:05 a.m.

19 LOCATION: PICADIO SNEATH
20 MILLER & NORTON
21 4710 U.S. Steel Tower
600 Grant Street
Pittsburgh, PA 15219

22 TAKEN BY: Defendant
23

24 REPORTED BY: Heidi H. Willis, RPR, CRR
25 Notary Public
AKF Reference No. HW03100

1 VIDEOTAPE DEPOSITION OF JOEL GREENBERGER, M.D.,
2 a witness, called by the Defendant for examination,
3 in accordance with the Federal Rules of Civil
Procedure, taken by and before Heidi H. Willis, RPR,
CRR, a Court Reporter and Notary Public in and for
the Commonwealth of Pennsylvania, at the offices of
Picadio Sneath Miller & Norton, 4710 U.S. Steel
Tower, Pittsburgh, Pennsylvania, on Friday, September
21, 2007, commencing at 9:05 a.m.

6

- - - -

7

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33 ALSO PRESENT:

34 Tnaya Witmer, Videographer

35

1

- - - -

2

PROCEEDINGS

3

- - - -

4

THE VIDEOGRAPHER: Good morning.

5

My name is Tnaya Witmer. I'm the videographer on behalf of AKF Court Reporters located at 436 Boulevard of the Allies, Pittsburgh, Pennsylvania.

6

Today is September 21st, 2007. This is the deposition of Dr. Joel Greenberger in the case of the University of Pittsburgh versus Varian Medical Systems, Inc.

7

The time is 9:06 a.m. If the court reporter would please swear in the witness, we may begin the deposition.

8

JOEL GREENBERGER, M.D.,
being first duly sworn,
was examined and testified as follows:

9

- - - -

10

MR. POPPE: And before we begin, John, do you want to note what you noted to me right before we started?

11

MR. ZELE: Yes. Today is Yom Kippur, starts at sundown tonight. Dr. Greenberger has

1 to leave today at 5 p.m., and to the extent
2 that there's any time remaining for the seven
3 hours for the deposition, Dr. Greenberger will
4 come back for that remaining time.

5 MR. POPPE: Okay.

6 - - - -

7 EXAMINATION

8 - - - -

9 BY MR. POPPE:

10 Q. Dr. Greenberger, my name is Matt Poppe. I'm an
11 attorney for Varian Medical Systems. Thank you
12 for being here today.

13 Have you ever been deposed before?

14 A. Yes.

15 Q. On how many occasions?

16 A. I can't give you an exact answer. Approximate?

17 Q. Approximate is fine.

18 A. 15.

19 Q. Have -- what was the most recent time before
20 today?

21 A. Two to three years ago.

22 Q. Have any of those instances been in your
23 capacity as a retained expert for a party in
24 litigation?

25 A. Yes.

1 source code in connection with the development
2 of the device associated with the patents in
3 this case?

4 MR. ZELE: Objection, vague, assumes
5 facts not in evidence.

6 A. Did I write the source code, could you just
7 clarify what you mean by that? Was I -- you
8 are asking me if I was at the computer typing
9 in?

10 Q. Right.

11 A. I'm sorry, I don't understand.

12 Q. That's what I mean.

13 A. No.

14 Q. To your knowledge were any of the inventors,
15 meaning Dr. Kalend, Shimoga, Kanade and
16 Mr. Athanassiou -- sorry, let me restate that.

17 To your knowledge did any of those
18 inventors personally write source code for the
19 device associated with the patents in this
20 case?

21 MR. ZELE: Objection, vague, assumes
22 facts not in evidence.

23 A. Yes.

24 Q. Which of them?

25 A. Any and potentially all of them.

1 Q. Did you personally supervise any computer
2 programmers other than those four inventors in
3 the development of source code for the project
4 associated with the patents?

5 MR. ZELE: Objection, vague,
6 misstates testimony, assumes facts not in
7 evidence.

8 A. No.

9 Q. To your knowledge did any of the other
10 inventors directly supervise any such computer
11 programmers?

12 MR. ZELE: Objection, vague.

13 A. No.

14 Q. Are you aware of anyone other than five named
15 inventors writing any source code for the
16 project associated with the patents in this
17 case?

18 MR. ZELE: Objection, vague.

19 A. No.

20 Q. Do you know if any of the source code written
21 for the device associated with the patents in
22 this case still exists?

23 MR. ZELE: Objection, vague,
24 misstates testimony, assumes facts not in
25 evidence.

1 A. You are asking me if I'm aware that it still
2 exists; is that correct?

3 Q. Correct.

4 A. I believe it still exists. I have no knowledge
5 that would suggest that it does not exist.

6 Q. Do you have a belief as to where that source
7 code is stored?

8 A. No.

9 Q. Was there ever a time when you knew where that
10 source code was stored?

11 MR. ZELE: Objection, vague.

12 A. During the time the experiments were being
13 performed, the inventors doing the experiments
14 are collecting the data and storing it at the
15 Robotics Institute at CMU or in the offices of
16 the physicists at Presbyterian University
17 Hospital or in the linear accelerator room in
18 which the experiments were being carried out
19 with the equipment. So during the period up to
20 and including submission of the patents, that's
21 where it was.

22 During the time after submission and
23 allowance of the patents and during the time
24 more data was being collected, I expect it was
25 still in those places.

1 Q. Earlier you mentioned a box of material that
2 was provided to you by Dr. Shimoga; is that
3 correct?

4 A. Yes.

5 Q. What was the occasion that prompted him to give
6 you that box?

7 A. He was leaving Pittsburgh.

8 Q. He was an employee of the University of
9 Pittsburgh at that time?

10 MR. ZELE: Objection, calls for legal
11 conclusion and vague.

12 A. It's a complicated answer because as you define
13 employee, it involves his capacity as a faculty
14 member at Carnegie Mellon University working on
15 a contract funded by a contract from, at that
16 time, Elekta Oncology Systems, which was
17 running through University of Pittsburgh.

18 I am not aware of whether his
19 paycheck was a CMU or University of Pittsburgh
20 paycheck. I'm also not aware of whether he
21 considered himself a CMU employee being
22 contracted to the University of Pittsburgh or,
23 in fact, a University of Pittsburgh employee.

24 So I can't give you an honest, succinct answer.

25 Q. Are you aware of a sequence of events in which

1 gave you that box of materials?

2 A. No.

3 Q. At that point in time, do you know where the
4 source code we were discussing earlier was
5 located?

6 A. No.

7 Q. Did Dr. Shimoga tell you when he left
8 Pittsburgh where the source code was located?

9 MR. ZELE: Objection, vague.

10 A. I don't recall.

11 Q. Are you currently employed by the University of
12 Pittsburgh?

13 A. Yes.

14 Q. Are you currently employed by UPMC?

15 A. Yes.

16 Q. Do you currently have any other employers?

17 A. I'm trying to answer precisely and
18 specifically, and with regard to my income tax
19 return, I am required to list sources of
20 income. As such, those people are employers,
21 so to give you a fair answer, I should include
22 all of those. Do you want to hear all of
23 those? I'm sorry to ask you a question.

24 Q. I'd like to know the list of employers for whom
25 you regularly perform work on a day-to-day

1 basis in exchange for compensation?

2 MR. ZELE: Objection, vague.

3 A. Please define compensation.

4 Q. Money.

5 A. That would be limited to, as defined by you, on
6 a day-to-day basis, University of Pittsburgh
7 and University of Pittsburgh Medical Center.

8 Q. Is there a particular department within the
9 University of Pittsburgh in which you are
10 employed?

11 A. Yes.

12 Q. What is that?

13 A. The department of radiation oncology.

14 Q. Do you have a title in your job with that
15 department?

16 A. Yes.

17 Q. What is that title?

18 A. Professor and chairman of the department of
19 radiation oncology at the University of
20 Pittsburgh Medical Center and Claude,
21 C-L-A-U-D-E, Worthington,
22 W-O-R-T-H-I-N-G-T-O-N, Benedum, B-E-N-E-D-U-M,
23 professor of radiation oncology.

24 Q. How long have you had those titles?

25 A. Since 1993.

1 (The witness reviewed the Exhibit.)

3 A. Yes, I recognize it.

4 Q. And is this one of the three patents that you
5 and the other inventors obtained in connection
6 with a general project that is associated with
7 this case?

8 | A. Yes.

10 (Exhibit Nos. 3 and 4 marked for identification.)

12 MR. ZELE: What's that one, the '554?
13 No. 3, okay.

14 BY MR. POPPE:

15 Q. Dr. Greenberger, do you now have in front of
16 you an exhibit marked Exhibit 3?

17 A. Yes.

18 Q. What is the patent number on that exhibit?

19 A. 5,727,554.

20 Q. And do you also have a document labeled Exhibit
21 4 in front of you?

22 A. Yes.

23 Q. And is that U.S. Patent No. 5,784,431?

24 A. Yes.

25 Q. Please take a moment to briefly review Exhibits

1 3 and 4, as I'm going to ask you the same
2 questions I did for Exhibit 2.

3 - - - -

4 (The witness reviewed the Exhibits.)

5 - - - -

6 Q. Are you familiar with -- I'm sorry, have you
7 had a chance now to review briefly Exhibits 3
8 and 4?

9 A. Yes.

10 Q. Do you recognize them?

11 A. Yes.

12 Q. And are these the other two patents associated
13 with the project that's related to this case?

14 MR. ZELE: Objection, vague.

15 A. Please define the project.

16 Q. Well, is there a project that you would
17 identify in any particular way in your own mind
18 pursuant to which you obtained the three
19 patents labeled Exhibits 2, 3 and 4?

20 A. Yes.

21 MR. ZELE: Objection.

22 A. Yes.

23 Q. And is there a term or a phrase that you would
24 use to describe that project?

25 A. This is --

1 MR. ZELE: Objection, calls for
2 speculation.

3 A. These three patents represent three pieces of a
4 program in development of dynamic conformal
5 radiotherapy. Those were the words we used at
6 the time, and these three patents represent
7 milestones, achievements along that pathway.

8 Q. What did you mean when you used the word
9 "program?" You said represent three pieces of
10 a program in the development of dynamic and
11 formal -- conformal radiotherapy?

12 A. I think we need to be very clear about words
13 and language, because it is now year 2007, and
14 the words we used in 1993 through 1998 meant
15 different things than they mean today with
16 respect to radiotherapy, radiotherapy physics.

17 So program to me means a collection
18 of scientists physicists, robotics engineers,
19 software engineers and physicians, in my case,
20 me, physician, who were dedicated to working
21 toward a common goal, which was at that time
22 developing what we termed dynamic conformal
23 radiotherapy, and those words in 1993, dynamic
24 conformal radiotherapy, do not mean what they
25 mean in 2007. So I hope I answered your

1 question.

2 Q. Just to find a shorthand way of referring to
3 the body of research that you and the other
4 inventors did leading up to the three patents,
5 can I refer to that as the dynamic conformal
6 radiotherapy project?

7 MR. ZELE: Objection, vague.

8 A. The dynamic conformal radiotherapy program as
9 it existed from the time I met Andre Kalend,
10 extending forward and including the time that I
11 met Takeo Kanade, Karun Shimoga and
12 Dr. Athanassiu and leading up to these
13 patents, we referred to that as the dynamic
14 conformal radiotherapy program.

15 MR. ZELE: We've been going an hour
16 again. We can take a break.

17 THE VIDEOGRAPHER: We've been going
18 34 minutes.

19 MR. ZELE: 34 minutes on your tape,
20 but we were going before that.

21 THE VIDEOGRAPHER: The time is 11:12
22 a.m. We are off the record.

23 - - - -

24 (There was a recess in the proceedings.)

25 - - - -

1 associate this assignment with the patent, '554
2 patent that's been marked Exhibit 3?

3 MR. ZELE: Objection, vague.

4 A. Yes.

5 Q. And by signing this document, is it correct
6 that you intended to assign your rights in the
7 patent application associated with the '554
8 patent and the related invention to the
9 University of Pittsburgh of the Commonwealth
10 System of Higher Education?

11 MR. ZELE: Objection, calls for legal
12 conclusion.

13 A. At this time, August 28th, 1996, to the best of
14 my recollection, University of Pittsburgh and
15 Carnegie Mellon University had a joint research
16 agreement in place, and we agreed, the
17 inventors from Pitt and the inventors from CMU
18 agreed to use the Pitt assignment sheet. So to
19 the best of my recollection, this is what we
20 decided to do.

21 Q. So I'm not clear then whether it was your
22 intent when you signed this agreement to assign
23 your rights to the patent application and
24 invention to the University of Pittsburgh.
25 I'll ask you to clarify, please.

1 recall his involvement in either of the two
2 previously mentioned interactions with Varian.

3 Q. Are you familiar with the name Reed McManigle?

4 A. Yes.

5 Q. Do you know if he was involved in
6 communications with Varian on behalf of the
7 University of Pittsburgh regarding the patents
8 on either of the two occasions that you
9 mentioned?

10 A. Reed McManigle left the University of
11 Pittsburgh several years ago. He was the
12 attorney in the technology transfer office who
13 helped with the negotiation for licensing of
14 these patents early on, and we are at 1998,
15 1996 through 1998. I don't recall his
16 involvement in the first occasion. That would
17 have been the only one. The second was after
18 he had left.

19 Q. On the first of those two occasions, do you
20 know which party, and I'm referring to either
21 Varian or the University of Pittsburgh,
22 initiated the discussions between Varian and
23 the University of Pittsburgh regarding the
24 patents?

25 A. I do not.

1 1994 in some animal laboratory research, but he
2 chose to go into full-time clinical practice,
3 went out to our facility in Kittanning,
4 Pennsylvania, very quickly.

5 Edward Mullen left the department
6 within months of the time this memo was
7 written, went into private practice in eastern
8 Pennsylvania where he still practices.

9 Q. And you listed them in this document because
10 you expected them to be involved solely in the
11 second approach listed in this document?

12 MR. ZELE: Objection, vague.

13 A. No.

14 Q. So there was a point in time at which you did
15 anticipate that one or both of them would be
16 involved in the dynamic conformal radiation
17 therapy program?

18 A. No.

19 MR. ZELE: Objection, misstates the
20 testimony.

21 A. I'm sorry, I said no.

22 Q. Why were they identified in the last paragraph
23 as co-investigators on this project?

24 A. At the time the memo was written, I was putting
25 together a program with multiple projects, a

1 lung cancer program, and I was trying to enlist
2 the help of the radiation oncologists who were
3 then in Pittsburgh practicing at Presbyterian
4 University Hospital where we would be building
5 the dynamic conformal radiation therapy
6 program.

7 Drs. Kalend and Mullen expressed
8 interest, and so I wrote their names on the
9 paper to give them support as potential
10 collaborators. Unfortunately neither of them
11 involved themselves in any way with the dynamic
12 conformal radiation therapy program, and as I
13 mentioned, Dr. Rosenstein briefly expressed
14 interest and did some work in the gene therapy
15 program but then requested to move into
16 full-time practice.

17 Q. In your earlier answer you referred to
18 Dr. Kalend and Mullen. Did you mean Dr. Mullen
19 and Dr. Rosenstein?

20 A. In my answer I referred to Dr. Mullen and
21 Dr. Rosenstein. Of course Dr. Kalend stayed
22 and became active long term in the department.

23 - - - -

24 (Exhibit No. 15 marked for identification.)

25 - - - -

1 Q. You've been handed Exhibit 17, two-page
2 document produced by the University of
3 Pittsburgh in this case, Bates Nos. PITT 1879
4 to 1880. Take a moment to review and let me
5 know if you recognize this document.

6 - - - -

7 (The witness reviewed the Exhibit.)

8 - - - -

9 A. Yes.

10 Q. This is a memorandum from you to Dr. Kalend;
11 correct?

12 A. Yes.

13 Q. And it's dated July 15th, 1993?

14 A. Yes.

15 Q. And you have initialed the document next to
16 your name in the from line; correct?

17 A. Yes.

18 Q. Do you see where it refers to applying for
19 matching funds from Westinghouse Corporation in
20 the first paragraph?

21 A. Yes.

22 Q. Did you, in fact, submit such an application?

23 A. No.

24 Q. Why not?

25 A. At this stage I was searching for money to fund

1 our research, and I cast the net very wide. I
2 was following up every lead, and I was
3 documenting as many leads as I could in memos
4 like this.

5 At the same time I was putting
6 together the team which ultimately resulted in
7 the inventors on these patents. In the early
8 phases, I was looking at multiple
9 opportunities.

10 I remember this whole process because
11 Ken McCarty was present at a poster session
12 which Dr. Kalend and I gave at the Pittsburgh
13 Cancer Institute retreat, which is referred to
14 on the second page, second paragraph from the
15 bottom, at the PCI regional advisory committee
16 retreat; and Dr. Kalend and I disclosed to Ken
17 McCarty at the poster session what we were
18 planning to do, and shortly after or maybe even
19 before this memo, I don't remember exactly,
20 disclosures of the idea, the invention, the
21 creation of the idea were sent to the
22 technology transfer office of the University of
23 Pittsburgh, and I believe Dr. McCarty, Ken
24 McCarty was one of the people cited, person to
25 whom the invention was first disclosed.

1 During the course of the disclosure
2 to him, what we were doing or planning to do,
3 our conception, our invention, he reported to
4 me his work with Westinghouse; and, in fact,
5 one of the beautiful things about Pittsburgh in
6 1993 and still today is the tremendous number
7 of private companies and enterprises that are
8 interested in collaborating with the
9 university. So this was one of the ones I
10 thought we could pursue. It just didn't work
11 out.

12 Q. Is Dr. McCarty still at the University of
13 Pittsburgh?

14 A. I believe he is.

15 MR. ZELE: Objection, calls for
16 speculation.

17 A. I don't know for sure. I believe he is.
18 - - - -
19 (Exhibit No. 18 marked for identification.)
20 - - - -

21 Q. You've been handed Greenberger Exhibit 18,
22 which is a document produced by Dr. Kanade
23 pursuant to a subpoena in this case with Bates
24 Nos. KAN 19 through 42.

25 Is this a document written by you and

1 was your first contact with Dr. Kanade?

2 MR. ZELE: Objection, calls for
3 speculation.

4 A. Not necessarily. While I customarily
5 documented meetings shortly around the time of
6 the meeting, other times documentation was a
7 bit delayed. I don't know for sure.

8 Q. This document refers to, in the last paragraph
9 on the first page, a collaborative arrangement
10 with Varian Corporation. Do you see that?

11 A. Yes.

12 Q. What is that referring to?

13 A. During this period -- and please understand by
14 "this period" I mean late 1993, early 1994 --
15 we were exploring the addition to our team of a
16 corporate partner, and since our technology
17 that we were developing was going to be a
18 retrofit technology, by that I mean we were not
19 going to be building a new linear accelerator,
20 we were not going to take the strategy that
21 Acura took by designing a machine on a robot
22 arm, rather we were going to use existing
23 linear accelerator structure, we were looking
24 for a corporate -- a vendor, partner.

25 And during this time period I was

1 speaking to members of Varian Corporation,
2 letting them know what we wanted to do and
3 then, under confidentiality, sharing with them
4 in greater detail what we were planning to do.

5 At the time this letter was written
6 and at the time that Dr. Kalend and I were
7 speaking with Dr. Kanade, we were hoping that
8 our partner in this could be Varian.

9 Q. Why Varian?

10 A. Number of reasons. One was that I was most
11 familiar and comfortable with Varian. I had
12 trained on their equipment as a resident. I like
13 like the structure of the equipment. I like
14 the company. I like the service. I like the
15 people I've met. That's one reason.

16 Another reason was we were designing
17 something that was revolutionary, that no one
18 else was doing. We wanted a partner who could
19 get that fast tracked and commercialized
20 quickly, because as the pieces were coming
21 together and as we assembled our team, we knew
22 that the resources we had in Pittsburgh and the
23 people would allow us to move quickly.

24 And since Varian at that time in 1993
25 had the dominant share of radiation oncology

1 facilities, Varian was selling more machines,
2 more equipment in the United States than either
3 Siemens or Phillips or Sagittaire or any of the
4 others at the time, we thought this would be an
5 ideal partnership.

6 Another reason was they expressed
7 interest and what I thought to be at the time
8 to be a genuine, honest, collegial interest,
9 friendly, collaborative, cooperative interest.

10 Q. When you said what you thought to be at the
11 time, did that view change?

12 MR. ZELE: Objection, vague.

13 A. To some extent.

14 Q. In what way?

15 A. Collegial, cooperative partner did not
16 materialize.

17 Q. In what way did you want them to be a partner,
18 "them" being Varian?

19 MR. ZELE: Objection, vague.

20 A. We were looking for a corporate partner, a
21 partner that manufactured and delivered
22 state-of-the art linear accelerators and a
23 partner that wanted to share our vision of how
24 such research should be carried out, namely the
25 research and development would be at the

1 University of Pittsburgh, and then what
2 materialized was CMU and the University of
3 Pittsburgh.

4 We wanted a partner who would come in
5 and recognize that the intellectual property
6 was ours, that the invention was ours, that the
7 reduction to practice, while being carried out
8 using in some capacity their equipment, would
9 be recognized as being collaborative and shared
10 technology.

11 We wanted a partner who would fund a
12 major part of the research, meaning salaries --
13 funding meaning equipment salaries, support,
14 materials, and fund with the understanding that
15 the intellectual property coming out of that
16 collaboration would be collaborative and
17 jointly owned.

18 MR. ZELE: I just want to point out
19 that by my clock it's about 5:00, and
20 Dr. Greenberger, as we pointed out before, has
21 a religious obligation.

22 If you are about done, Matt, I don't
23 know if you are or not but -- not done by a
24 long shot, huh? All right. But I think
25 Dr. Greenberger is going to have to go to

1 COMMONWEALTH OF PENNSYLVANIA) CERTIFICATE
 2 COUNTY OF ALLEGHENY) SS:

3 I, Heidi H. Willis, RPR, CRR, a Court Reporter
 4 and Notary Public in and for the Commonwealth of
 5 Pennsylvania, do hereby certify that the witness,
 6 JOEL GREENBERGER, M.D., was by me first duly sworn to
 7 testify to the truth; that the foregoing deposition
 8 was taken at the time and place stated herein; and
 9 that the said deposition was recorded
 10 stenographically by me and then reduced to printing
 11 under my direction, and constitutes a true record of
 12 the testimony given by said witness.

13 I further certify that the inspection, reading
 14 and signing of said deposition were NOT waived by
 15 counsel for the respective parties and by the
 16 witness.

17 I further certify that I am not a relative or
 18 employee of any of the parties, or a relative or
 19 employee of either counsel, and that I am in no way
 20 interested directly or indirectly in this action.

21 IN WITNESS WHEREOF, I have hereunto set my hand
 22 and affixed my seal of office this 1st day of
 23 October, 2007.



24
 25
 COMMONWEALTH OF PENNSYLVANIA
 Notary Public
 Heidi H. Willis, Notary Public
 City Of Pittsburgh, Allegheny County
 My Commission Expires July 8, 2008

EXHIBIT C

1 IN THE UNITED STATES DISTRICT COURT FOR THE
2 WESTERN DISTRICT OF PENNSYLVANIA

3 UNIVERSITY OF PITTSBURGH,)
4)
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ORIGINAL

13 VIDEOTAPE DEPOSITION OF: ANDRE KALEND, Ph.D.

16 DATE: October 5, 2007
17 Friday, 9:02 a.m.

18 LOCATION: LAKEVIEW RESORT
19 One Lakeview Drive
 Morgantown, WV 26508

20 TAKEN BY: Defendant

22 REPORTED BY: Heidi H. Willis, RPR, CRR
23 Notary Public
 AKF Reference No. HW03549

1 VIDEOTAPE DEPOSITION OF ANDRE KALEND, Ph.D.,
2 a witness, called by the Defendant for examination,
3 in accordance with the Federal Rules of Civil
4 Procedure, taken by and before Heidi H. Willis, RPR,
5 CRR, a Court Reporter and Notary Public in and for
the Commonwealth of Pennsylvania, at the Lakeview
Resort, One Lakeview Drive, Morgantown, West
Virginia, on Friday, October 5, 2007, commencing at
9:02 a.m.

6

- - - -

7

8 APPEARANCES:

9 FOR THE PLAINTIFF:

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17 M. Brendan Smith, Esq.
18 ORRICK HERRINGTON & SUTCLIFFE, LLP
19 666 Fifth Avenue
20 New York, NY 10103-0001
21 212-506-5298
22 mbsmith@orrick.com

19

20

21 ALSO PRESENT:

22 Geoff Broz, Videographer

23

24

25

1

- - - -

2

PROCEEDINGS

3

- - - -

4

THE VIDEOGRAPHER: Good morning. My

5

name is Geoff Broz. I am the videographer on
behalf of AKF. Today is Friday, October 5th,
2007. The time is now 9:02 a.m.

8

We are here at the Lakeview Golf
Resort to take the deposition of Dr. Andre
Kalend in the case of University of Pittsburgh
versus Varian Medical Systems, Inc., in the
United States District Court of the Western
District of Pennsylvania, Case No. 07-CV-0791
(AJS).

15

If the court reporter would swear in
the witness, we can begin the deposition.

17

18

ANDRE KALEND, Ph.D.,

19

being first duly sworn,

20

was examined and testified as follows:

21

- - - -

22

EXAMINATION

23

- - - -

24

BY MR. ANTHONY:

25

Q. Good morning, Dr. Kalend.

1 A. Good morning, sir.

2 Q. Have you ever had your deposition taken before?

3 A. No, sir.

4 Q. Has counsel for University of Pittsburgh
5 explained to you the process?

6 A. Yes.

7 Q. I'll be asking you --

8 MR. ZELE: I just want to note for
9 the record, this is John Zele of Morgan Lewis &
10 Bockius, and I'm representing Dr. Kalend today.

11 Q. And you are being represented by Mr. Zele here?

12 A. Yes.

13 Q. Now, I'll be asking you questions, Doctor, and
14 you should give me answers unless you are
15 instructed otherwise by your counsel. He may
16 object from time to time; that's his job. If
17 he doesn't tell you not to answer, you should
18 go ahead and answer.

19 Do you understand that?

20 A. Yes.

21 MR. ZELE: You should look at the
22 camera. It's going to be hard, but you are
23 going to have to look at the camera so --

24 THE WITNESS: I wish he was sitting
25 over there. That would be easier for me.

1 | please?

2 A. Yes, I will.

3 Q. And would you agree it's fair that if you do
4 answer a question, we can assume that you
5 understood the question?

6 A. That's correct, yes.

7 MR. ZELE: He had his own
8 understanding of the question but --

9 Q. In the proceeding today, you are the most
10 important person in this room. If you need a
11 break for any reason, just let us know, we'll
12 take the break. If you need anything for any
13 reason, let us know, we'll accommodate you. Is
14 that fair enough?

15 A. Yes.

16 Q. Could you give us your home address, full name
17 and home address, please?

18 A. My name is Dr. Andre Kalend, and I live on 4500
19 Laurel Ridge Lane, Morgantown, West Virginia.

20 Q. Dr. Kalend, are you currently employed?

21 A. Yes, I'm on faculty at West Virginia
22 University.

23 Q. Okay. And what is your position on the faculty
24 at West Virginia University?

25 A. I'm a full professor of radiology.

1 radiation oncology.

2 Q. And how long were you at Stony Brook?

3 A. I was at Stony Brook until '88, and then I was
4 offered a position at the University of
5 Pittsburgh Presbyterian Hospital.

6 Q. And how long were you at the University of
7 Pittsburgh?

8 A. From late '88, '89 till 2000, 2001.

9 Q. And you've been at the West Virginia University
10 since then?

11 A. Yes, sir.

12 Q. Have you received any awards for your work in
13 oncology, radiation oncology?

14 A. The NSF -- no, the NIH fellowship was an award,
15 was awarded to those who were capable and
16 excellent to be able to conduct both research
17 and clinical research.

18 I've had small grant from the
19 American Cancer Society. I had large grant
20 from the Whittaker Foundation. I had small
21 grant from Siemens. That's with the -- with a
22 senior investigator at Tufts. I've had part of
23 the overall larger grant be a investigator
24 under the Benedum grant at Pitt for boron
25 neutron contratherapy.

1 COMMONWEALTH OF PENNSYLVANIA) CERTIFICATE

2 COUNTY OF ALLEGHENY) SS:

3 I, Heidi H. Willis, RPR, CRR, a Court Reporter
4 and Notary Public in and for the Commonwealth of
5 Pennsylvania, do hereby certify that the witness,
6 ANDRE KALEND, Ph.D., was by me first duly sworn to
7 testify to the truth; that the foregoing deposition
8 was taken at the time and place stated herein; and
9 that the said deposition was recorded
10 stenographically by me and then reduced to printing
11 under my direction, and constitutes a true record of
12 the testimony given by said witness.

13 I further certify that the inspection, reading
14 and signing of said deposition were NOT waived by
15 counsel for the respective parties and by the
16 witness.

17 I further certify that I am not a relative or
18 employee of any of the parties, or a relative or
19 employee of either counsel, and that I am in no way
20 interested directly or indirectly in this action.

21 IN WITNESS WHEREOF, I have hereunto set my hand
22 and affixed my seal of office this 15th day of
23 October, 2007.



24

25

COMMONWEALTH OF PENNSYLVANIA	
Notary Public	
Heidi H. Willis, Notary Public	
City Of Pittsburgh, Allegheny County	
My Commission Expires July 8, 2008	

Member, Pennsylvania Association Of Notaries

EXHIBIT D

FOR ATTORNEYS' EYES ONLY

1 IN THE UNITED STATES DISTRICT COURT FOR THE
WESTERN DISTRICT OF PENNSYLVANIA

4 UNIVERSITY OF PITTSBURGH,)
5 Plaintiff,)
6) Case No.
7 -vs-) 07-CV-0791 (AJS)
8 VARIAN MEDICAL SYSTEMS, INC.,)
9 Defendant.)

ORIGINAL

CONFIDENTIAL - ATTORNEYS' EYES ONLY

DEPOSITION OF: TAKEO KANADE, Ph.D.

DATE: September 19, 2007
Wednesday, 9:11 a.m.

LOCATION: PICADIO SNEATH
MILLER & NORTON
4710 U.S. Steel Tower
600 Grant Street
Pittsburgh, PA 15219

TAKEN BY: Defendant.

REPORTED BY: Heidi H. Willis, RPR, CRR
Notary Public
AKF Reference No. HW03098

1 DEPOSITION OF TAKEO KANADE, Ph.D.,
2 a witness, called by the Defendant for examination,
3 in accordance with the Federal Rules of Civil
Procedure, taken by and before Heidi H. Willis, RPR,
CRR, a Court Reporter and Notary Public in and for
the Commonwealth of Pennsylvania, at the offices of
Picadio Sneath Miller & Norton, 4710 U.S. Steel
Tower, Pittsburgh, Pennsylvania, on Wednesday,
September 19, 2007, commencing at 9:11 a.m.

6 - - - -

7 APPEARANCES:

8 FOR THE PLAINTIFF:

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16 FOR CARNEGIE MELLON UNIVERSITY:

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1 TAKEO KANADE, Ph.D.,
2 having been duly sworn,
3 was examined and testified as follows:

4 - - - -

5 EXAMINATION

6 - - - -

7 BY MR. POPPE:

8 Q. Good morning, Dr. Kanade.

9 A. Good morning.

10 Q. Thank you for being here today. My name is
11 Matt Poppe, and I'm one of the attorneys for
12 Varian Medical Systems. You understand that
13 they've been sued by the University of
14 Pittsburgh for patent infringement?

15 A. Yes.

16 Q. Have you ever had your deposition taken before?

17 A. Once.

18 Q. When was that?

19 A. I recall beginning of 2005.

20 Q. And did that have anything to do with patents?

21 A. Yes.

22 Q. What was the case, if you know? Who were the
23 parties?

24 A. As I recall, AT&T, Gateway, Microsoft and Dell.

25 Q. Who was the patent owner, if you know?

1 years.

2 Q. Who were you working for at the time that the
3 collaboration began? Who was your employer?

4 MR. ZELE: Objection, assumes facts
5 not in evidence, compound.

6 A. Carnegie Mellon University.

7 Q. How long had you been working for Carnegie
8 Mellon at that time?

9 A. At that time?

10 Q. Yes.

11 A. I started 1980; therefore, it should be 12, 13,
12 14 years.

13 Q. And were you working for a particular
14 department at Carnegie Mellon from the time
15 period '92 through '94?

16 MR. ZELE: Objection, vague.

17 A. Robotics Institute and Computer Science
18 Institute.

19 Q. Have you been employed by Carnegie Mellon
20 continuously from that point in time until
21 today?

22 MR. ZELE: Objection, vague.

23 A. Correct.

24 Q. And always by the Robotics Institute?

25 A. Correct.

1 strike that.

2 Was it your understanding that you
3 would work alone on those problems?

4 A. Alone means only myself?

5 Q. Yes.

6 A. No.

7 Q. So your understanding was that you would work
8 with other people?

9 A. Yes.

10 Q. Which other people?

11 A. I don't think I gave particular name to him at
12 that meeting.

13 Q. Was the understanding that you and a group of
14 other people affiliated with Carnegie Mellon
15 University would work alone on the solution?

16 A. Together with Dr. Kalend and Dr. Greenberger.

17 Q. So the understanding was that a group of
18 Carnegie Mellon people would work with
19 Dr. Greenberger and Dr. Kalend on a solution?

20 A. That's right.

21 Q. And who did you ultimately get involved in
22 working with you on that project?

23 A. On CMU side?

24 Q. Yes.

25 A. Karun Shimoga first, after a second point, and

then Harry Athanassiou the second. I don't know at which point Harry began to get involved.

4 Q. And was anybody else also involved with you at
5 Carnegie Mellon?

6 MR. ZELE: Objection, vague.

7 A. Not -- later, relatively later stage, as I
8 recall, I used two programmers to program, to
9 do programming task, not necessarily generating
10 the solution.

11 Q. What were their names?

12 A. If my recollection is correct, Raju Patil,
13 either Wei Hua or -- I forgot his name. There
14 were two Chinese students from University of
15 Pittsburgh who were working with me, and it was
16 toward the end of the research, their research,
17 and I -- I believe I encouraged one of them to
18 do the task.

19 Q. To do what task?

20 A. Programming task.

21 Q. And what were the names of those two students?

22 A. Okay. So it should be one of the two, I forgot
23 which one. One is Wei Hua. The other one
24 is -- I think his name is was something like
25 Wu, W-u -- let's see, Y-u-t-e, Yute Wu.

1 COMMONWEALTH OF PENNSYLVANIA) CERTIFICATE

2 COUNTY OF ALLEGHENY) SS:

3 I, Heidi H. Willis, RPR, CRR, a Court Reporter
4 and Notary Public in and for the Commonwealth of
5 Pennsylvania, do hereby certify that the witness,
6 TAKEO KANADE, Ph.D., was by me first duly sworn to
7 testify to the truth; that the foregoing deposition
8 was taken at the time and place stated herein; and
9 that the said deposition was recorded
10 stenographically by me and then reduced to printing
11 under my direction, and constitutes a true record of
12 the testimony given by said witness.

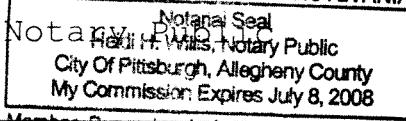
13 I further certify that the inspection, reading
14 and signing of said deposition were NOT waived by
15 counsel for the respective parties and by the
16 witness.

17 I further certify that I am not a relative or
18 employee of any of the parties, or a relative or
19 employee of either counsel, and that I am in no way
20 interested directly or indirectly in this action.

21 IN WITNESS WHEREOF, I have hereunto set my hand
22 and affixed my seal of office this 1st day of
23 October, 2007.



24 COMMONWEALTH OF PENNSYLVANIA



Member, Pennsylvania Association Of Notaries

EXHIBIT E

FOR ATTORNEYS' EYES ONLY

1 IN THE UNITED STATES DISTRICT COURT FOR THE
2 WESTERN DISTRICT OF PENNSYLVANIA

3 - - - - -

4 UNIVERSITY OF PITTSBURGH,)

5)

6)

7 Plaintiff,)

8)

9) Case No.
10 -vs-) 07-CV-0791 (AJS)

11)

12)

13 VARIAN MEDICAL SYSTEMS, INC.,)

14)

15)

16 Defendant.)
17)
18)
19)
20)
21)
22)
23)
24)
25)

CONFIDENTIAL
ATTORNEYS' EYES ONLY

13 CONFIDENTIAL - ATTORNEYS' EYES ONLY

14 - - - - -

15 DEPOSITION OF: ROBERT WOOLDRIDGE

16 - - - - -

17 DATE: September 26, 2007
18 Wednesday, 9:08 a.m.

19 LOCATION: PICADIO SNEATH
20 MILLER & NORTON
21 4710 U.S. Steel Tower
22 600 Grant Street
23 Pittsburgh, PA 15219

24 TAKEN BY: Defendant

25 REPORTED BY: Heidi H. Willis, RPR, CRR
Notary Public
AKF Reference No. HW03223

1 DEPOSITION OF ROBERT WOOLDRIDGE,
2 a witness, called by the Defendant for examination,
3 in accordance with the Federal Rules of Civil
4 Procedure, taken by and before Heidi H. Willis, RPR,
5 CRR, a Court Reporter and Notary Public in and for
the Commonwealth of Pennsylvania, at the offices of
Picadio Sneath Miller & Norton, 4710 U.S. Steel
Tower, Pittsburgh, Pennsylvania, on Wednesday,
September 26, 2007, commencing at 9:08 a.m.

6 - - - -
7

8 APPEARANCES:

9 FOR THE PLAINTIFF:
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20 FOR THE DEFENDANT:
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22 600 Grant Street
Pittsburgh, PA 15219
23 412-288-4000
hsneath@psmn.com
24
25

1 ROBERT WOOLDRIDGE,
2 being first duly sworn,
3 was examined and testified as follows:

5 EXAMINATION

7 BY MR. SNEATH:

8 Q. Good morning. My name is Henry Sneath, and we
9 are here for the purposes of taking your
10 deposition today. I'm going to talk to you a
11 little bit about the rules that govern
12 depositions, although I'm sure your counsel
13 probably has already. Forgive me if I repeat
14 anything that she's told you.

I represent the Defendant, Varian Medical Systems, Incorporated. They are the Defendant in the suit brought by the University of Pittsburgh here in the Western District of Pennsylvania.

20 This is a suit regarding patent
21 infringement, and today I'm going to be asking
22 you questions primarily about documents that
23 have been produced by Carnegie Mellon
24 University.

25 A. Yes, sir.

1 A. Yes, sir.

2 Q. If you need a personal break for whatever
3 reason, please let me know that as well and
4 I'll be happy to accommodate you.

5 A. Thank you.

6 Q. Please state your full name.

7 A. Robert A. Wooldridge.

8 Q. How do you spell your last name?

9 A. W-O-O-L-D-R-I-D-G-E.

10 Q. And what is your current home address?

11 A. 843 North Meadowcroft, M-E-A-D-O-W-C-R-O-F-T,
12 Avenue, Pittsburgh, PA 15216.

13 MR. SNEATH: Off the record.

14 - - - -

15 (There was a discussion off the record.)

16 - - - -

17 BY MR. SNEATH:

18 Q. Mr. Wooldridge, what's your current employment
19 situation?

20 A. I am the director of the Center for Technology
21 Transfer and Enterprise Creation at Carnegie
22 Mellon University.

23 Q. And how long have you been in that position?

24 A. I have been the director for approximately -- I
25 want to say five and a half years. I have been

1 in the Center for Tech Transfer for ten.

2 Q. Okay. And what was your position prior to
3 that?

4 A. I started as a licensing officer in 1997. I
5 progressed to a senior licensing officer
6 approximately two years thereafter, deputy
7 director maybe a year and a half thereafter and
8 then my present position, so essentially the
9 same role.

10 Q. And your current title is director of
11 technology transfer? Did I get that right?

12 A. Director, Center for Technology Transfer and
13 Enterprise Creation.

14 Q. Okay. Are you an officer at the university?

15 A. No, sir.

16 Q. And your employer is Carnegie Mellon
17 University?

18 A. That's correct.

19 Q. And is it fair to state that you have been
20 designated today pursuant to a Notice of
21 Deposition that we served on CMU as the witness
22 to respond to the categories in that notice?

23 A. Yes, sir.

24 Q. We'll get back into that in just a moment.

25 Just, if you would, briefly summarize your

1 BY MR. SNEATH:

2 Q. In preparation for this deposition, did you
3 review the documents that were Bates stamped
4 CMU?

5 A. Yes, sir.

6 Q. Did you review them substantively as in reading
7 them thoroughly, or did you just glance at them
8 to identify them? What did you do?

9 A. I believe I read them substantively.

10 Q. All right. How about with regards to documents
11 that were marked KAN that were Kanade
12 production?

13 A. I did not.

14 Q. Did you look at them at all?

15 A. No, sir.

16 MR. SNEATH: So Dr. Kanade was not
17 identified as a 30(b) (6) deponent pursuant to
18 our deposition notice, nor was anyone other
19 than Mr. Wooldridge.

20 MS. KOSCELNIK: Are you asking that
21 of me?

22 MR. SNEATH: I'm asking it
23 collectively, but whoever can answer is fine
24 with me.

25 MS. KOSCELNIK: Obviously I can

1 answer it. I mean Dr. Kanade was here a week
2 ago all day, and he was deposed, and he was
3 asked a lot of these questions. I realize you
4 weren't here, Mr. Sneath, but he was asked all
5 these questions. So in my considered opinion,
6 Mr. Wooldridge is the appropriate person to
7 respond to this 30(b)(6).

8 MR. SNEATH: It was not asked in the
9 form of a complaint. It was asked in the form
10 of a simple question.

11 MS. KOSCELNICK: Sure.

12 MR. SNEATH: I want to make sure we
13 understand that in terms of responding to the
14 30(b)(6), the only witness that has been
15 designated is Mr. Wooldridge.

16 MS. KOSCELNICK: Sure.

17 MR. SNEATH: All right. Mr. Kanade
18 was independently noticed for deposition in his
19 own name by Varian, and that deposition was
20 taken, and I agree with that. Everybody agrees
21 with that?

22 MS. KOSCELNICK: I don't think anybody
23 could disagree with that.

24 MR. SNEATH: Great. Well, I like to
25 make various obvious statements and then ask

1 MR. SNEATH: Well, that's the way
2 life works though because somebody decided that
3 these were the four people that were going to
4 look for documents; right? I mean that didn't
5 happen all on its own. Somebody made that
6 decision; right? They decided it's going to be
7 these four or it's not going to be six or eight
8 or ten or we are not going to send out a
9 broadcast e-mail to everybody at CMU saying
10 look for documents. Somebody obviously decided
11 that, so I'm assuming that was a decision.

12 MS. KOSCELNIK: You are assuming it
13 was someone other than counsel.

14 MR. SNEATH: Well, I don't know. I
15 just want to ask him if he made the decision.
16 I mean that's not a difficult question.

17 BY MR. SNEATH:

18 Q. Did you make a decision that --

19 A. Did I make a personal decision that those were
20 the departments, I would say no.

21 MS. KOSCELNIK: Okay. That's good.

22 Q. All right. If we could, let's take a look at
23 Exhibit 45, and that would be the subpoena and
24 Notice of Deposition that resulted in you being
25 here today. Do you agree with that?

1 A. Yes, sir.

2 Q. Did you review the deposition topics listed on
3 pages 3, 4 and 5?

4 A. Yes, sir.

5 Q. Were there any of those deposition topics on
6 which you felt you would not be able to provide
7 testimony?

8 And you can take your time and
9 identify any ones, and if you can't identify
10 any ones, then I'm going to assume you are here
11 on all of them. So that's where we are. If
12 you could take your time and do that, I'd
13 appreciate it.

14 If you need to consult with counsel,
15 if you guys want to go out in the hallway, you
16 can do that. I don't want to place an undue
17 burden on you, but I do need to know which ones
18 you are not here to talk about today.

19 A. No, I understand.

20 Q. And that will streamline the deposition.

21 A. I don't believe I can talk about No. 1.

22 Q. Okay.

23 A. Similar to the prior conversation, I don't
24 believe I can talk about No. 2. I believe I
25 can address 3. I believe I can address 4, 5.

1 I believe I can address 6. I can address 7. I
2 suspect I can address 8, 9 --

3 Q. With regard to 8, you say you suspect. Is it
4 you don't understand it perhaps or --

5 A. I'm not sure exactly what assignments executed
6 by named inventors are, but if you can pull
7 those out I certainly --

8 Q. Okay. No. 9?

9 A. Yes, I can address No. 9. I believe I can
10 address No. 10. I can answer questions about
11 11, 12, 13, 14 -- it's answer questions about;
12 correct, sir?

13 MS. KOSCELNIK: Correct.

14 Q. Yes.

15 A. I can address -- I think we stopped at 14, No.
16 15.

17 Q. And by answer questions, the answer wouldn't be
18 to all of them I don't know?

19 A. No, sir.

20 Q. I mean can you provide some testimony on the
21 topic?

22 A. CMU's valuation of the patented inventions, I
23 can tell you we did not do a separate
24 valuation, so that's what I'm saying. It's not
25 a no, it's a finance or substance.

1 Q. 16?

2 A. I have no knowledge of 16. I don't believe I
3 can say all discussions related to, No. 17, all
4 discussions related to the lawsuit. Some of
5 those were between counsel.

6 Q. But would there be some information in 17 you
7 could discuss?

8 MS. KOSCELNIK: You mean is there
9 anything that's not privileged?

10 MR. SNEATH: Well, with all of this
11 it assumes we are talking about nonprivileged.

12 A. If there is nonprivileged information there,
13 yeah.

14 Q. Okay. 18?

15 A. To the extent that there have been those
16 conversations that are not privileged.

17 Q. So the answer to 18 is a yes if it's not
18 privileged?

19 A. Yes, sir, and then 19.

20 Q. 19's a yes?

21 A. Yes, sir, I believe so.

22 Q. Have you given depositions before?

23 A. One.

24 Q. And how long ago was that?

25 A. Eight to ten months.

1 A. Are you saying how it applies to Dr. Kanade?

2 Q. Well, we know that at the time that the
3 inventions were patented, applied for and
4 patented, that more than just Dr. Kanade were
5 employed by CMU; right?

6 A. Yes, sir.

7 Q. Do you know, sitting here today -- and I can
8 show you a patent, at least I'll give you the
9 '554 patent, the front page, looking at the
10 named inventors -- which ones were employed by
11 CMU at the time of the application for that
12 patent in '96? Do you know?

13 A. At the time it was would have been Karun
14 Shimoga, Takeo Kanade, and I'm never going to
15 pronounce the other one.

16 Q. Athanassiu?

17 A. Athanassiu, as I recall.

18 Q. And with regard to the others, do you know
19 where they were employed?

20 A. I could not -- I could not say whether they
21 were University of Pittsburgh or UPMC at the
22 time. In part that's because I don't know if
23 those two were together at that time or
24 separate. I just don't know.

25 Q. But the others had an affiliation, as far as

1 to that.

2 BY MR. SNEATH:

3 Q. Okay. Well, I asked a number of preparatory
4 questions, and I told you to assume that when I
5 ask you if you have any basis on which you can
6 testify to the document, you can take a look at
7 it, you can see whether you were the author,
8 because it may be you authored a document that
9 only Dr. Kanade had a copy of for some reason
10 and maybe he produced it, so maybe you would
11 have a basis to shed some light on what the
12 document is and what it means and so on. So
13 that's implicit in my question.

14 I assume that for Exhibit 2 you have
15 no such knowledge because you've never seen it
16 before in any way; is that correct?

17 A. I have no such knowledge.

18 Q. Okay. Let's look at No. 3. Okay. This is a
19 document from the production of University of
20 Pittsburgh because it has PITT down at the
21 bottom, see that?

22 A. Yes, sir.

23 Q. However it was addressed to Reed McManigle.
24 Can you identify Reed McManigle?

25 A. Reed McManigle is a current employee of

1 Carnegie Mellon Center for Technology Transfer.

2 He has been there for one year approximately.

3 Q. Okay. Do you know who Andre Kalend is? He is
4 CC'd at the bottom.

5 A. It's a gentleman that I associated with either
6 the University of Pittsburgh or UPMC.

7 MS. TAUTKUS: First I'd like to note
8 for the record that the document is an
9 attorneys' eyes only document. Have we put CMU
10 on the protective order in this case?

11 MS. KOSCELNIK: We have signed
12 nothing. There was a protective order that
13 came along with one of the subpoenas I believe.

14 MS. TAUTKUS: CMU is not a party to
15 the protective order, so I assume until we
16 agree to that, any questioning or provision of
17 documents to the witness --

18 MR. SNEATH: Right, I think it was
19 probably because Mr. McManigle was on here, but
20 you are saying he was not employed by CMU back
21 then; right?

22 THE WITNESS: No, sir.

23 MR. SNEATH: Okay. You can just pass
24 that along, put it in the stack right there.

25 Let's take a break real quick.

1 prior to the application dates; isn't that
2 right?

3 A. Correct.

4 Q. Okay. I'm going to show you Exhibit 7.

5 Obviously today we are going to be skipping
6 some numbers based on our earlier discussions,
7 but we are not going to renumber things. They
8 have all been prenumbered, and it's of no
9 consequence.

10 This is CMU 7, and this is a document
11 produced by CMU with Bates stamp Nos. 279 to
12 283. Do you see that?

13 A. Yes, sir.

14 Q. Okay. Can you identify this document?

15 MS. KOSCELNIK: Look through the
16 whole thing.

17 A. I'm sorry. 279 to 283, correct.

18 Q. Can you identify what the document is?

19 A. These are the Policy Guidelines - Intellectual
20 Property Rights and Technology Transfer
21 Procedures in Collaborative Projects of the
22 University of Pittsburgh and Carnegie Mellon
23 University dated September 21, 1994.

24 Q. And it also says just under the heading you
25 read Final Version --

1 A. Yes, sir, sorry.

2 Q. -- written on September 21, 1994. Did I read
3 that right?

4 A. Yes, sir.

5 Q. And this was signed by representatives of both
6 the University of Pittsburgh and CMU, was it
7 not?

8 A. Yes, sir.

9 Q. And those signatures are dated for the
10 University of Pittsburgh October 4, 1994; is
11 that correct?

12 A. Yes, sir.

13 Q. Can you read the name of the signator?

14 A. I cannot.

15 Q. Looks like Ben somebody. Does that ring a
16 bell, Ben anybody?

17 A. I do not recognize the name.

18 Q. In any event, identified as senior vice
19 chancellor for the University of Pittsburgh;
20 right?

21 A. Yes, sir.

22 Q. And for CMU, can you identify that person?

23 A. That is Susan Dunkle, D-U-N-K-L-E.

24 Q. Identified as associate provost, and her
25 signature was placed on here October 13, '94.

1 Do you agree with that?

2 A. Yes, sir.

3 Q. Is she still employed by the university?

4 A. Yes, sir. She is Susan Burkette.

5 Q. Okay. So her current name is Susan Burkette?

6 A. That's correct.

7 Q. This was signed before your tenure at CMU?

8 A. Yes, sir.

9 Q. Are you nonetheless familiar with it because
10 you've had to use it over the years, refer to
11 it over the years?

12 A. Yes, sir.

13 Q. And would it be true that you have referred to
14 it, used it in the regular course of your
15 business as opposed to just looking at it for
16 this deposition?

17 A. Yes, sir.

18 Q. Does this agreement govern the two
19 patents-in-suit?

20 A. I believe it would.

21 MS. TAUTKUS: Objection to the extent
22 it calls for a legal conclusion.

23 Q. And so there's no misunderstanding, when I use
24 the word "govern," I meant that in the broad
25 sense, and I'd ask you if you want to change

1 your testimony, fine, or ask it in a different
2 way, do you believe that this agreement that
3 we've marked CMU 7 is applicable to the two
4 patents-in-suit?

5 MS. TAUTKUS: I have the same
6 objection.

7 Q. You can answer. I mean did you understand what
8 I mean by governed? Is it applicable to the
9 two patents?

10 A. This is the rule set.

11 THE REPORTER: I'm sorry, this is the
12 what?

13 THE WITNESS: The rule set.

14 Q. So your answer is yes? It does relate to and
15 govern these particular patents with regard to
16 the relationship between Pitt and CMU?

17 MS. TAUTKUS: Objection to the extent
18 it calls for a legal conclusion.

19 A. My opinion would be either this one or the
20 renewal.

21 Q. Okay. Fair enough. And let's go right to
22 that. I think I have it, and then we can ask
23 about both of them and the time frames, so CMU
24 9. Why don't we just, as a preparatory matter,
25 identify this, it bears Bates stamp Nos. CMU

1 274 to 278 and is entitled the same thing, it
2 just has a different date under the title of
3 June 6th, 1997. Do you agree with that?

4 A. Say that again, sir?

5 Q. Well, I identified the Bates stamp numbers, 274
6 to 278.

7 A. I heard that.

8 Q. It bears the same title as the previous one we
9 just looked at --

10 A. Oh, yes, sir.

11 Q. -- but it bears a different date of June 6th,
12 1997?

13 A. That's correct.

14 Q. And was this the revision you were talking
15 about?

16 A. Yes, sir.

17 Q. And, again, this one was signed by
18 representatives of both universities in June of
19 '97?

20 A. Yes, sir.

21 Q. The University of Pittsburgh person, can you
22 identify him? James?

23 A. James V. Maher, M-A-H-E-R.

24 Q. Do you know what his title is or was? It's not
25 stated on here.

1 A. He is a vice chancellor or senior vice
2 chancellor of the University of Pittsburgh.

3 Q. His signature is dated June 18th, 1997;
4 correct?

5 A. Correct.

6 Q. And, again, is that Susan Burkette's signature?

7 A. That's correct.

8 Q. And it's dated June the 6th of '97?

9 A. Yes, sir.

10 Q. Do you know what her title was in June of '97?

11 A. Associate provost.

12 Q. And this agreement, is this the one that's
13 currently in operation or --

14 A. No, sir. This is another three-year agreement.

15 Q. So the first one was a three-year term?

16 A. Correct.

17 Q. Exhibit 7?

18 A. Correct.

19 Q. It was renewed for three years in Exhibit 9?

20 A. Yes, sir.

21 Q. And I confess I forgot whether we have other
22 renewals, but do you know whether it has been
23 renewed in subsequent periods after --

24 A. It was not renewed in this form.

25 Q. All right. Was Exhibit 9, was that agreement

1 carried out for a full three years?

2 A. Yes, sir.

3 Q. And was that the last time that this particular
4 version of the agreement was renewed?

5 A. Yes, sir.

6 Q. So following then I presume June of 2000 -- you
7 can correct me if I'm wrong -- was there a new
8 agreement between CMU and Pitt?

9 A. Not in this form.

10 Q. Okay. Well, in what general form? Tell me
11 what you mean by that.

12 MS. KOSCELNIK: Can we just clarify
13 that you are calling these agreements and it
14 says policy guidelines? I just want to clarify
15 for the record that that's what we are talking
16 about, the policy guidelines.

17 MR. SNEATH: Fair enough.

18 BY MR. SNEATH:

19 Q. Where I have used the word "agreement," I was
20 referring to these two documents, Exhibit 7 and
21 9, which are entitled Policy Guidelines. Okay?
22 Do you understand that?

23 A. Yes.

24 Q. You knew what I was talking about; right?

25 A. Yes.

1 Q. All right. Now, after June of 2000, upon the
2 expiration of Exhibit 9, what new agreement, if
3 any, or new policy guidelines, whatever you
4 want to call it, was enacted between the two
5 universities that would govern intellectual
6 property rights?

7 A. The change could be summarized as going from a
8 blanket policy guideline to discrete agreements
9 associated with individual technologies.

10 Q. Okay. Now, with regard to the two
11 patents-in-suit, given that they were applied
12 for in '96 and granted in '98, did either of
13 these two agreements or both relate to those?
14 I think we said the first one did, we agreed
15 with that; right?

16 A. No.

17 Q. No?

18 A. You said did I agree with the first one --

19 Q. Yes.

20 A. -- and I said the first or the second --

21 Q. Got you.

22 A. -- based on the timing.

23 Q. Fine. You tell me which one, if either,
24 applied to the two patents-in-suit.

25 MS. KOSCELNIK: Objection.

1 MS. TAUTKUS: I'm going to object
2 again to the extent it calls for a legal
3 conclusion.

4 Q. Go ahead.

5 A. I don't know that there is a substantive
6 difference between the two.

7 Q. All right, fine.

8 A. Other than the dates.

9 Q. So would these agreements be triggered by an
10 application for a patent? What would trigger
11 the application of these agreements in your
12 understanding?

13 A. A disclosure. These agreements or these
14 guidelines start with the disclosure.

15 Q. Okay. So if we would say hypothetically that a
16 CMU professor disclosed to the university an
17 invention in progress or a thought or an
18 idea --

19 A. Yes, sir.

20 Q. -- would that mere disclosure to the university
21 trigger this agreement?

22 MS. KOSCELMNIK: Objection to the
23 form.

24 Q. Go ahead.

25 A. Are you limiting that, are you -- to clarify,

1 with multiple parties or --

2 Q. I know where you are going. You are right. I
3 gave a bad hypothetical.

4 Let's say hypothetically an employee
5 of CMU and an employee of Pitt disclosed that
6 they had a joint venture project of some kind
7 to develop a certain technology.

8 A. To my office?

9 Q. To your office.

10 A. Yes, sir.

11 Q. Are you saying that that disclosure would
12 potentially trigger the application of these
13 policy guidelines?

14 A. Yes, sir.

15 Q. And are all of the employees of at least CMU,
16 to the best of your knowledge, informed that
17 they need to make such disclosures to the
18 university so that these policy guidelines can
19 be put into effect?

20 A. They are informed.

21 Q. And is that because they are given Exhibit 1
22 that we talked about earlier, Exhibit 1 was the
23 intellectual property policy at CMU, that is
24 widely disseminated to faculty employees, for
25 example, at the university, isn't it?

1 A. It should be distributed both online and
2 faculty handbooks, in multiple ways.

3 Q. All right. So just in theory, people are
4 supposed to be on notice that if you are
5 working on some invention or joint venture, you
6 are to disclose it to your office; correct?

7 A. Yes, sir.

8 Q. And that disclosure the, I am using the word
9 "trigger," but would bring into effect then
10 these policy guidelines if it were a joint
11 project between the two universities; correct?

12 MS. KOSCELNIK: Objection to the
13 form.

14 MS. TAUTKUS: Object, calls for a
15 legal conclusion.

16 Q. You can answer.

17 MS. KOSCELNIK: And are you talking
18 about at the time that these were applicable?

19 MR. SNEATH: Yes, of course.

20 Q. Go ahead.

21 A. Yes, sir.

22 Q. Now, given your testimony that following the
23 expiration of the three-year period in Exhibit
24 9 the two universities went to a different
25 system that was more an ad hoc, project by

1 disclosed.

2 MR. SNEATH: How would one ask
3 that -- because it's making no assumptions,
4 because the witness is free to say, he's a very
5 smart guy, it was never disclosed, see.

6 So there is no real way to clean that
7 question up. Human beings only have a certain
8 way to express questions. It is not presuming
9 anything. It's not leading. It's not
10 suggesting anything. It's saying when --

11 MS. KOSCELNICK: I would disagree with
12 you on all of those points that you just said.

13 MR. SNEATH: So you want me to be the
14 literalist. All right, we'll take it the
15 literal way to make it easier for everybody,
16 okay.

17 BY MR. SNEATH:

18 Q. Was the invention described in the '554 patent
19 ever disclosed to CMU?

20 MS. TAUTKUS: I'm going to object to
21 the extent it calls for a legal conclusion.

22 MS. KOSCELNICK: And are you talking
23 about a legal disclosure as opposed to the
24 everyday use of the word "disclose"?

25 Q. You used the word "disclosure" earlier, what

1 did you mean?

2 A. A disclosure of invention, a written
3 description of invention that is typically
4 submitted by an inventor which may or may not
5 contain patentable or copyrightable material.

6 Q. And it's given to your department so your
7 department can react accordingly; is that
8 right?

9 A. That's correct.

10 Q. So that you can track it, follow it, decide
11 whether anything needs to be done from a legal
12 standpoint, all those things are done by your
13 department; right?

14 A. Yes, sir.

15 Q. So that's what you meant by a disclosure;
16 right?

17 A. Disclosure of invention, yes.

18 Q. And that's what I understood you to mean, and
19 that's what I've been asking you about all
20 along here is that your department is notified
21 about inventions and potential inventions so
22 that your department can do its job; right?

23 A. Yes.

24 MS. KOSCELNIK: Objection to form.

25 Q. Okay. So given that that's our understanding

1 of disclosure, do you have any knowledge as to
2 whether or not the invention described in the
3 '554 patent was in that sense disclosed to the
4 tech transfer department at CMU?

5 A. We received it in -- a cover sheet of an
6 invention disclosure in, I'm going to say
7 absent looking at the documents, March of 1998.

8 Q. So your answer would be yes, it was disclosed
9 to you --

10 MS. KOSCELNICK: Object to the form.

11 Q. It was disclosed to your department?

12 A. We received an invention disclosure in
13 approximately March of 1998.

14 Q. Is that different than saying it was disclosed
15 to your department?

16 A. Well, I don't know. You guys are talking about
17 the difference between disclosure and invention
18 disclosure, and I'm just trying to --

19 Q. No, she is. I want to make sure you and I
20 agree.

21 MS. KOSCELNICK: Objection.

22 Q. When I say was it disclosed to your department,
23 do you not understand what I'm talking about?

24 A. If you are talking about notification?

25 Q. Yes.

1 A. Then we were notified.

2 Q. And we may come to a document like that, but
3 that's your recollection sitting here today?

4 A. Ballpark, in terms of date.

5 Q. All right. Now, you think that came in '98?

6 A. I believe it was early '98.

7 Q. So can you then look at Exhibits 7 and 9, two
8 policy guidelines --

9 A. Yes, sir.

10 Q. -- and tell me whether or not one or the other
11 of them, given that date in your mind, would
12 have been triggered by or applicable to that
13 disclosure?

14 MS. KOSCELNICK: Objection to the
15 form.

16 MS. TAUTKUS: Objection, calls for a
17 legal conclusion.

18 A. So my answer is one or the other would apply.

19 Q. Okay.

20 A. Because there's disclosure to the University of
21 Pittsburgh, there's disclosure to CMU, and they
22 crossed time frames.

23 Q. And they what?

24 A. And they appeared to have happened at different
25 times.

1 Q. But in your mind it's one or the other?

2 A. Yes, sir.

3 Q. And there's no doubt that it's one of them?

4 A. That's my conclusion.

5 Q. Okay. So how does that work then with regard

6 to this disclosure issue given that there are

7 two universities involved in these two

8 scenarios that we are talking about? Do you

9 have an understanding of how that's done at

10 Pitt? Do you have any knowledge of how that's

11 done? Is there a similar process to what's

12 done at CMU?

13 MS. KOSCELNICK: Objection to the

14 form.

15 A. I don't know of Pitt's internal procedures.

16 Q. No one's ever discussed it with you?

17 A. Not to my knowledge, sir.

18 MS. KOSCELNICK: What time frame are

19 you talking about, Mr. Sneath?

20 Q. So when this disclosure was presented to your

21 department at CMU, do you recall whether the

22 disclosure indicated that it was a joint

23 project between the two universities?

24 A. Within that pile is a copy of the cover sheets

25 from the disclosures that listed CMU inventors

1 and University of Pittsburgh inventors.

2 Q. So when your department gets a disclosure like
3 that that indicates there are inventors from
4 both universities, is it your practice then to
5 look to these policies -- was it your practice
6 back then to look to these policy guidelines to
7 govern the relationship between those
8 universities?

9 MS. TAUTKUS: Objection, incomplete
10 hypothetical.

11 A. These would be the policy guidelines.

12 Q. In other words, they would come into play when
13 you learned, your department learns that it was
14 a joint venture between the two universities;
15 right? I mean that's the purpose of these
16 guidelines?

17 A. That's the purpose, yes.

18 Q. You were in this department, in your current
19 department, tech transfer, at some point in '97
20 was it?

21 A. 9/1/97 I began full-time.

22 Q. And you had done some work for them prior to
23 that time?

24 A. Yes, sir.

25 Q. So were you personally involved in responding

1 to or reacting to the disclosure of these
2 particular patents? Do you have a recollection
3 of being personally involved back then?

4 A. I was assigned to this docket.

5 Q. Okay. Did you engage in any discussions at
6 that time with the University of Pittsburgh
7 regarding these policy guidelines and how they
8 might apply to that docket?

9 A. I don't know if the conversation was limited to
10 that topic, but once we received the invention
11 disclosure, the notification, we started
12 talking.

13 Q. And do you remember with whom you talked?

14 A. Oddly enough it was with Reed McManigle.

15 Q. Would those discussions have included then a
16 discussion of the application of the policy
17 guidelines that we've been talking about in
18 Exhibit 9?

19 MS. TAUTKUS: Objection, vague.

20 Q. Go ahead.

21 A. Broadly, yes, these would have been the
22 guidelines in how we were going to move
23 forward.

24 Q. And you remember specifically then how you
25 addressed this particular disclosure that

1 there was no discrete interinstitutional
2 agreement entered on this.

3 Q. Right, and this would be --

4 A. That's correct.

5 Q. -- referring to that same topic?

6 A. That's right.

7 Q. And this was a discussion about a potential
8 discrete interinstitutional agreement relating
9 to certain technology?

10 A. And I previously said I'm not sure that was
11 necessary in my personal belief in this case.

12 Q. Okay.

13 A. But I do understand that that's what this is
14 referencing.

15 Q. Okay.

16 A. I should point out to you that in this time
17 frame, as you recall when I started to talk
18 about my history, that I became director in
19 2002, so I would not have had day-to-day
20 responsibility as I had in the past.

21 Q. All right.

22 A. So just for context, for 98049.

23 Q. Okay. Look at Exhibit 24. This is an
24 e-mail -- well, these are documents CMU 227
25 through 236. I have put them together, you can

1 tell me if that's not correct, but it appears
2 to be an e-mail with an attachment, and you
3 produced them consecutively, so I'm assuming
4 this is the --

5 A. I would have put them together.

6 Q. All right. Was this indeed a proposed
7 interinstitutional agreement regarding the
8 subject patents and the third patent, all of
9 which were your docket 49?

10 A. Can you repeat that or read it back?

11 Q. Yeah. Was this a proposed discrete agreement
12 that related to the subject patents and the
13 third patent that was part of your document?

14 A. It appears to be one proposed by Reed McManigle
15 of the University of Pittsburgh to Carl Mahler
16 or Carnegie Mellon, just so the direction is
17 clear.

18 Q. Now, in the middle of the e-mail, it references
19 or it says, Recently we were talking with
20 another radiation therapy company, Varian,
21 about another technology developed at Pitt by
22 Don Sashin for positioning the patient's head,
23 so on and so forth.

24 Were you ever made aware about
25 discussions with Varian?

1 MS. TAUTKUS: Objection, vague.

2 MS. KOSCELNIK: I assume you mean
3 these discussions, Mr. Sneath?

4 Q. Yes, the discussions that are being referenced
5 here. Was that ever brought to your attention?

6 A. It's possible that it was brought to my
7 attention, but I do not recall the specifics.

8 Q. The same thing with the CMU Exhibit 25. It's
9 document 237, e-mail from McManigle to various
10 people dated May 31, 2002. Again, this
11 discusses alleged interest by Varian --

12 A. Yes, sir.

13 Q. -- in licensing patented technologies. Do you
14 see that?

15 A. Yes, sir.

16 Q. Again, your answer would be the same -- you can
17 take the time to read it -- but you recall this
18 vaguely being brought up to you, but you don't
19 recall any of the specifics?

20 A. Yes, sir.

21 Q. And does anything in reading this e-mail
22 refresh your recollection about any of the
23 specifics? Other than just you reading it,
24 which we can all do, does it actually jog your
25 memory in any way?

1 A. No, but it does correspond to other documents
2 in my pocket which have the -- there are three
3 cover sheets from invention disclosures with
4 the 20 percent.

5 Q. Yes. Because at this stage they were trying to
6 get everybody to sign off on a distribution or
7 an allocation; right?

8 A. That's right.

9 Q. Being getting all the inventors to sign off on
10 that allocation which at this point had not
11 been done according to the e-mail?

12 A. That's right, and I will say that that
13 surprised me that it had not been done.

14 Q. All right. Look at CMU 238, which is document
15 or Exhibit 26, with CMU 238 through 248. You
16 are mentioned in here, although I don't think
17 you are copied. They were talking about you
18 behind your back.

19 A. Happens all the time.

20 Q. Take a look at this and see if this refreshes
21 your recollection about what was going on in
22 May of 2002, vis-a-vis this proposed agreement.

23 Let me see if I can make a suggestion
24 and see if we can short-circuit this because I
25 really want to get through all this. It would

1 appear here that this was follow-up to the
2 proposed agreement, and Carl is responding that
3 there are really three sticking points that
4 have been holding up not only this agreement,
5 but other interinstitutional agreements as well
6 and that these general issues need to be
7 resolved before the specifics can be dealt
8 with. Is that a fair summary?

9 A. That's exactly what I was going to point out to
10 you, that there were -- we talked about the
11 change of the form from a blanket policy
12 guideline to discrete, and this is really less
13 a discussion of particulars and more of a
14 discussion of the formal going forward
15 generally.

16 Q. Okay. And at this point we are clear that no
17 such agreement was entered into between CMU and
18 Pitt regarding the subject analogy, at the
19 point of this in 2002 was still in discussion?

20 A. Yes, sir.

21 Q. Were you ultimately advised that all the
22 inventors had agreed to a 20 percent split
23 across the board? Do you recall that?

24 A. I don't recall that, but there's no -- it's a
25 detail that wouldn't necessarily come up to the

1 director's attention. It would just be entered
2 into our records.

3 Q. All right. Let's show you Exhibits 29, 30, 31,
4 32. Actually just through 31 at the moment,
5 those three relate to the same topic: 29, 30,
6 31. These are CMU documents 256, that's
7 Exhibit 29; Exhibit 30 is 258; Exhibit 31 is
8 259, CMU Bates stamp numbers.

9 A. And where are you starting, sir?

10 Q. Start with Exhibit 29.

11 A. Okay.

12 Q. It's a June 5th, 2002 e-mail from Reed
13 McManigle to Carl Mahler.

14 A. Mm-hmm.

15 Q. And is it fair to state that he reports that
16 Pitt would be looking to a 60/40 split of
17 proceeds between Pitt and CMU based on the
18 respective contributions of the inventors?

19 MS. KOSCELNIK: Object --

20 Q. Just very broad terms but I mean is that --

21 MS. KOSCELNIK: Henry, if I could
22 just say I don't think it says based on the
23 respective contributions, it says because -

24 MR. SNEATH: Well, it says as three
25 of the inventors were at Pitt, three out of

1 five.

2 A. That's what it says but it's incorrect.

3 Q. I think later it might have been reversed.

4 A. Okay.

5 Q. If you look at the next e-mail -- I gave you
6 all three. I didn't mean to hold back on you
7 there -- I think one of the next two e-mails,
8 somewhere along the way they agreed to a
9 reversal?

10 A. Corrects Dr. Shimoga, yeah.

11 Q. So on June the 6th, an e-mail from McManigle to
12 everybody says, Therefore the split between the
13 two universities would be reversed from what I
14 indicated earlier, 60 percent for CMU, 40
15 percent for Pitt?

16 A. That's correct.

17 Q. And was that agreement memorialized in some way
18 other than this e-mail?

19 A. Again, in my files I don't recall getting a
20 copy of an executed split agreement of any
21 kind.

22 Q. All right. But did you all go forward then on
23 the assumption that this was the agreement,
24 that there would be a 60/40 split?

25 MS. TAUTKUS: Objection, assumes

1 facts, vague.

2 Q. I'm not assuming anything. I'm asking you a
3 question, Mr. Wooldridge.

4 Did you go forward on an assumption
5 that there was a 60/40 split agreed to by
6 virtue of these e-mails?

7 A. By virtue of the inventorship being three from
8 CMU and two from Pitt, yes, and the fact that
9 they had agreed to -- the inventors themselves
10 had agreed to 20 percent, assuming this e-mail
11 is correct that they all, in fact, got that,
12 but it's not memorialized that I've seen.

13 Q. Now, when we talk about a 60/40 split in the
14 context of these discussions, would that be a
15 60/40 split of any proceeds relating to the
16 commercialization of the invention? Is that
17 what the discussion was about?

18 A. Yes. Well, not just proceeds, but it could be
19 costs as well.

20 Q. Okay. So both revenue and expenses that would
21 be generated by the process of
22 commercialization of these inventions if they
23 came to fruition?

24 MS. KOSCELNIK: I mean there is a
25 license we are talking about. Just when you is

1 a say they came to fruition, I'm not sure what
2 you mean by that.

3 Q. Well, what were those e-mails discussing?

4 Splitting what and under what circumstances?

5 A. Well, working from memory of the policy
6 guidelines, it is both a sharing of expenses
7 until licensing, so patent expenses -- well,
8 actually I don't think it goes beyond patent
9 expenses, so if I use \$10,000 worth of outside
10 counsel time and they use 3, we wouldn't split
11 that. This is limited, largely limited to
12 patent expenses.

13 Q. Okay.

14 A. We'll reimburse each other for time, and then
15 it would normally be if there is a license that
16 does, in fact, pay royalties, it would be a
17 recoupment of cost and then a split of proceeds
18 along those lines. I think that's consistent
19 with those policy guidelines, and even the
20 discrete form.

21 Q. With regard to the patents-in-suit, was there
22 any such sharing of expenses in anything?

23 A. I don't know if I can say at any time.

24 Q. Just because you don't recall or what's --

A. The reason being is that Elekta Oncology did

1 reimburse the University of Pittsburgh and,
2 hence, CMU didn't have to under that sponsored
3 research agreement or option that was in that.

4 Q. All right.

5 A. So I can't say for certain if there is
6 something of an annuity that was paid last
7 year, whether or not that was split. I don't
8 know.

9 Q. Is CMU participating in any of the litigation
10 expenses for this litigation?

11 MS. KOSCELNIK: Objection, that
12 question was asked and answered.

13 MR. SNEATH: I did?

14 MS. KOSCELNIK: I thought you did.

15 MR. SNEATH: I don't think so.

16 Q. But anyway, indulge me if I did.

17 MS. KOSCELNIK: You can answer.

18 Q. Is CMU paying any of the litigation expenses
19 for this patent infringement litigation, or
20 does it have an agreement to do so?

21 A. Can you be more distinct?

22 Q. Sure. That's fine.

23 A. I'm sure we are paying Jackie on an hourly
24 rate.

25 Q. That was the 10,000 you were talking about

1 earlier for an hour of her time.

2 A. And I don't think we are getting reimbursed by
3 anyone for that.

4 Q. That's not what I meant.

5 A. I come at a much lower rate.

6 Q. No, what I was getting at is the litigation
7 that's been filed by the University of
8 Pittsburgh against Varian claiming infringement
9 of the subject patents --

10 A. Yes, sir.

11 Q. -- has CMU contributed any funds to the
12 litigation of that case or does it have any
13 agreement to pay any of those litigation
14 expenses, legal fees, costs, so on?

15 MS. TAUTKUS: Objection.

16 MS. KOSCELNIK: Objection to form.

17 MS. TAUTKUS: Asked and answered.

18 A. To the best of my knowledge, but I may not have
19 complete knowledge, the answer is no.

20 Q. And no on both counts, that it has not paid any
21 moneys and, no, it has no agreement to do so?

22 A. Yes, no agreement to do so, not paid any
23 expenses, to the best of my knowledge.

24 Q. Has the University of Pittsburgh requested CMU
25 to make any such payments?

1 A. I do not know. I was not part of those
2 conversations. It would have been between
3 counsel, if any.

4 Q. And we are going back then to the beginning of
5 your testimony. We've been talking about this
6 60/40 split business. Would that 60/40 split
7 contemplate a 60/40 split of a recovery in any
8 lawsuit seeking to enforce the intellectual
9 property rights that are at issue?

10 MS. TAUTKUS: Objection.

11 MS. KOSCELNIK: Objection.

12 MS. TAUTKUS: Calls for legal
13 conclusion.

14 Q. You can answer.

15 A. Again, I do not know the details.

16 Q. Why don't you look at 32, 33, 34. These all
17 appear to mention discussions with my client,
18 Varian. I don't think you are distinctly
19 copied on any of these e-mails. I may be
20 wrong. No, I don't think so, but in any event,
21 were you advised about any of the discussions
22 with Varian that are referred to in these
23 e-mails other than just recently reading about
24 them in reviewing these documents?

25 A. I honestly do not recall being apprised of this

1 in 2002.

2 Q. Okay. And similarly, I'll represent to you
3 that there were ongoing discussions between the
4 University of Pittsburgh and Varian that are
5 referenced in some of the documents that you've
6 seen.

7 Other than having looked at the
8 documents recently in preparation for this
9 deposition, were you ever advised about the
10 substance of those discussions, the content of
11 those discussions between Pitt and Varian?

12 A. No, sir.

13 Q. Okay. And is that because you had risen up to
14 a level where you wouldn't have been involved
15 in those kind of day-to-day things, or it
16 wasn't your department, or you don't know why?

17 A. I would say it's more the former than the
18 latter. It would still be handled in my
19 department, it's just this was a discrete
20 matter, not --

21 Q. All right. Can you look at CMU 35, Exhibit 35.
22 Can you just identify what that document is?
23 It says CMU 849 Bates stamp.

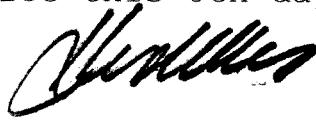
24 A. This is an accounts receivable log which I
25 assume is from Carnegie Mellon based on the

1 COMMONWEALTH OF PENNSYLVANIA) CERTIFICATE
2 COUNTY OF ALLEGHENY) SS:
3 I, Heidi H. Willis, RPR, CRR, a Court Reporter
4 and Notary Public in and for the Commonwealth of
5 Pennsylvania, do hereby certify that the witness,
6 ROBERT WOOLDRIDGE, was by me first duly sworn to
7 testify to the truth; that the foregoing deposition
8 was taken at the time and place stated herein; and
9 that the said deposition was recorded
10 stenographically by me and then reduced to printing
11 under my direction, and constitutes a true record of
12 the testimony given by said witness.

13 I further certify that the inspection, reading
14 and signing of said deposition were NOT waived by
15 counsel for the respective parties and by the
16 witness.

17 I further certify that I am not a relative or
18 employee of any of the parties, or a relative or
19 employee of either counsel, and that I am in no way
20 interested directly or indirectly in this action.

21 IN WITNESS WHEREOF, I have hereunto set my hand
22 and affixed my seal of office this 8th day of
23 October, 2007.



24

25

COMMONWEALTH OF PENNSYLVANIA	
Notary Public	Notary Seal
Heidi H. Willis, Notary Public	
City Of Pittsburgh, Allegheny County	
My Commission Expires July 8, 2008	

Member, Pennsylvania Association Of Notaries

EXHIBIT F

FOR ATTORNEYS' EYES ONLY

1 IN THE UNITED STATES DISTRICT COURT FOR THE
2 WESTERN DISTRICT OF PENNSYLVANIA

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4 UNIVERSITY OF PITTSBURGH,)
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6 Plaintiff,)
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6 -vs-) Case No.
7) 07-CV-0791 (AJS)
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VARIAN MEDICAL SYSTEMS, INC.,)
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CONFIDENTIAL

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12 CONFIDENTIAL - ATTORNEYS' EYES ONLY
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14 - - - - -
15 DEPOSITION OF: RICHARD V. WESTERHOFF
16 - - - - -
17 - - - - -
18 DATE: October 3, 2007
19 Wednesday, 9:00 a.m.
20 - - - - -
21 LOCATION: PICADIO SNEATH
22 MILLER & NORTON
23 4710 U.S. Steel Tower
24 600 Grant Street
25 Pittsburgh, PA 15219
TAKEN BY: Defendant
REPORTED BY: JoAnn M. Brown, RMR, CRR
Notary Public
AKF Reference No. JB03477

1 DEPOSITION OF RICHARD V. WESTERHOFF,
2 a witness, called by the Defendant for examination,
3 in accordance with the Federal Rules of Civil
4 Procedure, taken by and before JoAnn M. Brown, RMR,
5 CRR, a Court Reporter and Notary Public in and for
the Commonwealth of Pennsylvania, at the offices of
Picadio Sneath Miller & Norton, 4710 U.S. Steel
Tower, Pittsburgh, Pennsylvania, on Wednesday,
October 3, 2007, commencing at 9:14 a.m.

6 - - - -
7

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RICHARD V. WESTERHOFF,

3

being first duly sworn,

4

was examined and testified as follows:

5

- - - -

6

MR. ANTHONY: Good morning,

7

Mr. Westerhoff.

8

THE WITNESS: Good morning.

9

MR. ANTHONY: This morning, we were

10 set up for video feed. I received an objection
11 from counsel to videotaping the deposition.
12 The objection was based on a lack of notice of
13 videotaping the deposition. I looked at the
14 Notice, and I do not see that this had been
15 noticed for videotaping. I offered to
16 videotape it in any event and register the
17 objection. I also offered to have the
18 videographer hold the video until this issue
19 can be resolved, and, as I understand it,
20 counsel for the witness has refused to go
21 forward as long as it's videotaped; is that
22 correct?

23

MR. MALLIN: Yeah. We ought to say

24

some things in the beginning and make clear the
25 nature of this deposition.

1 This is a deposition of Eckert
2 Seamans, Cherin & Mellott, LLC, a law firm
3 which prosecuted the patents-in-suit. I am
4 general counsel of that law firm and authorized
5 to represent it here. Eckert Seamans has
6 designated Richard V. Westerhoff as a witness
7 to testify on the topics set forth in the
8 Notice of Deposition to the extent that those
9 topics relate to the patents-in-suit. To the
10 extent that those topics go beyond the
11 patents-in-suit, Eckert Seamans objects to
12 those topics or any questions beyond those
13 topics.

14 Eckert Seamans also -- since the
15 client has not waived privilege, Eckert Seamans
16 must be duty-bound to follow the privilege and
17 will follow instructions or itself make
18 objections based on privilege as they come up,
19 if they come up.

20 Finally, I note that pursuant to --
21 finally, I note that there was a Subpoena Duces
22 Tecum served on Eckert Seamans which was
23 quashed by the court. Nonetheless, Eckert
24 Seamans has produced documents which are
25 described in the transmittal letters and a

1 Q. Can you state your full name and home address
2 for the record, please.

3 A. Richard V. Westerhoff, 219 Eaton Road,
4 Pittsburgh, Pennsylvania.

5 Q. And, Mr. Westerhoff, would you outline your
6 education after high school, please.

7 A. Yes. I attended the Massachusetts Institution
8 of Technology. I received a bachelor of
9 science degree in electrical engineering.
10 Further education was received at the
11 University of Pittsburgh where I received a
12 J.D. degree.

13 Q. So you're a lawyer in the State of
14 Pennsylvania?

15 A. Yes.

16 Q. In any other state?

17 A. No.

18 MR. ANTHONY: Okay. Now, let me mark
19 as -- I guess we'll mark them ESCM -- yeah,
20 ESCM Exhibit 1, a copy of a Subpoena for Eckert
21 Seamans.

22 - - - -

23 (Exhibit 1 marked for identification.)

24 - - - -

25 MR. ANTHONY: Off the record.

1 instructions of the University of Pittsburgh,
2 and I'll instruct him not to answer the
3 question.

4 BY MR. ANTHONY:

5 Q. Was your recollection refreshed as to any fact
6 or event as a result of your conversations with
7 Mr. Zele?

8 MR. ZELE: Objection, vague.

9 A. No.

10 Q. Are you presently employed, sir?

11 A. I am of counsel with the firm. Basically, I'm
12 retired.

13 Q. How long have you been associated with Eckert
14 Seamans?

15 A. Since October 1985.

16 Q. Were you a partner there?

17 A. Yes.

18 Q. And from what period?

19 A. From the start, I was a partner.

20 Q. And your current position, I saw some place,
21 was of counsel or senior counsel?

22 A. Well, that card might say. I don't know what
23 the card says.

24 Q. It doesn't.

25 A. Oh, it doesn't? Okay.

1 My status now is of counsel.

2 Q. When did you become of counsel?

3 A. About two years ago.

4 Q. And before that, you were a partner?

5 A. Well, before that, I was of special counsel.

6 Q. Okay. And for how long were you of special
7 counsel?

8 A. From 2000 -- I semi-retired in 2000 and went
9 on, sort of, a part-time status, and that's
10 when I became of special counsel, and that was
11 about 2000.

12 Q. And from 1985 to approximately 2000, you were a
13 partner?

14 A. Yes.

15 MR. ANTHONY: Let me have marked as
16 Exhibit 3 the University of Pittsburgh's Second
17 Supplemental Privilege Log.

18 - - - -

19 (Exhibit 3 marked for identification.)

20 - - - -

21 BY MR. ANTHONY:

22 Q. Would you look at Exhibit 3, please.

23 Sir, did you play any role in
24 preparing this privilege log?

25 A. No.

1 MR. ANTHONY: Let me mark as Exhibit
2 3A -- let's mark it as Exhibit 4, a letter from
3 Mr. Mallin to Shannon Clougherty of October 1,
4 2007, with a Privilege Log of Non-Party Eckert
5 Seamans.

6

7 (Exhibit 4 marked for identification.)

— — — —

9 BY MR. ANTHONY:

10 Q. Sir, did you -- why don't you look at Exhibit 4
11 and tell me if you've seen it before?

12 A. No.

13 Q. Okay. Look at the last two pages, the list
14 there, and review the items there and see if
15 you looked at any of those in preparation for
16 your testimony today, as best as you can given
17 the descriptions?

18 A. No.

19 Q. No?

20 Did you play any role in selecting
21 documents to be withheld on privilege?

22 A. No.

23 Q. So as you sit here today, you do not know one
24 way or the other whether the documents that
25 were withheld were, in fact, attorney-client

1 privilege?

2 A. True.

3 Q. In the documents you reviewed from the Eckert
4 Seamans' files, were there any documents that
5 had not been shared with the United States
6 Patent and Trademark Office in those files?

7 A. Yes.

8 Q. Can you recall what those documents were? Any
9 of them?

10 A. Yes.

11 Q. Please do, sir.

12 A. Well, there were -- in the files, there were
13 three classes of documents: There were
14 documents that were cited to the patent office,
15 there were documents that were not prior art
16 and were not cited to the patent office, and as
17 I recall, there was one document that was --
18 would have been prior -- it was prior art, but
19 it was not material at all. It was out in left
20 field.

21 Q. Excuse me, I didn't get the last part.

22 A. It was out in left field.

23 Q. Out in left field.

24 Do you recall what that document was,
25 sir?

1 A. I think the author is Kessler.

2 Q. Do you remember the title?

3 A. Yeah, because it was so out in left field. It
4 was a graphic simulator.

5 Q. And that was an article?

6 A. Yes.

7 MR. ANTHONY: Counsel, do you know if
8 the document production from Eckert Seamans is
9 now complete?

10 MR. MALLIN: Is complete?

11 MR. ANTHONY: Yes.

12 MR. MALLIN: Yes.

13 MR. ANTHONY: This is complete?

14 And that word counsel is ambiguous,
15 but I was referring to Mr. Mallin.

16 And that would be true that all
17 privileged -- it would be true, Mr. Mallin,
18 that all privileged documents are now listed on
19 the log?

20 MR. MALLIN: On the two logs.

21 MR. ANTHONY: Between the two logs?

22 MR. MALLIN: Yeah, between the two
23 logs, to the best of my information and belief.

24 Actually, another lawyer in the
25 office took the liberty of doing that. He's on

1 vacation this week, but that was what we were
2 intending to do.

3 I should note that, as I mentioned
4 before, the Subpoena was quashed, and there was
5 areas in the Subpoena that we objected to
6 producing, so --

7 MR. ANTHONY: And those documents
8 have not been produced?

9 MR. MALLIN: And those documents have
10 not been produced. I'm not sure that
11 everything we objected to wasn't produced
12 because there was some discussions, as the
13 judge indicated, but there were documents that
14 were not produced because of objections other
15 than the objection of a privilege.

16 MR. ANTHONY: Okay. Thank you, sir.

17 BY MR. ANTHONY:

18 Q. When did you become a member of the Bar of the
19 State of Pennsylvania, sir?

20 A. Actually, I graduated from law school and
21 started working as an attorney in '66, but I
22 think I actually became a member of the Bar in
23 '67.

24 Q. Have you ever been disciplined as a lawyer?

25 A. No.

1 Q. Apart from practicing at Eckert Seamans, where
2 else have you practiced law, sir?

3 A. I began my practice in the patent department of
4 Westinghouse Electric Corporation.

5 Q. And what years were you there?

6 A. From 1966 to 1971.

7 Q. And what was your -- what did you do in 1971?

8 A. I joined a patent firm here in the City of
9 Pittsburgh.

10 Q. Excuse me?

11 A. I joined a patent firm here in the City of
12 Pittsburgh.

13 Q. Oh, and what was that firm, sir?

14 A. I believe at the time it was called Parmalee,
15 Usler & Welsh.

16 Q. And how long were you with that firm?

17 A. Till 1985.

18 Q. At which time you joined Eckert Seamans?

19 A. Yes.

20 Q. Since you began practicing, how would you
21 describe any emphasis of your practice?

22 MR. ZELE: Objection, vague.

23 A. I don't understand the question.

24 Q. Sure.

25 Are you -- did you spend time as a

1 patent prosecutor?

2 A. Oh, yes.

3 Q. Okay. And throughout your career, what portion
4 of your practice was patent prosecution,
5 roughly?

6 A. Probably 75 to -- 75 percent or somewhere in
7 that area.

8 Q. And did you also have any litigation practice?

9 A. A little bit.

10 Q. What percentage, roughly?

11 A. That would be -- well, first of all, we have to
12 define litigation practice.

13 When I was with the Parmalee firm, I
14 was involved in some of the litigation there,
15 and some of that was commercial litigation
16 actually, too, because we did patent work and
17 we did some other -- it was a trade -- you
18 know, some trade secret things, and I ended up
19 involved in those things, and since I've been
20 at Eckert Seamans, I have not been a litigator,
21 although I've participated in litigation in
22 consultation on patent issues, analyzing the
23 art, that sort of thing.

24 Q. What experience do you have with medical
25 imaging systems?

1 A. I've done a few patents on medical imaging
2 systems.

3 Q. Apart from the two in issue here?

4 A. Yes.

5 Q. For what clients did you work on medical
6 imaging systems?

7 A. Well, the University of Pittsburgh and also
8 Vanderbilt University.

9 Q. Any others come to mind?

10 A. No.

11 Q. Have you ever represented Carnegie Mellon
12 University?

13 A. I don't believe so.

14 MR. ANTHONY: As ESCM 5, we'll mark a
15 copy of Patent 5,727,554.
16 - - - -

17 (Exhibit 5 marked for identification.)
18 - - - -

19 MR. ANTHONY: And as 6, a copy of
20 Patent 5,784,431.
21 - - - -

22 (Exhibit 6 marked for identification.)
23 - - - -

24 BY MR. ANTHONY:

25 Q. Mr. Westerhoff, do you recognize Exhibits 5 and

1 6?

2 A. Yes.

3 Q. And are these patents on which you were the
4 prosecuting patent attorney?

5 A. Yes.

6 Excuse me, I notice that -- I was
7 looking for the Certificate of Correction.

8 Q. Okay. Can you tell us how you became involved
9 in doing the prosecution on these two patents?

10 A. I was asked by Arnold Silverman of our office
11 to handle these patent applications.

12 Q. Who is Arnold Silverman?

13 A. He is a partner in the firm and, at the time,
14 was the chairman, the head of the intellectual
15 property department.

16 Q. Prior to that time, had you done any work for
17 the University of Pittsburgh?

18 A. Yes.

19 Q. And what type of work had you done prior to the
20 time you were asked to work on the applications
21 that matured as Exhibits 5 and 6?

22 A. I had done some other patent applications for
23 them.

24 Q. Was there a principal contact between Eckert
25 Seamans and the University of Pittsburgh with

1 COMMONWEALTH OF PENNSYLVANIA) CERTIFICATE

2 COUNTY OF ALLEGHENY) SS:

3 I, JoAnn M. Brown, RMR, CRR, a Court Reporter
4 and Notary Public in and for the Commonwealth of
5 Pennsylvania, do hereby certify that the witness,
6 ROBERT V. WESTERHOFF, was by me first duly sworn to
7 testify to the truth; that the foregoing deposition
8 was taken at the time and place stated herein; and
9 that the said deposition was recorded
10 stenographically by me and then reduced to printing
11 under my direction, and constitutes a true record of
12 the testimony given by said witness.

13 I further certify that the inspection, reading
14 and signing of said deposition were NOT waived by
15 counsel for the respective parties and by the
16 witness.

17 I further certify that I am not a relative or
18 employee of any of the parties, or a relative or
19 employee of either counsel, and that I am in no way
20 interested directly or indirectly in this action.

21 IN WITNESS WHEREOF, I have hereunto set my hand
22 and affixed my seal of office this 23rd day of
23 October, 2007.

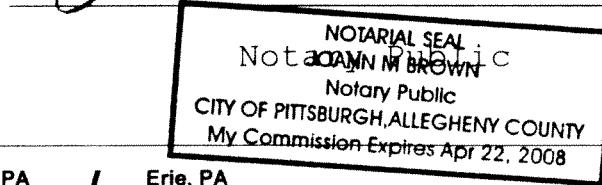


EXHIBIT G

1 IN THE UNITED STATES DISTRICT COURT FOR THE
2 WESTERN DISTRICT OF PENNSYLVANIA

3 - - - -

4 UNIVERSITY OF PITTSBURGH,)
5 Plaintiff,)
6 -vs-) Case No.
7 VARIAN MEDICAL SYSTEMS, INC.,) 07-CV-0791 (AJS)
8 Defendant.)
9
10
11
12 - - - -

13 CONFIDENTIAL - ATTORNEYS' EYES ONLY

14 - - - -
15 DEPOSITION OF: MARC S. MALANDRO, Ph.D.

16 - - - -

17 DATE: October 2, 2007
18 Tuesday, 9:10 a.m.

19 LOCATION: PICADIO SNEATH
20 MILLER & NORTON
21 4710 U.S. Steel Tower
22 600 Grant Street
Pittsburgh, PA 15219

23 TAKEN BY: Defendant

24 REPORTED BY: Heidi H. Willis, RPR, CRR
25 Notary Public
AKF Reference No. HW03476

1 DEPOSITION OF MARC S. MALANDRO, Ph.D.,
2 a witness, called by the Defendant for examination,
3 in accordance with the Federal Rules of Civil
4 Procedure, taken by and before Heidi H. Willis, RPR,
5 CRR, a Court Reporter and Notary Public in and for
the Commonwealth of Pennsylvania, at the offices of
Picadio Sneath Miller & Norton, 4710 U.S. Steel
Tower, Pittsburgh, Pennsylvania, on Tuesday, October
2, 2007, commencing at 9:10 a.m.

6

- - - -

7

8 APPEARANCES:

9 FOR THE PLAINTIFF:

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412-288-4000
23 hsneath@psmn.com

24

25

1 MARC S. MALANDRO, Ph.D.,
2 being first duly sworn,
3 was examined and testified as follows:
4 - - - - -

5 EXAMINATION
6 - - - - -

7 BY MR. SNEATH:

8 Q. Mr. Malandro. My name is Henry Sneath. I
9 represent Varian Medical Systems in a lawsuit
10 that's been brought by the University of
11 Pittsburgh here in the Western District of
12 Pennsylvania.

13 I'm going to be asking you questions
14 today regarding claims in that case and issues
15 related to those claims, and there's just a few
16 basic ground rules that I would ask that we try
17 to follow and rights that you have that you
18 should feel free to exercise.

19 Number one, you are entitled to
20 understand each and every question that I ask,
21 and if you don't understand my question, please
22 ask me to rephrase it or ask it again, I'll be
23 happy to do that.

24 If you are confused by the
25 proceedings in any way, you should feel free to

1 your answers before I begin my next question,
2 and if you'll extend me the same courtesy and
3 allow me to finish my questions before you
4 answer for the benefit of the court reporter.
5 Okay?

6 A. I understand.

7 Q. Please state your full name

8 A. Marc Shane Malandro

9 Q. What's your current home address?

10 A. 1064 South Lake Drive, Gibsonia, Pennsylvania
11 15044.

12 Q. And by whom are you employed?

13 A. University of Pittsburgh

14 Q. And what is your current job title?

15 A. Associate vice chancellor for technology
16 management, commercialization.

17 Q. And how long have you had that position?

18 A. That current title since October of 2006

19 Q. I'm sorry, 2006?

20 A. 2006.

21 Q. And what was your job before that?

22 A. I started in 2004 as a licensing manager, in
23 2005 took over as interim director and then
24 director, and then in 2006 associate vice
25 chancellor.

1 Q. So your first time of employment with Pitt was
2 what date?

3 A. February 2004.

4 Q. And where were you employed prior to that time?

5 A. Company called Sagres Discovery, S-a-g-r-e-s,
6 in Davis, California.

7 Q. Are you a native to the Pittsburgh area?

8 A. No.

9 Q. Where are you from originally?

10 A. Youngstown, Ohio.

11 Q. And your work with Sagres, what did you do
12 there?

13 A. I was co-founder and vice president of
14 strategic alliances.

15 Q. And what was the business of Sagres?

16 A. It was a biotechnology company identifying
17 cancer genes.

18 Q. Cancer?

19 A. Genes.

20 Q. Did your work with them involve any
21 collaboration with the University of Pittsburgh
22 or UPMC?

23 A. No.

24 Q. And how long were you with Sagres?

25 A. Four years.

1 Q. So that would take us back to, what, about
2 2000?

3 A. About 2000, November of 2000 that takes us.

4 Q. And where were you employed prior to that?

5 A. Celera Genomics, C-E-L-E-R-A.

6 Q. And where were you located with them?

7 A. Still in Davis with home office in Rockville,
8 Maryland.

9 Q. With that company, did you do any collaborative
10 work with the University of Pittsburgh or UPMC?

11 A. No.

12 Q. Did you ever give any deposition before?

13 A. Yes.

14 Q. How many times?

15 A. Twice.

16 Q. Did they involve issues relating to your work,
17 or were they personal?

18 A. Issues related to work.

19 Q. Is this for the University of Pittsburgh, or
20 one of your prior employments?

21 A. University of Pittsburgh.

22 Q. And were those two depositions part of a
23 lawsuit proceeding?

24 A. Yes.

25 Q. Were they lawsuits filed here in Western

1 Pennsylvania?

2 A. I'm not sure where they were filed.

3 Q. Okay. Were they patent cases?

4 A. Yes.

5 Q. Were they in any way involved with any of the
6 inventors who are listed in the patents-in-suit
7 in this case?

8 A. No.

9 Q. Anything related to the technology that's at
10 issue in this case, in either of those suits?

11 A. No.

12 Q. Do you happen to remember the names of any of
13 the parties in those lawsuits?

14 A. Siemens and CTI Molecular Imaging.

15 Q. Was Siemens the plaintiff or defendant in that
16 suit?

17 A. Defendant.

18 Q. And was University of Pittsburgh the plaintiff?

19 A. Yes.

20 Q. And the other one, I'm sorry?

21 A. CTI Molecular Imaging was acquired by Siemens.

22 Q. Was that one and the same lawsuit that you were
23 referring to?

24 A. Yes.

25 Q. And did you do two depositions in one case, or

1 was there another deposition in another case?

2 A. Two depositions in one case.

3 Q. Do you remember the lawyers who took your
4 deposition, what law firm?

5 A. I don't. They were an out-of-town firm. I
6 don't remember the name.

7 Q. Can you tell me your current job
8 responsibilities just in a general way?

9 A. I oversee the office of technology management.
10 I oversee the office of enterprise development,
11 and on both of those manage the intellectual
12 property and the commercialization of the
13 research efforts at the university, also an
14 associate adjunct professor of medicine.

15 Q. Of medicine?

16 A. Yes.

17 Q. Tell me about your educational background,
18 undergrad, graduate school.

19 A. Undergraduate Youngstown State University in
20 biology, master's degree from Youngstown State
21 University in biology, Ph.D. in biochemistry
22 and molecular biology, University of Florida
23 College of Medicine, and postdoctoral work Case
24 Western Reserve University in human molecular
25 genetics.

1 Q. And what do you teach as an adjunct professor?

2 A. I teach bench top to bedside, it's a
3 commercialization course for faculty.

4 Q. And to whom do you report at the university?

5 A. I report both to the provost and to the dean of
6 the medical school and senior vice chancellor
7 for health sciences. The provost is Jim Maher,
8 senior vice chancellor is Art Levine.

9 Q. Okay. You have been designated today as a
10 witness pursuant to the Notice of Deposition
11 that was served on the university. Would you
12 agree with that?

13 A. Yes.

14 Q. Could you tell me the process by which you were
15 involved in deciding what topics you'd be able
16 to address in a deposition?

17 MS. TAUTKUS: I'm going to object to
18 the extent to caution the witness not to
19 respond to the extent it involves any
20 attorney-client communications, but anything
21 other than attorney-client communications you
22 may answer.

23 A. I read the -- I don't know what it's exactly
24 called, the Notice of Deposition that has the
25 points laid out?

1 Q. Why don't we show you what we marked Exhibit
2 94. The exhibits today will have a designation
3 of PITT and then number.

4 A. I read this, had discussions with the general
5 counsel internally, had discussions with our
6 outside counsel, and we came to an agreement on
7 those which I think I can testify on.

8 Q. Did you, without the advice or benefit of
9 counsel, did you personally go through them and
10 decide which ones you felt that you could
11 address?

12 A. I guess I'm -- I don't understand the question.

13 Q. Okay. Prior to any discussions with counsel,
14 did you look at the list of topics and decide
15 on your own which topics you felt you could
16 testify to?

17 A. I looked at the list of topics and had a
18 general idea of what I was able to testify on.

19 Q. Were you involved in the production of
20 documents in this case?

21 A. Yes.

22 Q. Were you primarily responsible for working with
23 counsel in producing the documents that Pitt
24 produced?

25 A. No.

1 Q. Well, this document is an initial disclosure in
2 which the parties are each required to exchange
3 certain information early in the lawsuit. It
4 says here in heading A, Individuals likely to
5 have discoverable information; B is, Documents
6 and things related to disputed facts, so on and
7 so forth.

8 Were you involved in generating
9 information that you believe ended up in these
10 initial disclosures?

11 MS. TAUTKUS: I'm going to object,
12 and, again, caution the witness to the extent
13 that there were discussions with counsel, I'll
14 instruct the witness not to answer, but if
15 there were discussions apart from counsel, you
16 can go ahead and answer.

17 A. What we were just talking about, I believe if
18 those -- if that information made it into here,
19 then the answer would be yes. Alex, in
20 reporting to me, was the most direct contact
21 for most of the information from our office.

22 Q. All right. Now, if you'd go back and take a
23 look at Exhibit 94 again, that's the deposition
24 notice.

25 My understanding is -- and if counsel

1 needs to show you the e-mail that she sent --
2 that you have been designated for certain
3 topics. You are aware of that?

4 A. Yes.

5 Q. And I'd like to read them off, and, Counsel,
6 you can follow along with me, see if we agree.
7 My understanding is you've been specifically
8 designated under Rule 30(b)(6) for deposition
9 topics 9, 10 -- just stop me if I'm wrong
10 anywhere along the way -- 9, 10 as I said, 11,
11 13 --

12 MS. TAUTKUS: We have one caveat with
13 respect to 13, and that is he would only be
14 designated with respect to discussion of rights
15 between UPMC and the University of Pittsburgh.

16 MR. SNEATH: All right. Well, we'll
17 be coming back to that, but we'll note a
18 limitation on 13.

19 13, 14, 15, 16, 19, 21, 23 through --
20 no, I'm sorry, 22, 24, 25. Everybody agree
21 with that? Counsel?

22 MS. TAUTKUS: I agree with that.

23 THE WITNESS: Mm-hmm.

24 BY MR. SNEATH:

25 Q. And, Mr. Malandro, you have no different

1 understanding than what we just recited; is
2 that correct?

3 A. I don't believe so.

4 Q. Now, deposition topic No. 1, by way of example
5 of a number that have this response, my
6 understanding is the University of Pittsburgh
7 is not designating any witness under Rule
8 30(b) (6) to address deposition topic No. 1. Is
9 that your understanding?

10 A. I don't know.

11 MR. SNEATH: Counsel, can we agree on
12 that, first of all, before I proceed, that
13 deposition topic No. 1 is a designation of no
14 witness?

15 MS. TAUTKUS: I don't believe that's
16 the case. I'll have to consult with my notes,
17 if you want to do that off the record.

18 MR. SNEATH: Yeah, why don't we go
19 off the record for a moment.

20 - - - -

21 (There was a discussion off the record.)

22 - - - -

23 MR. SNEATH: All right. We are back
24 on the record. I was asking about deposition
25 topic 1, but based on our discussion off the

1 Q. Do you know whether or not the inventors listed
2 in the patents-in-suit had ever created a
3 working prototype of the technology described
4 in those patents?

5 A. I don't know.

6 Q. How about today? Do you know?

7 A. I don't know.

8 Q. I'd like to show you Exhibit 1. We are going
9 to finally start at the beginning. You can
10 just keep turning those over in that pile
11 there, and we can make a decision at the end
12 what we are going to do with them all.

13 This is Pitt production document 2240
14 through 2244. Can you identify this document?

15 A. This is a discussion of how collaborative
16 projects are handled between Pitt and
17 university dated '94.

18 Q. Okay. Between Pitt and CMU; right?

19 A. I'm sorry, Pitt and CMU.

20 Q. And you said it's a discussion. Would you
21 agree it's a signed document called Policy
22 Guidelines?

23 A. Yes.

24 Q. And appears to have been signed in October of
25 '94, and on the front page it says, Final

1 version written September 1, '94?

2 A. Yes.

3 Q. You know that this was the policy that was in
4 place between Pitt and CMU beginning at or
5 about those dates?

6 A. I believe it was.

7 Q. I'll show you Exhibit 2. This is document
8 2253. Can you identify this?

9 A. It appears to be a letter between Drs. Kanade
10 and Shimoga, to them from Kalend and
11 Greenberger.

12 Q. They relate or refer in the letter to dynamic
13 treatment tracking module, DTTM. Do you know
14 what that is?

15 A. I don't understand -- I don't know the acronym,
16 no.

17 Q. So you are not familiar with whatever that
18 project or product was?

19 A. Not specifically that.

20 Q. What distinction are you making? You have some
21 familiarity with -- forget the acronym part.

22 A. Well, I'm familiar with the technology in the
23 patent. So inasmuch as that technology relates
24 to the acronym, I don't know. So I don't know
25 if there was limited in scope or greater in

1 scope.

2 Q. Looking back for a moment, if you would, in
3 Exhibit 1, it's the one we just looked at
4 before this, again, the policy guidelines, do
5 you have an understanding that during the time
6 period in which this policy was in effect that
7 the two universities would share ownership of
8 intellectual property if that intellectual
9 property was developed during collaboration
10 between employees of the two universities? And
11 specifically I'm looking at D4 on the second
12 page.

13 A. Can you repeat your question, please?

14 Q. Do you have an understanding that during the
15 term of this agreement or these policy
16 guidelines between the universities that if
17 intellectual property was jointly developed
18 during collaboration by employees of the two
19 universities, that the intellectual property
20 would be owned jointly pursuant to this
21 agreement?

22 MS. TAUTKUS: Objection, calls for
23 legal conclusion.

24 A. It says IP developed jointly shall be owned
25 jointly.

1 Q. So you agree that was the policy at least
2 during the term of this agreement?

3 A. During the -- correct.

4 Q. Why don't we look at Exhibit 3, if we could.
5 Exhibit 3 is 7801 through 7803, Pitt
6 production.

7 Have you seen this document before
8 today?

9 A. I haven't seen this document.

10 Q. There are CCs down there. Do you know who Jodi
11 Buntain is?

12 A. I don't.

13 Q. How about either of the other two, Joyce Yasko
14 or Melvin Deutsch?

15 A. I don't.

16 Q. Take a look at the topics that are referenced
17 there in the letter, tell me if any of that
18 looks familiar with regard to the Sun computer,
19 the Sun-5 and so on.

20 Are any of those issues in which you
21 have any familiarity?

22 A. No.

23 Q. Look at the assignment document that's on the
24 next two pages. Do you know what that document
25 is?

1 though for the deposition, so we make the
2 record of what your position is regarding the
3 deposition topics so that we can then take them
4 up with the Court. The Court is not going to
5 want to hear about our off-line discussion
6 during a break.

7 MS. TAUTKUS: I've already made my
8 position on the record.

9 BY MR. SNEATH:

10 Q. Okay. So let's take a look at Exhibit 10, if
11 we could. Would you agree that this is the
12 follow-up policy guideline document to the one
13 that we looked at earlier, this one being
14 effective June 6th, 1997?

15 A. I believe so, yes.

16 Q. And this is the policy guideline document
17 between Pitt and CMU effective at or about that
18 time; is that right?

19 A. I believe so, yes.

20 Q. And signed by both universities?

21 A. Yes.

22 Q. Do you know whose handwriting appears on this
23 document?

24 A. The signatures?

25 Q. Yeah, you know, I shouldn't even ask you. It's

1 an unfair question because I think we've had
2 testimony. This is a CMU document. I don't
3 believe it was produced by Pitt, but it was
4 produced by CMU. We already know that the
5 writing on here was Mr. Wooldridge's writing,
6 and his testimony, I think I'll state this
7 fairly, is that that writing did not constitute
8 part of the agreement, it was simply the typed
9 part of this. So in fairness to you, I'm just
10 advising you of that.

11 Do you know whether or not the
12 university has a copy of this in its possession
13 and was, in fact, operating under this document
14 for the term of the agreement, Pitt?

15 A. I would assume because we have the provost's
16 signature on it that we would have a copy of
17 it.

18 Q. You have no reason to disagree that this
19 agreement was an agreement between the
20 universities that became effective June of '97?

21 A. Yeah, I don't disagree.

22 Q. All right. Sure, again, trying to do this more
23 or less chronologically, Exhibit 82. Take a
24 look. This is a package of documents that runs
25 from 2564 through 2581. Tell me whether or not

1 COMMONWEALTH OF PENNSYLVANIA) CERTIFICATE

2 COUNTY OF ALLEGHENY) SS:

3 I, Heidi H. Willis, RPR, CRR, a Court Reporter
4 and Notary Public in and for the Commonwealth of
5 Pennsylvania, do hereby certify that the witness,
6 MARC S. MALANDRO, Ph.D., was by me first duly sworn
7 to testify to the truth; that the foregoing
8 deposition was taken at the time and place stated
9 herein; and that the said deposition was recorded
10 stenographically by me and then reduced to printing
11 under my direction, and constitutes a true record of
12 the testimony given by said witness.

13 I further certify that the inspection, reading
14 and signing of said deposition were NOT waived by
15 counsel for the respective parties and by the
16 witness.

17 I further certify that I am not a relative or
18 employee of any of the parties, or a relative or
19 employee of either counsel, and that I am in no way
20 interested directly or indirectly in this action.

21 IN WITNESS WHEREOF, I have hereunto set my hand
22 and affixed my seal of office this 10th day of
23 October, 2007.

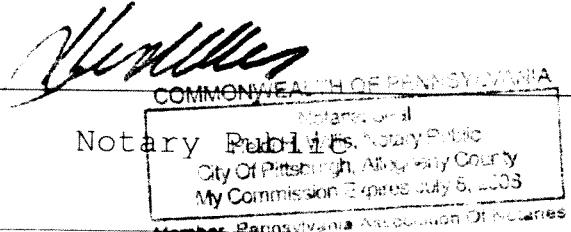


EXHIBIT H

Policy Guidelines --
Intellectual Property Rights and Technology Transfer Procedures
in Collaborative Projects
of the University of Pittsburgh and Carnegie Mellon University.
Final Version -- written on September 21, 1994

A. Objectives.

The objectives of these Guidelines are -

1. to encourage collaboration between members of Carnegie Mellon University ("CMU") and the University of Pittsburgh ("Pitt"), for the benefit of all participants, both universities, the community, and society in general;
2. to provide clear policy guidelines on intellectual property ("IP") rights developed in Collaborative Projects ("CP's");
3. to facilitate the subsequent commercialization of IP rights.

B. Principles

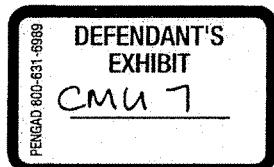
These Guidelines are built on the following principles:

1. Each participant's basic IP rights will be governed by the IP policies of that university in which the participant has his/her primary appointment -- ("Pitt Participant", "CMU Participant").
2. Invention disclosures will be the key vehicles for administering CP IP rights and commercialization projects.
3. The basic allocation between the two universities of ownership rights, expenses and proceeds ("University Allocation") will be calculated in accordance with the Relative Contributions toward each invention by the Participants from the two universities (see Section E.2), and the other provisions of these Guidelines.
4. The commercialization work for of each invention disclosure will be handled by the Technology Transfer Offices of one of the two universities, in accordance with the provisions of Section F. No new organization structures will be created.

SPECIFICS

C. Definition of Collaborative Projects

Prior to the formal beginning of a CP, the participating collaborators will, using their normal practices and procedures, define and agree to the following points : Definition of the CP, objectives, scope, principal investigators, expected funding, expected duration, and other dimensions of the project. Each such agreement will include mutual, blanket confidentiality agreements, as appropriate for each case.



CMU 0279

Policy Guidelines -- Intellectual Property Rights and TT Procedures in Collaborative Projects, Sept. 21, 1994, page 2

The allocation of ownership of IP among the participants and universities which may result from a CP will normally not be defined at this stage but will be determined later when specific Invention Disclosures are created.

D. Creation of IP Rights in CP's.

1. Mere discussion of a problem during collaboration between participants in a CP, without creating solutions to the problem, will not create any rights to ownership of patents, copyrights, trade secrets, or any other IP rights.
2. IP developed solely by Pitt Participants during collaboration will be owned entirely by Pitt, including title, interest, and IP rights.
3. IP developed solely by CMU Participants during collaboration will be owned entirely by CMU, including title, interest, and IP rights.
4. All IP developed jointly by CMU Participants and Pitt Participants during collaboration shall be owned jointly by Pitt and CMU and shall be administered in accordance with these Guidelines.

E. Invention Disclosures, Allocation of Proceeds.

1. It is recognized that different innovations made within the same CP are likely to have different characteristics; for example, they may involve different participants, may result in different university decisions regarding university commitment to commercialization, and may require different approaches to commercialization. The primary vehicle for managing IP and commercialization of innovations resulting from a CP will therefore be individual invention disclosures ("Disclosures").
2. With each Disclosure, the Participants must also define the "Relative Contribution" toward the invention made by each Participant. A Participant's Relative Contribution in a particular Disclosure may range from zero to 100 percent (for sole inventors).

The steps of reaching a definitive agreement on the Relative Contribution of all Participants will be as follows :

- a. The Participants in a Disclosure will aim to reach agreement with one another and will then propose a schedule of the Relative Contribution of each Participant. If no such agreement can readily be reached, the Participants will seek the advice and counsel of relevant department heads, program leaders, and one or both of the Technology Transfer Offices in order to reach such agreement. All such discussions, agreements, and resolutions of differences are to be dealt with in the same manner which is customary for "normal" for invention disclosures within each university.

Policy Guidelines – Intellectual Property Rights and TT Procedures in Collaborative Projects, Sept. 21, 1994, page 3

- b. The Technology Transfer Offices at both Universities must concur with each such proposal.
- c. If no agreement can be reached, the two Technology Transfer Offices will, as a last resort and according to the rules of the American Arbitration Association, select an Arbitrator to determine Relative Contributions of the Participants in a Disclosure.
3. a. The “University Allocation” of expenses and proceeds will be proportionate to the sum of the Relative Contributions by the individual Participants from the two universities.

For example, if two Pitt Participants made a total of 60% and three CMU Participants 40% of the Relative Contribution toward the invention, then 60% of total distributions will go to Pitt and 40% to CMU, for each university's respective further allocation of proceeds.

- b. The further allocation of each university's share of proceeds among its Participants, Participants' departments, and other units will be calculated in accordance with the IP Policies of each university.

In order to clarify and record all details of the resulting allocation of proceeds, a specific **Allocation Agreement** will be developed for each Disclosure, with individual allocations to be calculated in accordance with the combination of principles defined under 3.a and 3.b above; the Allocation Agreement will define the percentage of Net Proceeds to be received by each of the two universities and, in accordance with each university's policies, by each of the Participants and any other qualified units.

Third party interests, if any, which may be involved in any CP and/or Disclosure will be noted in each Allocation Agreement and will be taken into account in calculating Relative Contributions.

F. Designated / Responsible Technology Transfer Office.

1. The Participants in a Disclosure will propose which of the two Technology Transfer Offices (“TT Office”, at Pitt or CMU) they prefer to handle the potential commercialization of their Disclosure.

The Participants may make their proposal without regard to the Relative Contribution of the Participants from the two Universities. If the Participants' decision is not unanimous, the TT Office of the University whose participants made more than 50% Relative Contributions will be automatically proposed.

This Participants' proposal will be developed with the participation of the two TT Offices and will require their concurrence.

The TT Office thus chosen shall be called “Designated TT Office”.

Policy Guidelines – Intellectual Property Rights and TT Procedures in Collaborative Projects, Sept. 21, 1994, page 4

2. The Designated TT Office will have the **sole responsibility** for the commercialization of the IP disclosures resulting from CP's. The **normal policies and practices used by the Designated TT Office will apply**, including the decision process of whether or not the university wishes -
 - (a) to pursue the commercialization of a particular Disclosure, and in what manner, or
 - (b) to turn it back to the inventors.

The Designated TT Office will, however, include at least one faculty member of the other university in completing the evaluation process of each Disclosure.

If the Designated TT Office wishes to turn back a Disclosure to the inventors, the other, "Non-Designated" TT Office will then have the option of taking responsibility for pursuing that Disclosure. In that case, all other provisions of these Guidelines will remain in effect except that, contrary to Section G.2 below, this Non-Designated TT Office must also assume full responsibility for **all Docket Expenses incurred in pursuit of the commercialization of that Disclosure.**

The TT Office which emerges with the responsibility for the commercialization of a Disclosure will be called the "**Responsible TT Office**".

3. The Responsible TT Office will work closely with the Participants in planning and executing commercialization of that Disclosure. It will keep the Participants and the other TT Office well informed on its activities and plans, will be sensitive and responsive to any special circumstances (for example, special regulatory requirements) of the other university, and will consult with the other TT Office on such issues.

G. Sharing of Proceeds and Expenses.

1. Pitt and CMU will share the **Net Proceeds** from the commercialization of a Disclosure in proportion to the University Ownership Allocation for each Disclosure.

"**Net Proceeds**" are defined as -

- All gross proceeds received by the participating universities due to the commercialization of an IP, such as license fees, license income, and ownership in a related business entity (including realized capital gains),
- minus all allowable docket expenses for that Invention Disclosure ("Docket Expenses") which are incurred by the Responsible TT Office.

Docket Expenses may include all expenses incurred directly in the pursuit of the commercialization of an Invention Disclosure (Docket), including

- a. Patenting and other IP expenses, including related attorneys fees;
- b. Other legal expenses related to the Docket, including negotiating and litigation expenses;
- c. Direct selling and marketing expenses related to the Docket, such as the cost of "selling trips", customer entertainment, promotion and advertising;

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- d. The time spent by professionals in the Responsible TT Office in handling the Docket, charged at the hourly "billing rates" which are customarily used by that office; each TT Office will advise the other of the annual schedule of such rates at the beginning of each fiscal year.
- c. Consulting expenses related to the Docket.

In the case of planned material expenditures for a Docket which are unusual either in type or magnitude, the Responsible TT Office will advise the other of its plans in advance of incurring the commitment for such expenditures.

- 2. Docket Expenses will be shared and paid for by the two universities in proportion to the University Allocation of each Disclosure -- i.e. in all cases where the Designated TT Office is actually proceeding with the handling of a Disclosure.

The Designated TT Office will submit invoices to the other TT Office after the end of each calendar quarter for the other university's portion of Docket Expenses; such charges will be paid by that university within 30 days.

- 3. Net Proceeds will become available for Distribution once the Proceeds received for a Disclosure exceed Docket Expenses. Net Proceeds will be distributed by the Responsible TT Office to all Participants in accordance with the Allocation Agreement.

Distributions will be made as promptly as practical, with consideration of such factors as the status of the commercialization of each IP, the balance of expected future proceeds versus expected future expenses, and the normal accounting procedures of the TT Office, but at least once a year within 90 days from the end of the fiscal year of the Responsible TT Office.

- 4. Ownership participation in business entities related to a Disclosure (such as shares in the equity of start-up corporation) will be assigned to the two universities in accordance with each relevant Allocation Agreement; each university will handle any further assignments and/or distributions of ownership certificates and/or related cash proceeds in accordance with its own Policies.

H. Approval.

These Guidelines are approved for a three-year trial period ending 6/30/1997, and can be extended and/or amended by mutual agreement.

University of Pittsburgh :

Name : Ben J. Beck
Title : Sr. Vice Chancellor
Date : Oct 4, 1994

Carnegie Mellon University :

Name : Susan D. Dunle
Title : ASSOCIATE PROVOST
Date : Oct 13, 1994

EXHIBIT I

ORIGINAL

Policy Guidelines --
**Intellectual Property Rights and Technology Transfer Procedures
in Collaborative Projects
of the University of Pittsburgh and Carnegie Mellon University.**

June 6, 1997

A. Objectives.

The objectives of these Guidelines are -

1. to encourage collaboration between members of Carnegie Mellon University ("CMU") and the University of Pittsburgh ("Pitt"), for the benefit of all participants, both universities, the community, and society in general;
2. to provide clear policy guidelines on intellectual property ("IP") rights developed in Collaborative Projects ("CP's");
3. to facilitate the subsequent commercialization of IP rights.

B. Principles

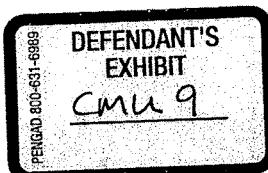
These Guidelines are built on the following principles :

1. Each participant's basic IP rights will be governed by the IP policies of that university in which the participant has his/her primary appointment -- ("Pitt Participant", "CMU Participant").
2. Invention disclosures will be the key vehicles for administering CP IP rights and commercialization projects.
3. The basic allocation between the two universities of ownership rights, expenses and proceeds ("University Allocation") will be calculated in accordance with the Relative Contributions toward each invention by the Participants from the two universities (see Section E.2), and the other provisions of these Guidelines.
4. The commercialization work for of each invention disclosure will be handled by the Technology Transfer Offices of one of the two universities, in accordance with the provisions of Section F. No new organization structures will be created.

SPECIFICS

C. Definition of Collaborative Projects

Prior to the formal beginning of a CP, the participating collaborators will, using their normal practices and procedures, define and agree to the following points : Definition of the CP, objectives, scope, principal investigators, expected funding, expected duration, and other dimensions of the project. Each such agreement will include mutual, blanket confidentiality agreements, as appropriate for each case.



CMU 0274

Policy Guidelines -- Intellectual Property Rights and TT Procedures in Collaborative Projects, Sept. 21, 1994, page 2

The allocation of ownership of IP among the participants and universities which may result from a CP will normally not be defined at this stage but will be determined later when specific Invention Disclosures are created.

D. Creation of IP Rights in CP's.

1. Mere discussion of a problem during collaboration between participants in a CP, without creating solutions to the problem, will not create any rights to ownership of patents, copyrights, trade secrets, or any other IP rights.
2. IP developed solely by Pitt Participants during collaboration will be owned entirely by Pitt, including title, interest, and IP rights.
3. IP developed solely by CMU Participants during collaboration will be owned entirely by CMU, including title, interest, and IP rights.
4. All IP developed jointly by CMU Participants and Pitt Participants during collaboration shall be owned jointly by Pitt and CMU and shall be administered in accordance with these Guidelines.

E. Invention Disclosures, Allocation of Proceeds.

1. It is recognized that different innovations made within the same CP are likely to have different characteristics; for example, they may involve different participants, may result in different university decisions regarding university commitment to commercialization, and may require different approaches to commercialization. The primary vehicle for managing IP and commercialization of innovations resulting from a CP will therefore be individual invention disclosures ("Disclosures").
2. With each Disclosure, the Participants must also define the "Relative Contribution" toward the invention made by each Participant. A Participant's Relative Contribution in a particular Disclosure may range from zero to 100 percent (for sole inventors).

Understands but impossible to calculate
The steps of reaching a definitive agreement on the Relative Contribution of all Participants will be as follows :

- a. The Participants in a Disclosure will aim to reach agreement with one another and will then propose a schedule of the Relative Contribution of each Participant. If no such agreement can readily be reached, the Participants will seek the advice and counsel of relevant department heads, program leaders, and one or both of the Technology Transfer Offices in order to reach such agreement. All such discussions, agreements, and resolutions of differences are to be dealt with in the same manner which is customary for "normal" for invention disclosures within each university.

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- b. The Technology Transfer Offices at both Universities must concur with each such proposal.
- c. If no agreement can be reached, the two Technology Transfer Offices will, as a last resort and according to the rules of the American Arbitration Association, select an Arbitrator to determine Relative Contributions of the Participants in a Disclosure.
- 3. a. The "University Allocation" of expenses and proceeds will be proportionate to the sum of the Relative Contributions by the individual Participants from the two universities.

For example, if two Pitt Participants made a total of 60% and three CMU Participants 40% of the Relative Contribution toward the invention, then 60% of total distributions will go to Pitt and 40% to CMU, for each university's respective further allocation of proceeds.

- b. The further allocation of each university's share of proceeds among its Participants, Participants' departments, and other units will be calculated in accordance with the IP Policies of each university.

In order to clarify and record all details of the resulting allocation of proceeds, a specific **Allocation Agreement** will be developed for each Disclosure, with individual allocations to be calculated in accordance with the combination of principles defined under 3.a and 3.b above; the Allocation Agreement will define the percentage of Net Proceeds to be received by each of the two universities and, in accordance with each university's policies, by each of the Participants and any other qualified units.

Third party interests, if any, which may be involved in any CP and/or Disclosure will be noted in each Allocation Agreement and will be taken into account in calculating Relative Contributions.

E. Designated / Responsible Technology Transfer Office.

- 1. The Participants in a Disclosure will propose which of the two Technology Transfer Offices ("TT Office", at Pitt or CMU) they prefer to handle the potential commercialization of their Disclosure.

The Participants may make their proposal without regard to the Relative Contribution of the Participants from the two Universities. If the Participants' decision is not unanimous, the TT Office of the University whose participants made more than 50% Relative Contributions will be automatically proposed.

This Participants' proposal will be developed with the participation of the two TT Offices and will require their concurrence.

The TT Office thus chosen shall be called "Designated TT Office".

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2. The Designated TT Office will have the sole responsibility for the commercialization of the IP disclosures resulting from CP's. The normal policies and practices used by the Designated TT Office will apply, including the decision process of whether or not the university wishes -
 - (a) to pursue the commercialization of a particular Disclosure, and in what manner, or
 - (b) to turn it back to the inventors.

The Designated TT Office will, however, include at least one faculty member of the other university in completing the evaluation process of each Disclosure.

If the Designated TT Office wishes to turn back a Disclosure to the inventors, the other, "Non-Designated" TT Office will then have the option of taking responsibility for pursuing that Disclosure. In that case, all other provisions of these Guidelines will remain in effect except that, contrary to Section G.2 below, this Non-Designated TT Office must also assume full responsibility for all Docket Expenses incurred in pursuit of the commercialization of that Disclosure.

The TT Office which emerges with the responsibility for the commercialization of a Disclosure will be called the "Responsible TT Office".

3. The Responsible TT Office will work closely with the Participants in planning and executing commercialization of that Disclosure. It will keep the Participants and the other TT Office well informed on its activities and plans, will be sensitive and responsive to any special circumstances (for example, special regulatory requirements) of the other university, and will consult with the other TT Office on such issues.

G. Sharing of Proceeds and Expenses.

1. Pitt and CMU will share the Net Proceeds from the commercialization of a Disclosure in proportion to the University Ownership Allocation for each Disclosure.

"Net Proceeds" are defined as -

- All gross proceeds received by the participating universities due to the commercialization of an IP, such as license fees, license income, and ownership in a related business entity (including realized capital gains),
- minus all allowable docket expenses for that Invention Disclosure ("Docket Expenses") which are incurred by the Responsible TT Office .

Docket Expenses may include all expenses incurred directly in the pursuit of the commercialization of an Invention Disclosure (Docket), including

- a. Patenting and other IP expenses, including related attorneys fees;
- b. Other legal expenses related to the Docket, including negotiating and litigation expenses;
- c. Direct selling and marketing expenses related to the Docket, such as the cost of "selling trips", customer entertainment, promotion and advertising;

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- d. The time spent by professionals in the Responsible TT Office in handling the Docket, charged at the hourly "billing rates" which are customarily used by that office; each TT Office will advise the other of the annual schedule of such rates at the beginning of each fiscal year.
- e. Consulting expenses related to the Docket.

In the case of planned material expenditures for a Docket which are unusual either in type or magnitude, the Responsible TT Office will advise the other of its plans in advance of incurring the commitment for such expenditures.

2. **Docket Expenses** will be shared and paid for by the two universities in proportion to the University Allocation of each Disclosure – i.e. in all cases where the Designated TT Office is actually proceeding with the handling of a Disclosure.

The Designated TT Office will submit invoices to the other TT Office after the end of each calendar quarter for the other university's portion of Docket Expenses; such charges will be paid by that university within 30 days.

3. **Net Proceeds** will become available for **Distribution** once the Proceeds received for a Disclosure exceed Docket Expenses. Net Proceeds will be distributed by the Responsible TT Office to all Participants in accordance with the Allocation Agreement.

Distributions will be made as promptly as practical, with consideration of such factors as the status of the commercialization of each IP, the balance of expected future proceeds versus expected future expenses, and the normal accounting procedures of the TT Office, but at least once a year within 90 days from the end of the fiscal year of the Responsible TT Office.

4. **Ownership participation** in business entities related to a Disclosure (such as shares in the equity of start-up corporation) will be assigned to the two universities in accordance with each relevant Allocation Agreement; each university will handle any further assignments and/or distributions of ownership certificates and/or related cash proceeds in accordance with its own Policies.

H. Approval.

These Guidelines are approved for a three-year period ending 6/30/2000, and can be extended and/or amended by mutual agreement.

University of Pittsburgh :

Name : James V. Maher

Title : JV

Date : 6/18/97

Carnegie Mellon University :

Name : John D. Brink

Title : JDB

Date : 6/6/97

EXHIBIT J

Carl Mahler

From: Reed McManigle [reedmcm@otm.lit.pitt.edu]
Sent: Friday, May 31, 2002 11:40 AM
To: Mahler Carl (E-mail)
Cc: Chris Capelli; Colecchia Theresa (E-mail)
Subject: new Interinstitutional

Attachments: Inter-Inst Agr #1 5-31-02.doc



Inter-Inst Agr #1
5-31-02.doc ... Carl

We need to do another interinstitutional agreement for three patented technologies that involved Takeo Kanade in the Robotics Institute, Charalambos Athanassiu, who was (is?) a visiting scientist in the Robotics Institute, working with Joel Greenberger, Andre Kalend and Karun Shimoga in our school of medicine. The technologies are for positioning patients during radiation therapy. They were developed with funding from Elekta, a manufacturer of radiation therapy equipment. The relationship with Elekta fell apart (with legal action underway to recoup unpaid research dollars). Elekta had paid for patent expenses during the term of the research agreement, which were filed in the US and internationally. We've been covering patent expenses since the Elekta relationship fell apart. We have three issued US patents: 5,823,192; 5,784,431; and 5,727,554

Recently, we were talking with another radiation therapy company, Varian, about another technology developed at Pitt by Don Sashin for positioning the patient's head (as distinguished from the other three technologies which related to whole body positioning). While I was talking to them about the Sashin technology, I asked if they might also want to take a look at the whole body positioning patents. They have been looking at them over the past few months, reviewing the patents, talking with the researchers, etc. and now have indicated that they want to license all four of the technologies.

My recollection is that we never had the inventors tell us their relative contribution to the inventions, so we'll have to get that information before we can fill in the split between Pitt and CMU. I'll email the inventors to get this rolling (I don't have contact information for Athanassiu, but I'm hoping that Kanade will). In the meantime, I've drafted an IIA based on the Stetten IIA for your review.

Reed

<<Inter-Inst Agr #1 5-31-02.doc>>

200 GSAC
Thackeray and O'Hara Street
Pittsburgh, PA 15260
412-624-8787
412-648-8525 (f)
reednmcm@pitt.edu

A rectangular stamp with a black border. The words "DEFENDANT'S" and "EXHIBIT" are stacked vertically in the center. Below them, "CMU 24" is written in a larger, bold font. The entire stamp is printed in black ink on a white background.

CMU 0227

INTER-INSTITUTIONAL AGREEMENT

THIS INTER-INSTITUTIONAL AGREEMENT ("AGREEMENT") is made effective as of this ____ day of _____, 2002, ("EFFECTIVE DATE") by and between CARNEGIE MELLON UNIVERSITY, a Pennsylvania non-profit corporation, located at 5000 Forbes Avenue, Pittsburgh, PA 15213 ("CMU"), and UNIVERSITY OF PITTSBURGH - OF THE COMMONWEALTH SYSTEM OF HIGHER EDUCATION, a Pennsylvania non-profit corporation, with an office at 200 Gardner Steel Conference Center, Thackeray and O'Hara Streets, Pittsburgh, Pennsylvania 15260 ("PITTSBURGH").

RECITALS

WHEREAS, Andre Kalend, Joel Greenberger and Karun Shimoga of PITTSBURGH and Takeo Kanade and Charalambos Athanassiou of CMU have collaborated in the research and development of three inventions titled "Apparatus responsive to movement of a patient during treatment/diagnosis;" "Apparatus for matching X-ray images with reference images;" and "Apparatus for automatically positioning a patient for treatment/diagnosis" (the "INVENTIONS"); and

WHEREAS, PITTSBURGH has filed U.S. and international patent applications on the INVENTIONS, and has been awarded U.S. patents 5,727,554, 5,784,431, and 5,823,192 and additional international patents; and

WHEREAS, CMU and PITTSBURGH wish to agree on the disposition of the INVENTIONS as defined hereafter and described above; the allocation of patenting and other expenses; and on the allocation of revenues from the commercialization of the INVENTIONS.

NOW, THEREFORE, in consideration of the premises and mutual covenants contained herein, and intending to be legally bound hereby, the parties hereto agree to the following terms and conditions:

ARTICLE 1 - DEFINITIONS

1.1 INVENTORS

"INVENTORS" means Andre Kalend, Joel Greenberger and Karun Shimoga of PITTSBURGH and Takeo Kanade and Charalambos Athanassiu of CMU.

1.2 PATENT

"PATENT" means those issued patents, any pending patent applications and any future United States and foreign application or patent covering the INVENTIONS or any part thereof.

1.3 LICENSE REVENUES

"LICENSE REVENUES" means the proceeds received by the parties from any licensing arrangement and includes license initiation fees, up-front fees, minimum royalties or milestone payments, sublicense initiation fees or any other fixed sum payments received from the licensing or other disposition of the PATENT(S) and all earned or running royalties on the sales of products covered under any claim of the PATENT(S), less fifteen percent (15%) of such revenues which shall be paid to PITTSBURGH for administrative overhead.

ARTICLE 2 - PATENTS AND EXPENSES

2.1 MANAGEMENT OF PATENT(S)

CMU and PITTSBURGH agree that PITTSBURGH shall be responsible for managing the prosecution and maintenance of the PATENT(S). PITTSBURGH shall consult with CMU on a timely basis on all significant matters relating to the prosecution and maintenance of the PATENT(S). PITTSBURGH shall promptly, upon request, provide CMU all serial numbers and filing dates, together with copies of all patent applications for the INVENTIONS, including copies of all office actions, responses and all other Patent Office communications and relevant correspondence.

2.2 UNITED STATES AND FOREIGN PATENT EXPENSES

Except as provided in Section 2.3 below, CMU and PITTSBURGH agree to share equally all reasonable United States and foreign patent expenses (including legal fees, filing, prosecution, and maintenance fees or other governmental charges) incurred in connection with PATENT(S). CMU's share of the past patent expenses, as of the execution date of this Agreement, shall be deducted from the LICENSE REVENUES prior to distribution. Future patent expenses, if any, will be subject to the provisions that follow. Payment of all fees and costs relating to the filing, prosecution, and maintenance of the PATENT(S) shall be paid initially by PITTSBURGH. PITTSBURGH shall give CMU quarterly notices along with documentation evidencing costs incurred (including copies of patent attorney invoices for which such payments have been made) and CMU shall reimburse PITTSBURGH within thirty (30) days after receipt of such quarterly notices for one-half (1/2) of such costs.

2.3 JURISDICTION AND NON-PAYMENT

The parties, in consultation with any licensees, if appropriate, shall mutually determine the countries or jurisdictions where patent applications for the PATENT(S) will be filed, prosecuted and maintained. If either party declines to pay its share of United States or foreign patent expenses for the prosecution or maintenance of a PATENT(S) in any country or jurisdiction, the other party may pay all such United States or foreign patent expenses but thereafter the paying party shall have sole authority over licensing and patent prosecution of the PATENT(S) in any such country or jurisdiction. The party who has such sole authority in a country shall not be under any obligation pursuant to Section 3.2 to share LICENSE REVENUES from such a country or jurisdiction with the other party.

ARTICLE 3 - LICENSING

3.1 LICENSING OF PATENT(S)

The parties agree that PITTSBURGH shall have the exclusive responsibility and authority: (a) to promote and market the PATENT(S) for licensing and

commercialization; (b) to identify and negotiate with appropriate parties interested in such licensing and commercialization rights for the PATENT(S); (c) to enter into binding license agreements or binding option agreements for the granting of an exclusive license including the right to grant sublicenses or non-exclusive licenses or commercialization rights for the PATENT(S); and (d) to manage any such license or option agreements for the PATENT(S). PITTSBURGH agrees to consult with CMU on the licensing strategy, commercialization efforts and the licensing terms. PITTSBURGH will provide CMU promptly, upon execution, with a copy of all option or license agreements for PATENT(S) entered into under this AGREEMENT. PITTSBURGH will not enter into any fully paid-up license agreements without the prior written consent of CMU. Pittsburgh will assure that all licenses and sublicenses thereunder shall contain the following provisions: a disclaimer of all warranties with respect to the INVENTIONS, indemnification by the Licensee of both PITTSBURGH and CMU for any third party claims resulting from Licensee's use of the INVENTIONS, a requirement that Licensee maintain insurance to meet its indemnification obligation in an amount no less than a one million dollar comprehensive general liability policy and a three million dollar umbrella policy, and an arbitration provision requiring arbitration of any disputes (except for infringement actions).

3.2 LICENSE REVENUES

The parties agree to share all LICENSE REVENUES received from any joint licensing arrangement for the PATENT(S) entered into under this AGREEMENT, except as provided in Section 2.3, in accordance with the following allocation: ____% PITTSBURGH; ____% CMU. After receipt by PITTSBURGH of the first such LICENSE REVENUES, PITTSBURGH will make quarterly payments to CMU within sixty (60) days after each March 31, June 30, September 30 and December 31 of each year, of CMU's share of such LICENSE REVENUES.

3.3 RETURN OF LICENSE

In the event that the PATENT(S) are licensed to an entity (or entities), and such entity subsequently returns or otherwise abandons the PATENT(S), or such license to the

PATENT(S) is terminated, resulting in no outstanding licenses, then following such return, abandonment or termination, the responsibility and authority for the licensing and commercialization of the PATENT(S) shall remain with PITTSBURGH for an additional period of two (2) years from the date of termination of such license. If at the conclusion of such additional two-year period, PITTSBURGH has been unsuccessful in licensing or commercializing the PATENT(S), then the parties agree to consult each other and decide together on the best commercialization strategy (and the responsibilities of the parties relating thereto) at that time.

ARTICLE 4 – PATENT INFRINGEMENT

In the event the PATENT(S) are infringed by a third party, CMU and PITTSBURGH, and, if appropriate, the exclusive licensee, shall determine a mutually beneficial course of action and division of expenses and recoveries at the time such infringement is discovered, consistent with the terms of any exclusive license then in effect. Both parties shall use all reasonable efforts to cooperate with each other in any action brought by or against the parties relating to the PATENT(S).

ARTICLE 5 – TERM

This AGREEMENT shall be in force from the EFFECTIVE DATE and shall remain in effect for the life of the last patent to expire under PATENT(S), unless otherwise terminated by operation of law or by acts of the parties in accordance with the terms of this AGREEMENT.

ARTICLE 6 – TERMINATION

- 6.1 Provided that a license agreement is not then in effect, CMU or PITTSBURGH may terminate this AGREEMENT for any reason upon at least sixty (60) days advance written notice to the other party, but in any event not less than sixty (60) days prior to the date on which any pending Patent Office actions need to be taken to preserve patent rights for the benefit of the parties hereto.

- 6.2 Termination of this AGREEMENT shall not relieve either party of any obligation or liability accrued hereunder prior to such termination, or rescind any payment due prior to the time such termination becomes effective.
- 6.3 In the event neither CMU nor PITTSBURGH wishes to retain PATENT(S) upon termination of this AGREEMENT, the parties shall consult each other and agree on how to dispose of PATENT(S).

ARTICLE 7 - CONFIDENTIAL INFORMATION

- 7.1 Both parties shall safeguard unpublished data, patent prosecution materials and option or license agreements relating to PATENT(S) (hereinafter referred to as "CONFIDENTIAL INFORMATION") against disclosure to third parties with the same degree of care as it exercises with its own data and proprietary agreements of a similar nature.
- 7.2 CMU and PITTSBURGH agree not to disclose CONFIDENTIAL INFORMATION to others (except to their employees, agents or consultants who are bound by a like obligation of confidentiality), except that the parties shall not be prevented from using or disclosing any CONFIDENTIAL INFORMATION:
 - (a) which is now, or becomes in the future, public knowledge other than through acts or omissions of receiving party;
 - (b) which is lawfully obtained by the receiving party without a confidentiality restriction and without breach of this Agreement from a source other than a party hereto; or
 - (c) which the receiving party can demonstrate was independently developed by employees of the receiving party having no knowledge of the CONFIDENTIAL INFORMATION.

- 7.3 PITTSBURGH shall disclose CONFIDENTIAL INFORMATION to potential licensees only under the protection of a confidentiality agreement for the sole purpose of evaluation of the PATENT(S) for commercial development in accordance with this AGREEMENT.
- 7.4 Upon termination of this AGREEMENT, both parties shall safeguard CONFIDENTIAL INFORMATION for two (2) years from the effective date of termination pursuant to Section 6.1.

ARTICLE 8 – REPORTS AND RECORDS

- 8.1 PITTSBURGH shall keep full, true and accurate books of account containing all particulars that may be necessary to show the amount paid by PITTSBURGH for patent application prosecution as aforesaid. Such books of account shall be kept at PITTSBURGH's principal place of business. Such books and the supporting data shall be open at reasonable times, upon advance request, for two (2) years following the end of the calendar year to which they pertain, for the inspection by CMU and/or an independent certified public accountant retained by CMU for the purpose of verifying patent prosecution expenses or compliance in other respects with this AGREEMENT.
- 8.2 PITTSBURGH, within ninety (90) days after each March 31, June 30, September 30 and December 31 of each year during the term of this Agreement, shall deliver to CMU true and accurate reports, giving such particulars of the business conducted by licensee(s) and sublicensee(s) of PATENT(S) during the preceding quarter as shall be pertinent to a royalty accounting hereunder. PITTSBURGH'S obligation to furnish such reports shall not commence until after receipt by PITTSBURGH of LICENSE REVENUES from a license for the PATENT(S). If no LICENSE REVENUES shall have been received, PITTSBURGH shall so report in writing. PITTSBURGH will keep accurate accounts of all LICENSE REVENUES received and will permit CMU to employ representatives to examine its books and records at reasonable times, upon advance request and no more than once per year, in

order to verify the payments due and owing under this AGREEMENT. The fees and expenses of such representatives shall be borne by CMU.

ARTICLE 9 – MISCELLANEOUS

9.1 RIGHTS OF GOVERNMENTS

Nothing in this AGREEMENT shall be construed to limit in any way the rights of the United States Government or other state or local governmental organization(s) under applicable federal, state or local regulations, rules or laws. Each party shall be separately responsible for complying with all reporting and other requirements of any federal or governmental entity with an interest in the INVENTIONS or the PATENT(S).

9.2 NOTICES, PAYMENTS AND OTHER COMMUNICATIONS

Any notice or payment made under this AGREEMENT shall be sufficiently given if sent in writing by first class mail, postage prepaid, or registered mail, return receipt requested, or by overnight courier service, with proof of service by receipt, addressed as follows:

If a notice, invoice or payment to Carnegie Mellon University:

Carnegie Mellon University

5000 Forbes Avenue
Pittsburgh, PA 15213
ATTN: _____

If a notice, invoice or payment to PITTSBURGH:

Office of Technology Management
University of Pittsburgh
200 Gardner Steel Conference Center
Thackeray and O'Hara Streets
Pittsburgh, PA 15260
ATTN: Director

with copies of notices to:

Office of General Counsel
University of Pittsburgh
1710 Cathedral of Learning
Pittsburgh, PA 15260-9165
ATTN: General Counsel

9.3 ENTIRE AGREEMENT AND CHANGES

This AGREEMENT embodies the entire understanding between the parties relating to the subject matter hereof and supersedes all prior understandings and agreements, whether written or oral. This AGREEMENT may not be varied or modified except by a written document signed by duly authorized representatives of both parties.

9.4 SURVIVING PROVISIONS

The provisions of Articles 2, 4, 7 and 9 shall survive termination of this AGREEMENT.

IN WITNESS WHEREOF, the duly authorized representatives of the parties have executed this Agreement as of the day and year first above written.

UNIVERSITY OF PITTSBURGH – OF THE
COMMONWEALTH SYSTEM OF HIGHER
EDUCATION

By: _____

Jerome Cochran
Executive Vice Chancellor

CARNEGIE MELLON UNIVERSITY

By: _____

EXHIBIT K

Carl Mahler

From: Reed McManigle [reedmcm@otm.it.pitt.edu]
Sent: Friday, May 31, 2002 11:54 AM
To: Greenberger, Joel (E-mail); Kanade Takeo (E-mail); Kalend Andre (E-mail)
Cc: Mahler Carl (E-mail)
Subject: patient positioning patents

Gentlemen,

per my emails yesterday, Varian has expressed interest in licensing the three patented technologies for patient positioning. As part of this licensing process, we'll need to reach some agreement between Pitt and CMU about how proceeds will be distributed, which is driven by the respective contributions of their inventors. I've searched my files, and conferred with Dr. Greenberger, but I can't find any indication of an agreement between the five inventors about their respective contributions. I did find a draft of an agreement from 1998 that indicated an equal split of 20% each, but I didn't find a signed agreement and Dr. Greenberger confirmed that there wasn't one.

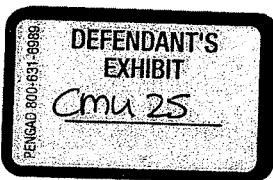
So can we get some agreement on the relative contribution to inventorship? And do you know how to get in touch with the other two inventors--Charalambos Athanassiou and Karun Shimoga--we'll need to get them and you to sign some agreement on the allocation of proceeds--and hopefully to send all of you some checks, if the licensing negotiations go well!

Thanks.

Reed

200 GSCC
Thackeray and O'Hara Street
Pittsburgh, PA 15260
412-624-8787
412-648-8525 (f)
reedmcm@pitt.edu

1



CMU 0237

EXHIBIT L

Carl Mahler

From: Carl Mahler [cmahter@andrew.cmu.edu]
Sent: Friday, May 31, 2002 12:43 PM
To: Reed McManigle
Subject: Re: new Interinstitutional
Attachments: Inter-Inst Agr #1 5-31-02.doc



Inter-Inst Agr #1
5-31-02.doc ...
Reed,

Thank you for the information and the draft IIA. As you probably recall, there are several other IIA's whose execution is currently stalled over three issues that are important to CMU, namely

- (1) approval of all licenses by CMU prior to execution on its behalf,
- (2) capping out-of-pocket patent expenses (at a level currently proposed to be \$25,000 which would be divided between both parties), and
- (3) removal of any obligation of CMU to support expenses of national phase prosecution of patents.

Section 2.3 of the agreement arguably addresses item number (3) above in that it indicates that a party can drop its support of patent applications on a country-by-country basis, but the other two issues are still very much alive.

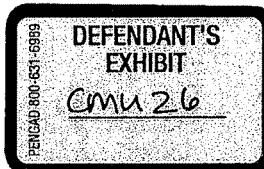
My understanding is that Bob Wooldridge is currently in discussions with Chris Capelli on these issues and that both sides hope to have a broad agreement that would resolve these issues once and for all. However, until this is resolved I think that CMU is unlikely to sign off on any of these IIA's.

I am copying Bob on this e-mail so that he is aware that there are more technologies being affected by this.

Sincerely,
Carl

--On Friday, May 31, 2002 11:39 AM -0400 Reed McManigle <reedmcm@tm.tt.pitt.edu> wrote:

```
> Carl,
>
> We need to do another interinstitutional agreement for three patented
> technologies that involved Takeo Kanade in the Robotics Institute,
> Charalampos Athanassiu, who was (is?) a visiting scientist in the
> Robotics Institute, working with Joel Greenberger, Andre Kalend and
> Karun Shimoga in our school of medicine. The technologies are for
> positioning patients during radiation therapy. They were developed
> with funding from Elekta, a manufacturer of radiation therapy
> equipment. The relationship with Elekta fell apart (with legal action
> underway to recoup unpaid research dollars). Elekta had paid for
> patent expenses during the term of the research agreement, which were filed in the US
> and internationally.
> We've been covering patent expenses since the Elekta relationship fell
> apart. We have three issued US patents: 5,823,192; 5,784,431; and
> 5,727,554
>
> Recently, we were talking with another radiation therapy company,
> Varian, about another technology developed at Pitt by Don Sashin for
> positioning the patient's head (as distinguished from the other three
> technologies which related to whole body positioning). While I was
> talking to them about the Sashin technology, I asked if they might
```



> also want to take a look at the whole body positioning patents. They
> have been looking at them over the past few months, reviewing the
> patents, talking with the researchers, etc. and now have indicated
> that they want to license all four of the technologies.
>
> My recollection is that we never had the inventors tell us their
> relative contribution to the inventions, so we'll have to get that
> information before we can fill in the split between Pitt and CMU.
> I'll email the inventors to get this rolling (I don't have contact
> information for Athanassiu, but I'm hoping that Kanade will). In the
> meantime, I've drafted an IIA based on the Stetten IIA for your review.
>
> Reed
>
> <<Inter-Inst Agr #1 5-31-02.doc>>
>
> 200 CSCC
> Thackeray and O'Hara Street
> Pittsburgh, PA 15260
> 412-624-8787
> 412-648-8525 (f)
> reedmcm@pitt.edu
>

INTER-INSTITUTIONAL AGREEMENT

THIS INTER-INSTITUTIONAL AGREEMENT ("AGREEMENT") is made effective as of this ____ day of _____, 2002, ("EFFECTIVE DATE") by and between CARNEGIE MELLON UNIVERSITY, a Pennsylvania non-profit corporation, located at 5000 Forbes Avenue, Pittsburgh, PA 15213 ("CMU"), and UNIVERSITY OF PITTSBURGH - OF THE COMMONWEALTH SYSTEM OF HIGHER EDUCATION, a Pennsylvania non-profit corporation, with an office at 200 Gardner Steel Conference Center, Thackeray and O'Hara Streets, Pittsburgh, Pennsylvania 15260 ("PITTSBURGH").

RECITALS

WHEREAS, Andre Kalend, Joel Greenberger and Karun Shimoga of PITTSBURGH and Takeo Kanade and Charalambos Athanassiou of CMU have collaborated in the research and development of three inventions titled "Apparatus responsive to movement of a patient during treatment/diagnosis;" "Apparatus for matching X-ray images with reference images;" and "Apparatus for automatically positioning a patient for treatment/diagnosis" (the "INVENTIONS"); and

WHEREAS, PITTSBURGH has filed U.S. and international patent applications on the INVENTIONS, and has been awarded U.S. patents 5,727,554, 5,784,431, and 5,823,192 and additional international patents; and

WHEREAS, CMU and PITTSBURGH wish to agree on the disposition of the INVENTIONS as defined hereafter and described above; the allocation of patenting and other expenses; and on the allocation of revenues from the commercialization of the INVENTIONS.

NOW, THEREFORE, in consideration of the premises and mutual covenants contained herein, and intending to be legally bound hereby, the parties hereto agree to the following terms and conditions:

ARTICLE 1 - DEFINITIONS

1.1 INVENTORS

"INVENTORS" means Andre Kalend, Joel Greenberger and Karun Shimoga of PITTSBURGH and Takeo Kanade and Charalambos Athanassiu of CMU.

1.2 PATENT

"PATENT" means those issued patents, any pending patent applications and any future United States and foreign application or patent covering the INVENTIONS or any part thereof.

1.3 LICENSE REVENUES

"LICENSE REVENUES" means the proceeds received by the parties from any licensing arrangement and includes license initiation fees, up-front fees, minimum royalties or milestone payments, sublicense initiation fees or any other fixed sum payments received from the licensing or other disposition of the PATENT(S) and all earned or running royalties on the sales of products covered under any claim of the PATENT(S), less fifteen percent (15%) of such revenues which shall be paid to PITTSBURGH for administrative overhead.

ARTICLE 2 – PATENTS AND EXPENSES

2.1 MANAGEMENT OF PATENT(S)

CMU and PITTSBURGH agree that PITTSBURGH shall be responsible for managing the prosecution and maintenance of the PATENT(S). PITTSBURGH shall consult with CMU on a timely basis on all significant matters relating to the prosecution and maintenance of the PATENT(S). PITTSBURGH shall promptly, upon request, provide CMU all serial numbers and filing dates, together with copies of all patent applications for the INVENTIONS, including copies of all office actions, responses and all other Patent Office communications and relevant correspondence.

2.2 UNITED STATES AND FOREIGN PATENT EXPENSES

Except as provided in Section 2.3 below, CMU and PITTSBURGH agree to share equally all reasonable United States and foreign patent expenses (including legal fees, filing, prosecution, and maintenance fees or other governmental charges) incurred in connection with PATENT(S). CMU's share of the past patent expenses, as of the execution date of this Agreement, shall be deducted from the LICENSE REVENUES prior to distribution. Future patent expenses, if any, will be subject to the provisions that follow. Payment of all fees and costs relating to the filing, prosecution, and maintenance of the PATENT(S) shall be paid initially by PITTSBURGH. PITTSBURGH shall give CMU quarterly notices along with documentation evidencing costs incurred (including copies of patent attorney invoices for which such payments have been made) and CMU shall reimburse PITTSBURGH within thirty (30) days after receipt of such quarterly notices for one-half (1/2) of such costs.

2.3 JURISDICTION AND NON-PAYMENT

The parties, in consultation with any licensees, if appropriate, shall mutually determine the countries or jurisdictions where patent applications for the PATENT(S) will be filed, prosecuted and maintained. If either party declines to pay its share of United States or foreign patent expenses for the prosecution or maintenance of a PATENT(S) in any country or jurisdiction, the other party may pay all such United States or foreign patent expenses but thereafter the paying party shall have sole authority over licensing and patent prosecution of the PATENT(S) in any such country or jurisdiction. The party who has such sole authority in a country shall not be under any obligation pursuant to Section 3.2 to share LICENSE REVENUES from such a country or jurisdiction with the other party.

ARTICLE 3 – LICENSING

3.1 LICENSING OF PATENT(S)

The parties agree that PITTSBURGH shall have the exclusive responsibility and authority: (a) to promote and market the PATENT(S) for licensing and

commercialization; (b) to identify and negotiate with appropriate parties interested in such licensing and commercialization rights for the PATENT(S); (c) to enter into binding license agreements or binding option agreements for the granting of an exclusive license including the right to grant sublicenses or non-exclusive licenses or commercialization rights for the PATENT(S); and (d) to manage any such license or option agreements for the PATENT(S). PITTSBURGH agrees to consult with CMU on the licensing strategy, commercialization efforts and the licensing terms. PITTSBURGH will provide CMU promptly, upon execution, with a copy of all option or license agreements for PATENT(S) entered into under this AGREEMENT. PITTSBURGH will not enter into any fully paid-up license agreements without the prior written consent of CMU. Pittsburgh will assure that all licenses and sublicenses thereunder shall contain the following provisions: a disclaimer of all warranties with respect to the INVENTIONS, indemnification by the Licensee of both PITTSBURGH and CMU for any third party claims resulting from Licensee's use of the INVENTIONS, a requirement that Licensee maintain insurance to meet its indemnification obligation in an amount no less than a one million dollar comprehensive general liability policy and a three million dollar umbrella policy, and an arbitration provision requiring arbitration of any disputes (except for infringement actions).

3.2 LICENSE REVENUES

The parties agree to share all LICENSE REVENUES received from any joint licensing arrangement for the PATENT(S) entered into under this AGREEMENT, except as provided in Section 2.3, in accordance with the following allocation: ____% PITTSBURGH; ____% CMU. After receipt by PITTSBURGH of the first such LICENSE REVENUES, PITTSBURGH will make quarterly payments to CMU within sixty (60) days after each March 31, June 30, September 30 and December 31 of each year, of CMU's share of such LICENSE REVENUES.

3.3 RETURN OF LICENSE

In the event that the PATENT(S) are licensed to an entity (or entities), and such entity subsequently returns or otherwise abandons the PATENT(S), or such license to the

PATENT(S) is terminated, resulting in no outstanding licenses, then following such return, abandonment or termination, the responsibility and authority for the licensing and commercialization of the PATENT(S) shall remain with PITTSBURGH for an additional period of two (2) years from the date of termination of such license. If at the conclusion of such additional two-year period, PITTSBURGH has been unsuccessful in licensing or commercializing the PATENT(S), then the parties agree to consult each other and decide together on the best commercialization strategy (and the responsibilities of the parties relating thereto) at that time.

ARTICLE 4 - PATENT INFRINGEMENT

In the event the PATENT(S) are infringed by a third party, CMU and PITTSBURGH, and, if appropriate, the exclusive licensee, shall determine a mutually beneficial course of action and division of expenses and recoveries at the time such infringement is discovered, consistent with the terms of any exclusive license then in effect. Both parties shall use all reasonable efforts to cooperate with each other in any action brought by or against the parties relating to the PATENT(S).

ARTICLE 5 – TERM

This AGREEMENT shall be in force from the EFFECTIVE DATE and shall remain in effect for the life of the last patent to expire under PATENT(S), unless otherwise terminated by operation of law or by acts of the parties in accordance with the terms of this AGREEMENT.

ARTICLE 6 – TERMINATION

- 6.1 Provided that a license agreement is not then in effect, CMU or PITTSBURGH may terminate this AGREEMENT for any reason upon at least sixty (60) days advance written notice to the other party, but in any event not less than sixty (60) days prior to the date on which any pending Patent Office actions need to be taken to preserve patent rights for the benefit of the parties hereto.

- 6.2 Termination of this AGREEMENT shall not relieve either party of any obligation or liability accrued hereunder prior to such termination, or rescind any payment due prior to the time such termination becomes effective.
- 6.3 In the event neither CMU nor PITTSBURGH wishes to retain PATENT(S) upon termination of this AGREEMENT, the parties shall consult each other and agree on how to dispose of PATENT(S).

ARTICLE 7 – CONFIDENTIAL INFORMATION

- 7.1 Both parties shall safeguard unpublished data, patent prosecution materials and option or license agreements relating to PATENT(S) (hereinafter referred to as "CONFIDENTIAL INFORMATION") against disclosure to third parties with the same degree of care as it exercises with its own data and proprietary agreements of a similar nature.
- 7.2 CMU and PITTSBURGH agree not to disclose CONFIDENTIAL INFORMATION to others (except to their employees, agents or consultants who are bound by a like obligation of confidentiality), except that the parties shall not be prevented from using or disclosing any CONFIDENTIAL INFORMATION:
 - (a) which is now, or becomes in the future, public knowledge other than through acts or omissions of receiving party;
 - (b) which is lawfully obtained by the receiving party without a confidentiality restriction and without breach of this Agreement from a source other than a party hereto; or
 - (c) which the receiving party can demonstrate was independently developed by employees of the receiving party having no knowledge of the CONFIDENTIAL INFORMATION.

- 7.3 PITTSBURGH shall disclose CONFIDENTIAL INFORMATION to potential licensees only under the protection of a confidentiality agreement for the sole purpose of evaluation of the PATENT(S) for commercial development in accordance with this AGREEMENT.
- 7.4 Upon termination of this AGREEMENT, both parties shall safeguard CONFIDENTIAL INFORMATION for two (2) years from the effective date of termination pursuant to Section 6.1.

ARTICLE 8 - REPORTS AND RECORDS

- 8.1 PITTSBURGH shall keep full, true and accurate books of account containing all particulars that may be necessary to show the amount paid by PITTSBURGH for patent application prosecution as aforesaid. Such books of account shall be kept at PITTSBURGH's principal place of business. Such books and the supporting data shall be open at reasonable times, upon advance request, for two (2) years following the end of the calendar year to which they pertain, for the inspection by CMU and/or an independent certified public accountant retained by CMU for the purpose of verifying patent prosecution expenses or compliance in other respects with this AGREEMENT.
- 8.2 PITTSBURGH, within ninety (90) days after each March 31, June 30, September 30 and December 31 of each year during the term of this Agreement, shall deliver to CMU true and accurate reports, giving such particulars of the business conducted by licensee(s) and sublicensee(s) of PATENT(S) during the preceding quarter as shall be pertinent to a royalty accounting hereunder. PITTSBURGH'S obligation to furnish such reports shall not commence until after receipt by PITTSBURGH of LICENSE REVENUES from a license for the PATENT(S). If no LICENSE REVENUES shall have been received, PITTSBURGH shall so report in writing. PITTSBURGH will keep accurate accounts of all LICENSE REVENUES received and will permit CMU to employ representatives to examine its books and records at reasonable times, upon advance request and no more than once per year, in

order to verify the payments due and owing under this AGREEMENT. The fees and expenses of such representatives shall be borne by CMU.

ARTICLE 9 - MISCELLANEOUS

9.1 RIGHTS OF GOVERNMENTS

Nothing in this AGREEMENT shall be construed to limit in any way the rights of the United States Government or other state or local governmental organization(s) under applicable federal, state or local regulations, rules or laws. Each party shall be separately responsible for complying with all reporting and other requirements of any federal or governmental entity with an interest in the INVENTIONS or the PATENT(S).

9.2 NOTICES, PAYMENTS AND OTHER COMMUNICATIONS

Any notice or payment made under this AGREEMENT shall be sufficiently given if sent in writing by first class mail, postage prepaid, or registered mail, return receipt requested, or by overnight courier service, with proof of service by receipt, addressed as follows:

If a notice, invoice or payment to Carnegie Mellon University:

Carnegie Mellon University

5000 Forbes Avenue
Pittsburgh, PA 15213
ATTN: _____

If a notice, invoice or payment to PITTSBURGH:

Office of Technology Management
University of Pittsburgh
200 Gardner Steel Conference Center
Thackeray and O'Hara Streets
Pittsburgh, PA 15260
ATTN: Director

with copies of notices to:

Office of General Counsel
University of Pittsburgh
1710 Cathedral of Learning
Pittsburgh, PA 15260-9165
ATTN: General Counsel

9.3 **ENTIRE AGREEMENT AND CHANGES**

This AGREEMENT embodies the entire understanding between the parties relating to the subject matter hereof and supersedes all prior understandings and agreements, whether written or oral. This AGREEMENT may not be varied or modified except by a written document signed by duly authorized representatives of both parties.

9.4 **SURVIVING PROVISIONS**

The provisions of Articles 2, 4, 7 and 9 shall survive termination of this AGREEMENT.

IN WITNESS WHEREOF, the duly authorized representatives of the parties have executed this Agreement as of the day and year first above written.

UNIVERSITY OF PITTSBURGH – OF THE
COMMONWEALTH SYSTEM OF HIGHER
EDUCATION

By: _____
Jerome Cochran
Executive Vice Chancellor

CARNEGIE MELLON UNIVERSITY

By: _____

EXHIBIT M

Carl Mahler

From: Reed McManigle [reednmc@otm.it.pitt.edu]
Sent: Wednesday, June 05, 2002 3:12 PM
To: Carl Mahler
Subject: RE: new interinstitutional-patent positioning

Carl,

I just wanted to give you an update that I've heard from four out of the five inventors on this and so far all are ok with an even split. I have my fingers crossed on the fifth one, but if anyone might think they had a larger role, it could be him. At any rate, if this even split among inventors holds up, we'd be looking at a 60/40 split of proceeds between Pitt and CMU as three of the inventors were at Pitt.

I wanted to clarify one other issue in the hopes that we can free this case up from the broader discussions about joint IP--and that is the issue of patent expenses. We're expecting that there really won't be any exposure here. Elekta paid for the patent expenses during the time that they were involved, and we intend to bill Varian for any expenses that weren't covered by Elekta. So at least those issues on this IIA should be moot.

So the remaining issue is whether CMU approves the licensing terms prior to execution. We see having the control of the negotiations as one of the main benefits of doing an interinstitutional, to facilitate rapid closure of deals. We sign many IIA's each year which give the lead institution authority to negotiate and complete the deal. This is how the Stetten/Nowatzky IIA was structured between Pitt and CMU last November. So I hope that you and Bob can let this IIA go ahead, even if the larger issue continues to be studied by the powers that be, so we can be responsive to this potential licensee.

Reed

-----Original Message-----

From: Carl Mahler [mailto:cmahler@andrew.cmu.edu]
Sent: Friday, May 31, 2002 12:43 PM
To: Reed McManigle
Subject: Re: new interinstitutional

Reed.

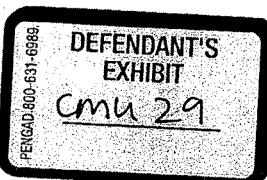
Thank you for the information and the draft IIA. As you probably recall, there are several other IIA's whose execution is currently stalled over three issues that are important to CMU, namely
(1) approval of all licenses by CMU prior to execution on its behalf,
(2) capping out-of-pocket patent expenses (at a level currently proposed to be \$25,000 which would be divided between both parties), and
(3) removal of any obligation of CMU to support expenses of national phase prosecution of patents.

Section 2.3 of the agreement arguably addresses item number (3) above in that it indicates that a party can drop its support of patent applications on a country-by-country basis, but the other two issues are still very much alive.

My understanding is that Bob Wooldridge is currently in discussions with Chris Capelli on these issues and that both sides hope to have a broad agreement that would resolve these issues once and for all. However, until this is resolved I think that CMU is unlikely to sign off on any of these IIA's.

I am copying Bob on this e-mail so that he is aware that there are more technologies being affected by this.

Sincerely,
Carl



CMU 0256

EXHIBIT N

Carl Mahler

From: Reed McManigle [reed@cmu.edu]
Sent: Thursday, June 06, 2002 9:03 AM
To: Takeo Kanade; Greenberger, Joel (E-mail); Kalend Andre (E-mail);
Shimoga Karun (E-mail); Athanassiou Haralabos (E-mail)
Cc: Mahler Carl (E-mail); Chris Capelli
Subject: RE: patient positioning patents

Gentlemen,

I've now heard from all five inventors and all are ok with the even split. This means that the interinstitutional agreement between Pitt and CMU will provide for 60% of the proceeds to go to Pitt, and 40% to CMU, as there are three inventors from Pitt and two from CMU. Distributions to inventors within each university will follow that university's intellectual property policies.

I'll keep you posted as the discussions with Varian proceed.

Reed

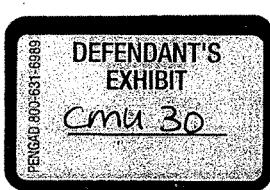


EXHIBIT O

Carl Mahler

From: Reed McManigle [reedmcm@otm.ti.pitt.edu]
Sent: Thursday, June 06, 2002 10:28 AM
To: Takeo Kanade; Greenberger, Joel (E-mail); Kalend Andre (E-mail); Shimoga Karun (E-mail); Athanassiou Haralabos (E-mail)
Cc: Mahler Carl (E-mail); Chris Capelli
Subject: RE: patient positioning patents

Per the email below, Joel has let me know that Karun was a CMU employee at the time of the invention and only became a Pitt employee later. Therefore the split between the two universities would be reversed from what I had indicated earlier--60% for CMU, 40% for Pitt.

Thanks for the clarification Joel.

Reed

Reed,

At the time these patents were submitted Shimoga was a CMU employee, only "based" at Pitt to work with Kalend and me. Remember we only hired Shimoga after Elekta granted us the money and that was after the patents had issued.

Kalend and Greenberger are the only Pitt employees. Please correct this .

Thanks, Joel

-----Original Message-----

From: Reed McManigle
Sent: Thursday, June 06, 2002 9:03 AM
To: 'Takeo Kanade'; 'Greenberger, Joel (E-mail)'; 'Kanade Takeo (E-mail)'; 'Kalend Andre (E-mail)'; 'Shimoga Karun (E-mail)'; 'Athanassiou Haralabos (E-mail)'
Cc: 'Mahler Carl (E-mail)'; Chris Capelli
Subject: RE: patient positioning patents

Gentlemen,

I've now heard from all five inventors and all are ok with the even split. This means that the interinstitutional agreement between Pitt and CMU will provide for 60% of the proceeds to go to Pitt, and 40% to CMU, as there are three inventors from Pitt and two from CMU. Distributions to inventors within each university will follow that university's intellectual property policies.

I'll keep you posted as the discussions with Varian proceed.

Reed

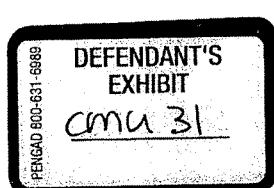


EXHIBIT P

Carl Mahler

From: Reed McManigle [reedmcm@otm.tt.pitt.edu]
Sent: Tuesday, June 18, 2002 9:17 AM
To: Carl Mahler
Subject: RE: Patient Positioning Patents

Hi Carl,

Thanks for your movement on this. I haven't made a proposal to Varian yet, because we hadn't worked out something that would give Pitt negotiating authority--I didn't want to go out on the limb by making a proposal to Varian, with the chance of finding out later that CMU had an issue with that, and that I'd then have to rescind the proposal. So now based on your email, and the expectation of a forthcoming IIA, I'll go ahead and discuss a deal proposal with Chris and will get it out to Varian.

I'll keep you posted on how things progress.

Reed

-----Original Message-----

From: Carl Mahler [mailto:cmaehler@andrew.cmu.edu]
Sent: Tuesday, June 18, 2002 8:20 AM
To: Reed McManigle
Subject: Patient Positioning Patents

Hi Reed,

Sorry that I've been so uncommunicative. Is Varian still interested in the patient positioning technology? If so, I think we've found a way to move forward on this IIA. Since the patent costs are not an issue it looks like there are only two problems left; (1) control of the licensing process and (2) exceptions to CMU's IP policy. I think that we can probably give on point (1) in this case, although we really don't want it to count a setting a precedent, and we can probably handle point (2) by getting the CMU inventors to agree to this deviation from policy by signing a separate letter.

I hope that my delay hasn't caused problems. Please let me know how things stand and if the licensing potential is still alive, I'll try to resolve the situation in the next few days.

Thanks,
Carl

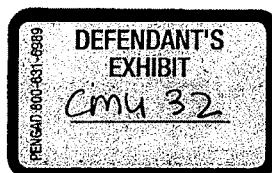


EXHIBIT Q

Carl Mahler

From: Reed McManigle [reedmcm@otm.tt.pitt.edu]
Sent: Tuesday, September 10, 2002 9:13 AM
To: Greenberger, Joel (Greenberger, Joel); kalenda@rcbhsc.wvu.edu; tk@cs.cmu.edu; kshimoga@automatedcell.com; athanassiou+@automatedcell.com; Sashin, Don (Sashin, Don)
Cc: cmahler@cmu.edu; Chris Capelli
Subject: Varian

-----Original Message-----

From: Lester Boeh [mailto:lester.boeh@varian.com]
Sent: Monday, September 09, 2002 4:45 PM
To: Reed McManigle
Cc: 'Morse Richard (E-mail)'
Subject: RE: Checking in

Hi Reed,
I'll let Richard comment on the Sashin patent since he will be in Pittsburgh. With regard to the Greenberger, et al patents, I don't see us being able to pursue them at this time from my perspective. Perhaps Richard has a comment here as well.
Thanks and Best Regards,
Lester Boeh

-----Original Message-----

From: Reed McManigle [mailto:reedmcm@otm.tt.pitt.edu]
Sent: Thursday, September 05, 2002 7:57 AM
To: 'lester.boeh@varian.com'
Cc: Morse Richard (E-mail)
Subject: RE: Checking in

Hi Lester and Richard,

I'm checking in again to find out where you are at with regard to the various technologies at Pitt (and CMU). Don Sashin has told me that Richard will be coming to Pittsburgh on September 18 and Drs. Kalnicki and Wu will visit Palo Alto in November. Could you give me a sense of the breadth of these discussions--e.g. will you be looking at/discussing the Sashin/Lopresti head positioning system, as well as the Greenberger/Kalend/Kanade body positioning system?

Your last communication gave me the impression that you would not be looking at the Greenberger/Kalend/Kanade during the visit that had been scheduled in August. Does this imply that you are no longer considering that technology?
We have some patent expenses coming up on those patents (i.e. in Korea) that we are unlikely to make if either you are not interested in that patent portfolio, or not interested in patent coverage in Korea.

At any rate, I would appreciate an update and some more detailed sense of where you see this all going, and what the timeline will be for a definitive decision on licensing.
Thanks.

Reed

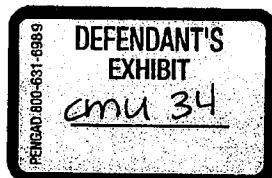


EXHIBIT T

201

FOR ATTORNEYS' EYES ONLY

1 IN THE UNITED STATES DISTRICT COURT FOR THE
WESTERN DISTRICT OF PENNSYLVANIA

4 UNIVERSITY OF PITTSBURGH,)
5 Plaintiff,)
6 -vs-) Case No.
7 VARIAN MEDICAL SYSTEMS, INC.,) 07-CV-00491 (AJS)
8 Defendant.)

ORIGINAL

CONFIDENTIAL - ATTORNEYS' EYES ONLY

14 VIDEOTAPE DEPOSITION OF: JOEL GREENBERGER, M.D.
VOLUME II

17 DATE: October 24, 2007
Wednesday, 9:16 a.m.

19 LOCATION: PICADIO SNEATH
20 MILLER & NORTON
21 4710 U.S. Steel Tower
600 Grant Street
Pittsburgh, PA 15219

TAKEN BY: Defendant

24 REPORTED BY: Heidi H. Willis, RPR, CRR
25 Notary Public
AKF Reference No. HW03678

1 VIDEOTAPE DEPOSITION OF JOEL GREENBERGER, M.D.,
2 a witness, called by the Defendant for examination,
3 in accordance with the Federal Rules of Civil
4 Procedure, taken by and before Heidi H. Willis, RPR,
5 CRR, a Court Reporter and Notary Public in and for
the Commonwealth of Pennsylvania, at the offices of
Picadio Sneath Miller & Norton, 4710 U.S. Steel
Tower, 600 Grant Street, Pittsburgh, Pennsylvania,
on Wednesday, October 24, 2007, commencing at
9:16 a.m.

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- - - -

7

APPEARANCES:

8

FOR THE PLAINTIFF:

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- and -

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25

ALSO PRESENT:

Matthew Martin, Videographer

1

- - - -

2

(Deposition Exhibit Nos. 21 through 44 marked for
identification.)

4

- - - -

5

PROCEEDINGS

6

- - - -

7

THE VIDEOGRAPHER: Good morning. My
name is Matthew Martin. I'm here from AKF
Reporting and VideoTech Services. I am the
videographer.

11

Today's date is Wednesday, October
24th, 2007. The time right now is 9:17 a.m.
and that's indicated on the screen.

14

We are hear to take the video
deposition of Dr. Joel Greenberger in the case
university of Pittsburgh versus Varian Medical
Systems.

18

We are at 600 Grant Street,
Pittsburgh, Pennsylvania 15219, and we are at
the offices of Picadio Sneath,
Miller & Norton, and this case is being heard
in the U.S. District Court of Western
Pennsylvania, Civil Action No. 2:07 CV-00491.

24

If the court reporter may swear in
the witness, we may proceed.

1 - - -
2 JOEL GREENBERGER, M.D.,
3 having been duly sworn,
4 was examined and testified as follow:
5 - - -

6 MR. POPPE: Good morning,
7 Dr. Greenberger.

8 THE WITNESS: Good morning.

9 MR. POPPE: Dan, I'll note that --
10 well, this is obviously the resumed deposition
11 of Dr. Greenberger. At the previous
12 deposition there were 20 exhibits marked, so
13 we'll just resume with Exhibit 21. Do you
14 have any problem with that?

15 MR. JOHNSON: Not at all.

16 - - -
17 EXAMINATION
18 - - -

19 BY MR. POPPE:

20 Q. Dr. Greenberger, let me show you what's been
21 Marked Exhibit 21, a copy for your counsel.
22 My question is whether you can identify this
23 document after taking the time you need to
24 review it.

25 - - -

1 or model numbers, can you describe the
2 technology -- strike that.

3 Did you describe the technology to your
4 tech transfer office that was generating
5 concerns in your mind about possible
6 infringement by Varian?

7 A. I sent them some documentation, and I have
8 given to counsel and sent it to them over the
9 years in various forms.

10 Q. And was your concern in the '99 to 2002 time
11 frame related to possible infringement of your
12 image matching patent or your respiratory
13 gating patent or both?

14 A. Certainly both and -- yes, both.

15 Q. And you expressed that concern to your tech
16 transfer office during the '99 to 2000 time
17 period?

18 A. I don't know if I stated it just the way you
19 stated it, but I know I said I'm concerned
20 about the things that Varian is talking about
21 selling sound to me like the things we
22 developed in our patents and are contained in
23 our patents.

24 Q. What was the Varian technology, again, putting
25 aside the specific product or model names, in

1 the '99 to 2002 time period that in your mind
2 implicated possible infringement of the
3 respiratory gating patent, if any?

4 A. Well, the best way to answer that is during
5 the early stages of the development, the
6 Varian people were in Pittsburgh negotiating
7 with us to partner, and as part of that
8 process, under confidentiality we showed them
9 what we were doing.

10 And I believe at the end of the
11 deposition last time, near the end of the
12 deposition, you were asking me about what I
13 had hoped the relationship would be, and then
14 you asked me why it didn't stay positive, and
15 I believe I answered you that early on I
16 expected a collegial, professional
17 collaborative arrangement, and reason it went
18 sour is that I felt that Varian people were
19 dismissing us and did not want to work with us
20 except as customers to purchase equipment,
21 and, therefore, I expected in good faith that
22 even though we wouldn't be partners, we would
23 respect each other.

24 As part of that, I fulfilled what I
25 thought was a respectful relationship by

1 A. Yes.

2 Q. So to go back to the prior question, based on
3 Exhibit 33, do you believe that this meeting
4 referenced here that was going to take place
5 in November of 1993 actually did occur given
6 that that would be prior to the date of the
7 confidential disclosure agreement?

8 A. I don't remember the date of the trip. I
9 don't remember if we went in November or we
10 went later.

11 Q. How many trips did you have in the '93, '94
12 time frame to Varian related to the program?

13 A. I don't recall. I recall one.

14 Q. Referring still to Exhibit 33, it says, This
15 meeting is for research collaboration. Do you
16 see that?

17 A. Yes.

18 Q. What did you mean by research collaboration?

19 A. I was being very careful to separate what I
20 anticipated would be a research sponsor
21 agreement from an agreement to purchase
22 equipment, and I was being careful at this
23 time in our negotiations with Varian just as I
24 testified earlier that I was being careful in
25 our negotiations about Elekta.

1 When this planned partnership with Varian
2 fell through and we moved toward with Elekta,
3 you recall I indicated that my attorney, Al
4 Ciocca, working on UPMC, then University of
5 Pittsburgh hospitals, which would be
6 Presbyterian University Hospital, Magee-Womens
7 Hospital, his actions negotiating the purchase
8 agreement I wanted to keep separate from the
9 negotiations with my other attorney, Reed
10 McManigle, representing the tech transfer
11 office.

12 What I was indicating here -- this memo
13 is to Jodi Ruey, who was the then academic
14 administrator for the department of radiation
15 oncology who handled all of my budgets,
16 school, hospital research grants, and Eva
17 Bednar, who was the department accountant, and
18 to put this in context, back in 1993
19 University Radiotherapy Associates was a
20 separate practice plan for just radiation
21 oncology. We had some discretionary moneys.
22 We wanted to be sure that we separated
23 expenditure of those moneys for research
24 purposes from any expenditure to purchase
25 equipment.

1 Q. Still referring to Exhibit 33, is that your
2 handwritten initials next to your name on the
3 from line?

4 A. Yes.

5 Q. Do you recall when you first spoke to a Varian
6 employee related to your dynamic conformal
7 radiotherapy program?

8 A. It was shortly after my arrival in Pittsburgh,
9 shortly after March 1993.

10 Q. Who did you talk to at Varian at that time?

11 A. The main issue --

12 MR. JOHNSON: He asked you who you
13 talked to.

14 A. Who, I'm sorry, Bud Poston, is that his name,
15 salesperson, Jack Coats, salesperson, and
16 Martin Kandes.

17 Q. How did you first make contact with them or
18 vice versa related to the program?

19 A. We, Dr. Kalend and myself, put together the
20 dynamic conformal radiotherapy program very
21 early, March 1993, and for the months
22 thereafter. As we were, on one hand, putting
23 together the Pittsburgh group, the meetings I
24 described with Contraves, with the Carnegie
25 Group, with CMU faculty, as that was going on,

1 the hospital was also contemplating purchase
2 of equipment for Magee-Womens Hospital and for
3 an upgrade of equipment at Presbyterian
4 University Hospital.

5 So salespeople were coming through
6 meeting with Joyce Yasko, who we referenced
7 earlier, and Keith Noll, who we referenced
8 earlier. In the course of those meetings,
9 they were introduced to me.

10 Q. And those salespeople were the persons you
11 referenced earlier?

12 A. Bud Poston, Jack Coats, C-O-A-T-E-S, I believe
13 that's how he spells his name.

14 Q. And Martin Kandes or no?

15 A. Martin Kandes very shortly thereafter.

16 Q. And what did you tell them about your program
17 at that time?

18 A. Very early on with them, as well as
19 representatives from Siemens and Elekta, who
20 also were negotiating to sell equipment,
21 Dr. Kalend and I informed them, as did Joyce
22 Yasko, that we would not be simply purchasing
23 equipment, that the rules had changed. We now
24 had a chairman of radiation oncology and the
25 director of medical physics who were

1 inventors, and that the vendor who wanted to
2 sell us equipment needed to know that we were
3 developing a novel technology for what we call
4 dynamic conformal radiotherapy.

5 My recollection is very early on, Bud
6 Poston and Jack Coats got Martin Kandes
7 involved.

8 Q. What do you mean when you say that the rules
9 have changed?

10 A. In the past, purchase of equipment for Magee-
11 Womens Hospital, Presbyterian University
12 Hospital had been simply vendor-customer
13 interactions: give us the best price, give us
14 the best service contract, give us the photon
15 and the electron energies we need, give us
16 your latest upgrades, work with us to
17 facilitate minimum downtime, classic customer-
18 vendor interactions.

19 What I mean by the rules have changed is
20 we were committed to implementing our new
21 inventions, and we wanted to purchase
22 equipment from a vendor who would also be our
23 partner in development of the inventions. We
24 explained that very clearly to Varian, to
25 Siemens and Elekta.

1 Varian jumped on the opportunity, and as
2 I said the last time I was here, the initial
3 interactions were very positive, very
4 collegial and very optimistic.

5 Q. Was an element of the changing rules that you
6 expected the vendor from whom you purchased
7 equipment to fund your research as a condition
8 for the purchase of equipment?

9 A. No, not necessarily. That's part of how the
10 rules were changing. The old paradigm, the
11 old way of doing business always included some
12 funding of research, but it was done in the
13 form of grants or support for a physics
14 postdoctoral fellow. It was done in the form
15 of some modest cash payment to the physics
16 division for research support which would of
17 course benefit the university, but would
18 primarily benefit the vendor because such
19 research would be in the form of cash
20 delivered with usually some strings attached
21 in the sense that in some arrangements
22 anything invented would be right of first
23 refusal or the property of the vendor or such
24 publications would have to be vetted by the
25 vendor. It was a one-sided kind of

1 relationship, in my mind all benefiting a
2 vendor.

3 The rules change that I described is one
4 in which the scientists and the vendor would
5 collaborate by writing joint research grants
6 or by putting their own independent funding
7 into a pool for joint venture, which would be
8 one of development and would have joint
9 ownership.

10 Q. I'm handing you Exhibit 34. Exhibit 34 is a
11 document that Varian has produced in this
12 case, Bates No. VAR 00313545, appears to be a
13 letter from you to Martin Kandes at Varian
14 dated December 3rd, 1993.

15 Is this a letter that you wrote?

16 A. Yes.

17 Q. You signed it?

18 A. Yes.

19 Q. And sent it to Varian on or about December
20 3rd, '93?

21 A. Yes.

22 Q. The first sentence refers to Martin Kandes,
23 Tom Vogel and Jack Coats of Varian coming to
24 meet with you, Dr. Kalend and Mr. McManigle at
25 UPMC; is that correct?

1 A. University of Pittsburgh Medical Center, yes.

2 Q. And do you recall that meeting?

3 A. There were many meetings. I don't recall the
4 specific one.

5 Q. There were many in-person meetings?

6 A. Yes.

7 Q. How many in-person meetings between you and
8 Varian do you recall in '93 and '94 prior to
9 the -- let's say the rejection of the NIST ATP
10 submission?

11 A. Difficult for me to put a number on that
12 because of the large numbers of phone calls
13 and communications, drafts of grants going
14 back and forth. I had the feeling that during
15 late December 1993 and early 1994, well, late
16 1993 not just December, and early 1994, that
17 Varian, their scientists and their
18 collaborators, and the salespeople were, as I
19 would describe it, they were the main event in
20 my academic life.

21 Q. There is a sentence in the first paragraph of
22 Exhibit 34 that says, We are delighted that
23 the proposed collaboration between UPMC and
24 Varian Corporation appears to be taking
25 shape. Do you see that?

1 be perfectly positioned to be marketed,
2 commercialized by Varian.

3 So this agreement was one step along that
4 way, and as I testified previously, it
5 incorporated some of the concepts that I
6 described as a partnership because we were
7 cooperating in applying for a grant. We
8 weren't accepting money from Varian to do the
9 research. I think that's the essence of the
10 partnership.

11 Q. What confidential information did you provide
12 to Varian pursuant to this agreement?

13 A. We gave them access to everything, from March
14 of 1993 when Dr. Kalend and I began to
15 envision the overall dynamic conformal
16 radiotherapy program, began to generate
17 documents, including that poster presentation
18 at Nemacolin. We shared all of that with
19 Martin Kandes.

20 Q. Shared meaning what?

21 A. Let him read it, let him see it, explained it
22 to him, brought him to Pittsburgh, showed him
23 how we would do it, explained to him how the
24 Kanade cameras worked and how they would be
25 adapted to monitor patient movement and

positioning, explained to him how we were going to do the matching for tracking the position of the tumor target relative to a point in time of the treatment and how that matched to the simulation, and essentially shared with him the entire vision of the program.

8 Q. Did you provide Mr. Kandes with any written
9 materials containing information for him to
10 retain that you -- that contained information
11 you considered to be confidential?

A. Absolutely.

13 Q. What were those written materials?

14 A. The grant application, early drafts, it
15 proposes the specific aims in that application
16 were very much the essence of our conception
17 of the inventions.

18 Q. Anything else other than those particular
19 materials that you just identified?

20 A. Many of the figures and photographic materials
21 showing him the way we would set it up,
22 demonstrations of how we were going to do it.
23 I'm recalling those times where I was
24 present. He spent significant time with
25 Dr. Kalend as well and --

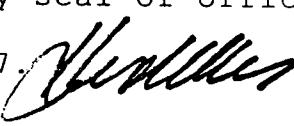
1 COMMONWEALTH OF PENNSYLVANIA

2 COUNTY OF ALLEGHENY

3 I, Heidi H. Willis, RPR, CRR, a Court Reporter
4 and Notary Public in and for the Commonwealth of
5 Pennsylvania, do hereby certify that the witness,
6 JOEL GREENBERGER, M.D., was by me first duly sworn
7 to testify to the truth; that the foregoing
8 deposition was taken at the time and place stated
9 herein; and that the said deposition was recorded
10 stenographically by me and then reduced to printing
11 under my direction, and constitutes a true record of
12 the testimony given by said witness.

13 I further certify that the inspection, reading
14 and signing of said deposition were NOT waived by
15 counsel for the respective parties and by the
16 witness.

17 I further certify that I am not a relative or
18 employee of any of the parties, or a relative or
19 employee of either counsel, and that I am in no way
20 interested directly or indirectly in this action.

21 IN WITNESS WHEREOF, I have hereunto set my hand
22 and affixed my seal of office this 8th day of
23 November, 2007. 

COMMONWEALTH OF PENNSYLVANIA

Notarial Seal
Heidi H. Willis, Notary Public
City Of Pittsburgh, Allegheny County
My Commission Expires July 8, 2008

Member, Pennsylvania Association Of Notaries

25 Notary Public

EXHIBIT U

CONFIDENTIAL

1 IN THE UNITED STATES DISTRICT COURT FOR THE
2 WESTERN DISTRICT OF PENNSYLVANIA

3 UNIVERSITY OF PITTSBURGH,)
4)
5 Plaintiff,)
6) Case No.
7 -vs-) 07-CV-0791 (AJS)
8 VARIAN MEDICAL SYSTEMS, INC.,)
9)
10 Defendant.)
11 *original*
12 - - - - -

13 CONFIDENTIAL

14 - - - - -
15 DEPOSITION OF: ALEXANDER J. CIOCCA, ESQ.

16 - - - - -
17 DATE: October 3, 2007
18 Wednesday, 9:23 a.m.

19 LOCATION: UPMC Shadyside Hospital
20 Medical Office Building
21 5150 Centre Avenue
22 Fifth Floor Conference Room
23 Pittsburgh, PA 15213

24 TAKEN BY: Defendant

25 REPORTED BY: Heidi H. Willis, RPR, CRR
Notary Public
AKF Reference No. HW03565

1 DEPOSITION OF ALEXANDER J. CIOCCA, ESQ.,
2 a witness, called by the Defendant for examination,
3 in accordance with the Federal Rules of Civil
4 Procedure, taken by and before Heidi H. Willis, RPR,
CRR, a Court Reporter and Notary Public in and for
the Commonwealth of Pennsylvania, at the UPMC
Shadyside Medical Office Building, 5150 Centre
Avenue, Fifth Floor Conference Room, Pittsburgh,
Pennsylvania, on Wednesday, October 3, 2007,
commencing at 9:23 a.m.

6

7

8

APPEARANCES:

9

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21

22

23

24

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1 ALEXANDER J. CIOCCA, ESQ.,
2 being first duly sworn,
3 was examined and testified as follows:

4 - - - -

5 EXAMINATION

6 - - - -

7 BY MR. SNEATH:

8 Q. Mr. Ciocca, Al, may I call you Al today?

9 A. Yes, please.

10 Q. Al, my name is Henry Sneath, as you know. I
11 represent Varian Medical Systems in a lawsuit
12 that's been filed by the University of
13 Pittsburgh in the Western District of
14 Pennsylvania.

15 I know you are familiar with this
16 process, you being an attorney, but I'll just
17 remind you of a couple things. I'm going to
18 ask you questions today pursuant to a subpoena
19 and Notice of Deposition, and if you don't
20 understand my question, please exercise your
21 right to ask me to rephrase it or ask it again,
22 I'll be happy to do so. If you need to take a
23 break, just let me know.

24 Are you representing yourself, or are
25 you unrepresented? In what capacity are you

1 appearing today as a witness, if any?

2 A. Just as a witness for this deposition.

3 Q. All right. And have you been designated by
4 UPMC as a corporate representative pursuant to
5 that Notice of Deposition?

6 A. Yes.

7 Q. Al, state your full name, please.

8 A. It's Alexander J. C-I-O-C-C-A.

9 Q. And what's your current home address?

10 A. Current home address is 4011 Chelstead,
11 C-H-E-L-S-T-E-A-D, Way, Murrysville, PA 15668.

12 Q. In an effort to shorten this up today, I asked
13 you to send me your CV, and we've marked it as
14 Exhibit 26. All of the exhibits today are
15 going to bear the Bates stamp UPMC and then a
16 sequential number beginning with 1.

17 Is this your current curriculum
18 vitae?

19 A. Yes.

20 Q. And does it accurately represent your
21 employment, your education, your professional
22 activities and your presentations and
23 publications roughly up-to-date?

24 A. Yes.

25 Q. What is your current employment position with

1 UPMC?

2 A. My current title is associate counsel in the
3 UPMC corporate legal department. I'm one of
4 the senior attorneys.

5 Q. And give me a brief description of your job
6 responsibilities in that capacity.

7 A. I am legal counsel for several hospitals within
8 the UPMC system, namely UPMC South Side, UPMC
9 St. Margaret, Western Psychiatric Institute And
10 Clinic, and a few programs that are within the
11 UPMC Presbyterian Shadyside corporation that's
12 kind of shared among several colleagues.

13 I'm also responsible as the chief
14 counsel for the graduate medical education
15 program of UPMC and the UPMC clinical trials
16 office that handles human subject research.

17 I'm the chief counsel for many of the aspects
18 of the UPMC Cancer Centers as well. I think
19 that would cover most of it. There are other
20 corporate areas and projects that are assigned
21 by the general counsel from time to time.

22 Q. Thank you. There was a time I believe when you
23 were on the staff at the University of
24 Pittsburgh, the legal counsel staff there; is
25 that correct?

1 A. Yes and no. I was not part of the Pitt general
2 counsel office, but I was part of the
3 management and legal counsel for Pitt when
4 Western Psychiatric Institute And Clinic was a
5 part of the university and managed by the
6 university, as well as legal counsel for the
7 school of medicine and the other schools of the
8 health sciences.

9 Q. And was your employer the University of
10 Pittsburgh at the time?

11 A. Yes.

12 Q. And when did that employment circumstance
13 change?

14 A. I think I was actually cut over to the UPMC
15 Presby payroll October 1st, 1986.

16 Q. 1986?

17 A. '86 -- I'm sorry, '96, 1996.

18 Q. Was that at or about the time that UPMC was set
19 aside as a separate corporation?

20 A. It actually preceded that. The history of it
21 is that I started there in January of '86, and
22 at that time Western Psych was part of the
23 university, an unincorporated program. In
24 1991, I believe, we merged the hospital
25 operations part of Western Psychiatric to make

1 A. I'm aware of none.

2 Q. Okay. When you were at Pitt, was Fran Connell
3 there?

4 A. Fran Connell, yes, yes.

5 Q. Did you have any involvement at the time in
6 licensing issues and patent assignment issues,
7 those kinds of things?

8 A. At one time I did, prior to Ms. Connell taking
9 over as the director of the technology transfer
10 office. I don't know what year that would have
11 been, sometime in probably the early '90s, and
12 subsequently to that I would have some
13 involvement at her request where matters
14 related to the school of medicine or schools of
15 health sciences, but not any involvement with
16 the rest of the campus that were outside of the
17 schools of health sciences.

18 Q. But she would be the principal person to ask
19 about those issues --

20 A. Yes.

21 Q. -- back at that time?

22 A. Yes, yeah, she was the director of the office.
23 She took it over after the prior director,
24 fellow named John Thompson retired, and I
25 consulted and assisted her whenever she asked

1 me to, but it was her operation.

2 Q. And 10, 11 and 12 would all relate to the same
3 set of issues if you take a look at those?

4 A. Yes.

5 Q. Would you think she would be a person who would
6 be most likely to have information on those
7 issues?

8 A. Yeah, I would think so. If you are looking at
9 the time frame of the mid-'90s to the filing of
10 the patents and so forth, I would think so.

11 The current Office of Technology Management
12 director Marc Malandro wouldn't have been there
13 at that time. Depends what time frame you are
14 talking about because there was a reassignment
15 of job duties and reporting and so forth when
16 actually there was another director before
17 Marc, but he is the current director.

18 So depends what time frame. Mid-'90s
19 or around that time, yes, that would be Fran
20 Connell.

21 Q. All right. And she's still employed at the
22 University of Pittsburgh?

23 A. No. She retired last year I think.

24 Q. Do you know if she's still in the area?

25 A. She's in Philadelphia.

1 Q. Philadelphia. Do you know the circumstances
2 under which she left Pitt? Did she just
3 retire, or do you have any knowledge?

4 A. It was a voluntary retirement and that she
5 initiated.

6 Q. As far as you know, left on good terms?

7 A. Yes. Yeah, they had a nice party for her and,
8 you know, she had been there for quite some
9 time, actually started out in the general
10 counsel offices as one of the associate general
11 counsels.

12 Q. Okay. So for 10, 11 and 12, I think we just
13 covered those. 13 we have listed for
14 Dr. Shogan. Do you have any knowledge though
15 on 13?

16 A. No, I don't have any personal knowledge of
17 anything on 13 or 14.

18 Q. Same with 14?

19 A. Yes.

20 Q. 15?

21 A. I wasn't quite sure what you were trying to get
22 at there. Can you clarify?

23 Q. I think. Well, we may have already talked
24 about this. UPMC you said has recently
25 developed an IP policy, and prior to that time

1 A. Yes.

2 Q. Same for 19?

3 A. Same for 19.

4 Q. No. 20, UPMC's acquisition, possession,
5 ownership and use of any of the Varian products
6 that are listed in that request. Do you have
7 some knowledge regarding that?

8 A. I do.

9 Q. All right. Why don't you just generally tell
10 me what you know.

11 A. Okay. I wasn't quite sure again what you were
12 trying to get to there, but I think I discussed
13 this with you and with Matt, that UPMC did
14 enter into a customer-vendor relationship with
15 Varian several years ago when the UPMC Cancer
16 Centers' idea was spawned and several -- group
17 of senior managers cutting across various
18 departments and divisions made a decision that
19 Varian systems and equipment were the ones that
20 they wanted to get for use in the different
21 cancer facilities within UPMC and as we have
22 expanded it since then.

23 I was not part of any of those
24 discussions or the negotiations which were done
25 through the UPMC purchasing department, now

1 called supply chain management.

2 I did produce to you a spreadsheet of
3 all of the purchases that our department was
4 able to give me back to 2000 because of their
5 record retention/destruction policy. That
6 would not have told you where those systems and
7 equipment are located.

8 So thinking that that's what you were
9 looking for, I asked one of the senior
10 administrators for the cancer centers to let me
11 know what of that list of equipment had been
12 purchased and installed at various UPMC
13 locations, and this document was what I
14 received late yesterday (handing). If you want
15 to mark that as an exhibit, we can talk about
16 it.

17 Q. All right. Well, let's do one other thing
18 first. Why don't I show you Exhibit 1, if you
19 could first identify that.

20 A. That is the document that contains description
21 of UPMC purchases of various items from Varian
22 per the prior subpoena that you had served on
23 us going back, as I said, to I believe the year
24 2000, because they only keep the documents for
25 seven years in the purchasing department. That

1 gives a summary of each item that was purchased
2 and the price that was paid.

3 Q. You said there was a committee that made this
4 determination or you said senior managers, I
5 forget the term you used, that made the
6 decision to purchase this product?

7 A. Yes.

8 Q. Who was that?

9 A. I don't know who all was involved with that. I
10 believe Dr. Shogan was involved with that, so
11 that might be fair game for you to ask him.

12 Q. Do you know if Dr. Greenberger was?

13 A. I don't know.

14 Q. And was there any involvement by the legal
15 department in the process of those decisions to
16 make these purchases?

17 A. There would probably have been review by --
18 there could have been review by somebody in our
19 department. It was not me. I don't know who
20 was involved.

21 Q. And do you know whether the determination was
22 made to purchase from Varian as opposed to
23 others, or if there was some determination that
24 they were the only supplier? Do you have any
25 knowledge about that?

1 COMMONWEALTH OF PENNSYLVANIA) CERTIFICATE

2 COUNTY OF ALLEGHENY) SS:

3 I, Heidi H. Willis, RPR, CRR, a Court Reporter
4 and Notary Public in and for the Commonwealth of
5 Pennsylvania, do hereby certify that the witness
6 ALEXANDER J. CIOCCA, ESQ., was by me first duly sworn
7 to testify to the truth; that the foregoing
8 deposition was taken at the time and place stated
9 herein; and that the said deposition was recorded
10 stenographically by me and then reduced to printing
11 under my direction, and constitutes a true record of
12 the testimony given by said witness.

13 I further certify that the inspection, reading
14 and signing of said deposition were NOT waived by
15 counsel for the respective parties and by the
16 witness.

17 I further certify that I am not a relative or
18 employee of any of the parties, or a relative or
19 employee of either counsel, and that I am in no way
20 interested directly or indirectly in this action.

21 IN WITNESS WHEREOF, I have hereunto set my hand
22 and affixed my seal of office this 10th day of
23 October, 2007.



24

COMMONWEALTH OF PENNSYLVANIA

Notary Seal
Heidi H. Willis, Notary Public
City Of Pittsburgh, Allegheny County
My Commission Expires July 8, 2008

25 Member, Pennsylvania Association Of Notaries

EXHIBIT V

CONFIDENTIAL

1 IN THE UNITED STATES DISTRICT COURT FOR THE
2 WESTERN DISTRICT OF PENNSYLVANIA

3 UNIVERSITY OF PITTSBURGH,)
4)
5 Plaintiff,)
6) Case No.
7 -vs-) 07-CV-0791 (AJS)
8 VARIAN MEDICAL SYSTEMS, INC.,)
9)
10 Defendant.)
11
12
13 CONFIDENTIAL

14
15 DEPOSITION OF: JEFFREY E. SHOGAN, M.D.

16
17 DATE: October 3, 2007
18 Wednesday, 11:58 p.m.

19
20 LOCATION: UPMC Shadyside Hospital
21 Medical Office Building
5150 Centre Avenue
Fifth Floor Conference Room
Pittsburgh, PA 15213
22

23 TAKEN BY: Defendant

24
25 REPORTED BY: Heidi H. Willis, RPR, CRR
Notary Public
AKF Reference No. HW03565

1 DEPOSITION OF JEFFREY E. SHOGAN, M.D.,
2 a witness, called by the Defendant for examination,
3 in accordance with the Federal Rules of Civil
4 Procedure, taken by and before Heidi H. Willis, RPR,
5 CRR, a Court Reporter and Notary Public in and for
the Commonwealth of Pennsylvania, at the UPMC
Shadyside Medical Office Building, 5150 Centre
Avenue, Fifth Floor Conference Room, Pittsburgh,
Pennsylvania, on Wednesday, October 3, 2007,
commencing at 11:58 p.m.

6

7

- - - -

8

APPEARANCES:

9

10 FOR THE PLAINTIFF:
11 Rita E. Tautkus, Esq.
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13 rtautkus@morganlewis.com

14

15

FOR THE DEFENDANT:

16 Henry Sneath, Esq.
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19

20

21 FOR THE WITNESS:
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22 U.S. Steel Tower, 28th Floor
600 Grant Street
23 Pittsburgh, PA 15219
412-647-8478
24 cioccaaj@upmc.edu

25

1 JEFFREY E. SHOGAN, M.D.,
2 being first duly sworn,
3 was examined and testified as follows:
4 - - - -

5 EXAMINATION
6 - - - -

7 BY MR. SNEATH:

8 Q. Dr. Shogan, my name is Henry Sneath. I
9 represent Varian Medical Systems, Incorporated.
10 Varian is a Defendant in a lawsuit filed by the
11 University of Pittsburgh. It's a suit for
12 patent infringement. It's filed in the United
13 States District Court for the Western District
14 of Pennsylvania.

15 I'm going to ask you some questions
16 today relating to a subpoena we served on you
17 and UPMC asking that documents be produced and
18 a witness be designated for certain deposition
19 topics that we forwarded to counsel.

20 My understanding is you are
21 represented by Mr. Ciocca today; is that
22 correct?

23 A. That's correct.

24 Q. Please state your full name.

25 A. Jeffrey Edward Shogan.

1 Q. And, Dr. Shogan, what's your current employment
2 here at the university?

3 A. I'm employed by the University of Pittsburgh
4 Cancer Centers, UPMC Cancer Centers.

5 Q. And what is your position?

6 A. I'm one of the directors, chief business
7 officer, director of business, strategic
8 planning.

9 Q. Okay. And how long have you been here?

10 A. It was 2001 I believe, end of 2000, beginning
11 of 2001.

12 Q. I've put in front of you what I believe to be
13 your current CV. It's marked as Exhibit 25.
14 Would you agree with me that that is your at
15 least relatively current CV?

16 A. Yes.

17 Q. And do you stand by the representations that
18 are in there so I don't need to ask you
19 questions about them?

20 A. Yes.

21 Q. All right. Thank you. You were designated by
22 UPMC to testify regarding certain issues, so
23 I'm going to try to limit these questions the
24 best I can to that.

25 Tell me what your experience is with

1 COMMONWEALTH OF PENNSYLVANIA) CERTIFICATE

2 COUNTY OF ALLEGHENY) SS:

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4 and Notary Public in and for the Commonwealth of
5 Pennsylvania, do hereby certify that the witness
6 JEFFREY E. SHOGAN, M.D., was by me first duly sworn
7 to testify to the truth; that the foregoing
8 deposition was taken at the time and place stated
9 herein; and that the said deposition was recorded
10 stenographically by me and then reduced to printing
11 under my direction, and constitutes a true record of
12 the testimony given by said witness.

13 I further certify that the inspection, reading
14 and signing of said deposition were NOT waived by
15 counsel for the respective parties and by the
16 witness.

17 I further certify that I am not a relative or
18 employee of any of the parties, or a relative or
19 employee of either counsel, and that I am in no way
20 interested directly or indirectly in this action.

21 IN WITNESS WHEREOF, I have hereunto set my hand
22 and affixed my seal of office this 11th day of
23 October, 2007.

